Supreme Court, U.S.
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No.

IN THE

Supreme Court of the United States

JAMES W. NEWTON, JR.,
DBA JANEW MUSIC, PETITIONER

v.

MICHAEL DIAMOND; ADAM HOROWITZ; ADAM YAUCH, DBA BEASTIE BOYS; CAPITOL RECORDS, INC., A DELAWARE CORPORATION; GRAND ROYAL RECORDS, INC., A CALIFORNIA CORPORATION; UNIVERSAL POLYGRAM INTERNATIONAL PUBLISHING, INC., A DELAWARE CORPORATION; BROOKLYN DUST MUSIC, AN ENTITY OF UNKNOWN ORIGIN; MARIO CALDATO, JR., AN INDIVIDUAL; JANUS FILMS, LLC, A NEW YORK LIMITED LIABILITY COMPANY; CRITERION COLLECTION, A CALIFORNIA PARTNERSHIP; VOYAGER PUBLISHING COMPANY, INC., A DELAWARE CORPORATION; SONY MUSIC ENTERTAINMENT GROUP, A DELAWARE CORPORATION; BMG DIRECT MARKETING, INC., A DELAWARE CORPORATION; THE COLUMBIA HOUSE COMPANY, AN ENTITY OF UNKNOWN ORIGIN

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether in a copyright infringement action the trier of fact should evaluate the substantiality of original expression in a creative work from the perspective of an ordinary lay observer when that work can be understood only by an audience with specialized expertise, a question upon which virtually all the Courts of Appeals are in conflict, and which the leading commentator identifies as demanding Supreme Court review.

2. Whether a federal appellate court, reviewing a grant of summary judgment *de novo*, errs by resolving genuine disputes of material fact, thereby removing the fact-finding function from the exclusive province of the jury.

PARTIES TO THE PROCEEDINGS

Petitioner is James W. Newton, dba Janew Music.

Respondents are Michael Diamond, Adam Horowitz, and Adam Yauch, dba Beastie Boys; Capitol Records, Inc., a Delaware Corporation; Grand Royal Records, Inc., a California Corporation; Universal Polygram International Publishing, Inc., a Delaware Corporation; Brooklyn Dust Music, an entity of unknown origin; Mario Caldato, Jr., an individual; Janus Films, LLC, a New York Limited Liability Company; Criterion Collection, a California Partnership; Voyager Publishing Company, Inc., a Delaware Corporation; Sony Music Entertainment Group, a Delaware Corporation; BMG Direct Marketing, Inc., a Delaware Corporation; The Columbia House Company, an entity of unknown origin.

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OTHER AUTHORITIES

Boorstyn, N., ed., *Copyright Law Journal*, Vol. XVIII, No. 2 (March-April 2004) 24

I. Carr, D. Fairweather, B. Priestly (eds.), *Jazz: The Rough Guide* (1995) 16

Kernfeld, B., *What To Listen For In Jazz* (1995) 20

G. Giddins, *Rhythm-a-ning: Jazz Tradition and Innovation in the '80s* (1985) 3

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Petitioner James Newton respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit.

OPINIONS BELOW

The published opinion of the Ninth Circuit Court of Appeals from which petitioner seeks review is reported at 388 F.3d 1189 (9th Cir. 2004) (App. 1a).[1] That opinion amended and superceded on the denial of rehearing a prior Ninth Circuit opinion reported at 349 F.3d 591 (9th Cir. 2003) (App. 22a). The opinion of the district court is reported at 204 F.Supp.2d 1244 (C.D. Cal. 2002) (App. 42a).

JURISDICTION

The judgment of the Ninth Circuit Court of Appeals from which petitioner seeks review was issued on November 9, 2004. On January 31, 2005, Justice O'Connor signed an order extending the time for filing this petition for certiorari to and including March 10, 2005. The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1).

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[1] References to the Appendix submitted with this petition are cited as "App. [page]."

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, Section 8 of the United Stated Constitution provides: "The Congress shall have Power ... to Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

17 U.S.C. section 102, entitled "Subject matter of copyright: In general," provides:

> (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: ... (2) musical works, including any accompanying words; ... [and] (7) sound recordings...

STATEMENT OF THE CASE

This case raises important, recurring questions relating to the scope of protection afforded by the Copyright Act. Petitioner James Newton brought this copyright infringement action because respondent Beastie Boys digitally copied a portion of Newton's jazz

composition entitled *Choir*.[2] The Ninth Circuit ultimately ruled that the portion of *Choir* that was taken is too insubstantial to be actionable, thereby affirming summary judgment on the basis of the *de minimis* doctrine.

A. Petitioner's Creation of *Choir*

James Newton ("Newton") is a world famous jazz flutist, composer, music professor and Guggenheim Fellow. (ER 15 at 85-86).[3] The New York Times describes Newton as the "most accomplished and original flutist now playing in jazz." T. Page, in J. Newton, Axum (1982) (LP liner notes) (ER 6 at 58). According to a noted jazz critic, "Newton has assimilated the influences of jazz, Europe and exotic folk music with greater equanimity than any academic composer has done or is likely to do in the near future." G. Giddins, *Rhythm-a-ning: Jazz Tradition and Innovation in the '80s*, 62 (1985) (ER 18 at 119).

In 1978 Newton composed *Choir*, a meditative work containing elements of African American spirituals, traditional Japanese ceremonial court music

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[2] Compact Discs of Newton's versions of *Choir* and of the Beastie Boys' songs that use excerpts from *Choir* are available for submission to the Court. Petitioner has been informed by the Court clerk that the Compact Discs should not be included in the appendix to the petition, and should be submitted only upon request by the Court.

[3] Petitioner provides citations to Appellant's Excerpts of Record ("ER"), filed in the Ninth Circuit on September 30, 2002, for reference by the parties. The Excerpts of Record have not been submitted to this Court with this petition. The citations are written as: "ER [tab number] at [Bates-stamped page number]".

("Gagaku"), classical music, traditional African music and avant-garde practices, including compositional use of "multiphonics" (i.e. simultaneous multiple pitches). (ER 14 at 78). Newton was inspired to write the song by an early memory of watching four women singing in a church in rural Arkansas. *Choir* uses counterpoint vocalizations, flute, and multiphonics to re-create these four spiritual voices. (ER 15 at 87, 91-94).

Instructions for creating *Choir's* distinctive sound are set forth in the unpublished lead sheet (i.e. a simplified notation of melody used as a guide to the song). (ER 3 at 50). The introductory portion of *Choir*, which is the segment of the composition at issue in this suit, contains its first multiphonic passage. *See Newton v. Diamond (Newton III)*, 388 F.3d 1189, 1199 (9th Cir. 2004) (Appendix including excerpt of *Choir* score); App. 104a (*Choir* score). The flutist is directed to perform a steady, overblown C on flute (notated twice) one octave above middle C, while slowly vocalizing the counterpoint notes C to D-flat to C. The overall rhythm is "senza misura" (without measure) and "largo" (stately). *Id.* The interaction of steady overblown flute and slowly shifting dissonant vocalizations produces acoustically mirrored notes that move in contrary motion to the vocalized pitches. (App. 93a) (ER 24 at 149-150). Thus, the key musical elements heard in Newton's performance of *Choir* -- including senza misura/largo rhythm, dissonant harmony, intervallic use of whole and half steps, overblowing the background C note, and instructions for creating multiphonics -- are specifically noted in the score. Subsequent passages of *Choir* further develop this introductory theme, multiphonics, and improvisation.

Three subsequent recordings of *Choir* were published by Newton and distributed on phonorecords. Newton assigned his copyright in the 1982 *Choir* sound recording to ECM. (ER 8 at 62). At all times Newton has retained all rights to the composition of *Choir*. *See* 17 U.S.C. § 102(a)(2), (7) (sound recordings and their underlying compositions are separate works with their own discrete copyrights).

B. Respondents' "Sampling" of *Choir*

Beastie Boys are a multi-platinum hip-hop group who make extensive use of digital samples. "Sampling" entails the incorporation of short segments of prior sound recordings into new recordings. The digital sampling technique involved here developed in the early 1980s with the advent of digital synthesizers having MIDI (Musical Instrument Digital Interface) keyboard controls. These digital instruments allowed artists to manipulate and combine sampled sounds. Sampling usually involves "repurposing" the excerpt by placing it in a new context, and often involves repeated usage of a single excerpt. Thus, a distinctive excerpt of a work sampled for such usage may be quite small, while still making a significant contribution to the new work.

In 1992, Beastie Boys digitally sampled an excerpt from *Choir's* introduction, which they described as the "best bit." (ER 10 at 68; ER 20 at 124-129; ER 21 at 117-119). This sampled introduction represents over nine percent (i.e. one of eleven notated flute/vocal passages) of the *Choir* lead sheet. (ER 3 at 50). Beastie Boys used this sample as the *unaccompanied* introduction to multiple renditions of their signature hit song entitled *Pass the Mic*, "looping" the sample forty-two (42) times

throughout the song to create an essential musical "hook." (ER 11 at 69, Track 2). These recordings were subsequently reissued on CDs, LPs, cassettes, greatest hits anthologies, DVDs, videos and MP3s. Beastie Boys also use the *Choir* sample in almost every live performance of *Pass the Mic*. (ER 11 at 69, Track 5; ER 22 at 135). In November 2000, Beastie Boys released an instrumental version of *Pass the Mic* on their DVD video anthology, comprised almost *entirely* of a continuous loop of *Choir's* introduction, with a minor addition of a drum machine and other sounds that are barely audible. (ER 11 at 69, Track 6).

Beastie Boys licensed the ECM sound recording, recognizing the importance of the *Choir* sample in their song. (ER 12 at 71). However, they did not license the underlying composition. (ER 9 at 65).

C. Petitioner's Infringement Claim

Newton learned of the Beastie Boys' infringement of *Choir* in January 2000. (ER 15 at 109). Newton filed suit against Beastie Boys and other defendants on May 9, 2000 for copyright infringement and related claims. The jurisdiction of the district court was invoked under 28 U.S.C. § 1331 and § 1338(a), because this action arose under the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.*

On May 21, 2002, the district court issued its Order Granting Defendants' Motion for Summary Judgment and Denying Plaintiff's Motion for Summary Judgment. *Newton v. Diamond (Newton I)*, 204 F.Supp.2d 1244 (C.D. Cal. 2002). (App. 42a). The district court held that *Choir's* multiphonics are merely

"elements of Plaintiff's performance" licensed from ECM. *Id.* at 1255. (App. 62a-64a). The court held that no license to the underlying composition was required because, as a matter of law, the notes in question – C to D flat to C, over a held C note -- lacked sufficient originality to merit copyright protection. *Id.* at 1256 (App. 58a). The district court also held that even if the sampled segment of the composition were original, Beastie Boys' use of a brief segment of the sound recording of *Choir* was a *de minimis* taking of the *Choir* composition and therefore was not actionable. *Id.* at 1259. (App. 66a).

In a split opinion, the Ninth Circuit affirmed the District Court's decision on the sole ground that the taking was *de minimis*. *Newton III*, 388 F.3d at 1196-97. (App. 15a). The court separated from its consideration all elements unique to Newton's licensed sound recordings, and held that only the composition should be considered. *Newton III*, 388 F.3d at 1193 ("we must 'filter out' the licensed elements of the sound recording to get down to the unlicensed elements of the composition"). (App. 9a). In this regard, the court recognized a number of distinctive qualities of the *Choir* composition, including that it consists of three sung notes over a background played note which is overblown, that it indicates the tempo, and that it includes multiphonics. *Id.* at 1191. (App. 4a).

The Ninth Circuit found that the sound recording of *Choir* is the product of Newton's "highly developed performance techniques, rather than the result of a generic rendition of the composition." *Id.* at 1194. (App. 9a). The court concluded: "On the undisputed facts of this record, no reasonable juror

could find the sampled portion of the composition to be a quantitatively or qualitatively significant portion of the composition as a whole." *Id.* at 1195. (App. 13a).

Judge Graber issued a dissenting opinion in which she concluded that the composition is distinctive and substantial enough to pass the *de minimis* threshold. *See Newton III*, 388 F.3d at 1197 (Graber, J., dissenting). (App. 17a). In her dissent, Judge Graber indicated that the majority fundamentally misread key expert reports, essentially reversing their intended meaning. *Id.* at 1197-98. (App. 19a). The dissent also criticizes the majority for ignoring the essential fourth note on flute. Judge Graber wrote: "[T]he majority's repeated references to the sampled segment of *Choir* as a '3-note sequence' are overly simplified. The sampled segment is actually a three-note sequence [simultaneously] sung above a fingered held C note, for a total of four separate tones. Even passages with relatively few notes may be qualitatively significant. The opening melody of Beethoven's Fifth Symphony is relatively simple and features only four notes, but it certainly is compositionally distinctive and recognizable." *Id.* (App. 17a-18a).[4]

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[4] Similarly, Newton's expert explained: "The opening four notes of Beethoven's Fifth Symphony in C Minor take only a couple of seconds to play, are remarkably simple ... as a melody, and contain only a single melodic interval..." (App. 89a); *see also* 3 *Nimmer on Copyright* § 13.03[A][2] (2004) (notion that copying of three bars from musical work can never constitute infringement is without foundation).

REASONS FOR GRANTING THE PETITION

I. The Circuit Courts Have Reached Conflicting Approaches Regarding Whether to Recognize the Perspective of a Specialized Audience, Rather Than an Ordinary Lay Audience, When Evaluating the Substantiality of Original Expression in Work Protected by Copyright; the Leading Commentator on Copyright Law has Identified this Issue as Ripe for Supreme Court Review.

This Court has explained that "[n]ot all copying ... is copyright infringement." *Feist Pub'lns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). Thus, for an unauthorized use of a copyrighted work to be actionable, the use must be substantial enough to constitute infringement. The Copyright Act does not specify the minimum quantity of taking to be considered an infringement, so the courts have been left to wrestle with this issue.

As the case law has developed, a critical split has occurred among the circuit courts regarding whether to recognize the perspective of a specialized audience, rather than an ordinary lay audience, when evaluating the substantiality of a creative work that is beyond the understanding of the average person. This issue, which this Court has not yet addressed, is of vital importance because so much work in the modern era – especially in music and technology – is beyond the grasp of the average lay person and requires specialization or expertise.

The split among the circuits on this issue has become so severe in recent years that it has garnered wide-scale attention in academia and among noted legal commentators. Indeed, *Nimmer on Copyright*, widely recognized as the leading national treatise on copyright law, states: "[G]iven the disagreement among the circuits about how to apply the audience test, *Supreme Court review is ripe* on this basis alone." 4 *Nimmer on Copyright*, § 13.03 n. 202.15 (2004) (emphasis added) (hereinafter "*Nimmer*").[5]

A. The Audience Test is Used to Measure Substantiality in Both the *De Minimis* and Substantial Similarity Analyses

In copyright cases where the material taken is only a portion of the original work, as in *Newton*, the courts sometimes apply a threshold inquiry according to the maxim *de minimis non curat lex* (often rendered as "the law does not concern itself with trifles"). *See Newton III*, 388 F.3d at 1193 (App. 7a); *On Davis v. The Gap, Inc.*, 246 F.3d 152, 172 (2nd Cir. 2001) ("The *de minimis* doctrine essentially provides that where unauthorized copying is sufficiently trivial, 'the law will not impose legal consequences.'") (citations omitted). At issue in the *de minimus* use analysis is a legal judgment as to whether the copying has occurred to such a trivial extent that it should not be actionable.

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[5] Of the many issues addressed in Professor Nimmer's expansive treatise, Petitioner's research indicates that this is *the only one* currently identified as being ripe for Supreme Court review. *See Nimmer, passim.* This Court has recognized *Nimmer* as a leading authority on copyright law. *See, e.g., New York Times Co., Inc. v. Tasini*, 533 U.S. 483, 495, 507, 508 n. 1, 519 (2001).

More often, the question as to whether a taking is substantial enough to warrant copyright protection arises in the context of the "substantial similarity" test. Copyright plaintiffs carry the burden of showing substantial similarity of expression between the copyrighted work and the defendant's work. *See Feist*, 499 U.S. at 360-61 (1991). The test for substantial similarity is essentially whether the fundamental essence or structure of the original work is duplicated in the other. *See Nimmer* § 13.03[A][2].[6] In order to reach that comparison, the portion of plaintiff's work that has been appropriated must be significant in relation to plaintiff's work as a whole. *See Nimmer* § 8.01[G] (a finding that the appropriation of a portion of a work is merely "'*de minimis copying*' represents simply the converse of [a finding of] substantial similarity"). Thus, the question presented by this petition – whether substantiality should be measured from the perspective of a specialized audience when the material in question is beyond the understanding of a lay person – applies equally in the *de minimis* and substantial similarity analyses.

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[6] The courts of appeals differ somewhat in their application of the substantial similarity test. These differences are irrelevant to this petition. The relevant point here is that all the circuits test for substantiality, and there is a split among them in terms of whether to recognize the perspective of an audience with specialized or technical expertise.

B. Virtually All the Circuit Courts are Divided Over How to Apply the Audience Test

Whether through application of the *de minimis* maxim or in the context of a substantial similarity analysis, the courts have struggled with how to measure substantiality. *See Nimmer*, § 13.03[A] (measuring substantiality "presents one of the most difficult questions in copyright law"). It is here that the Courts of Appeal are sharply divided. The District of Columbia, First, Seventh, Eighth, Ninth, Tenth, and Eleventh Circuits view the substantiality of a plaintiff's work from the perspective of the "average audience," regardless of the complexity or technicality of the protected work. In sharp contrast, the Third, Fourth, and Sixth Circuits recognize that ordinary lay persons are unable to understand and appreciate certain complex and technical works, and that in these circumstances the perspective of a specialized audience must be used.

1. The Ninth Circuit and Six Other Courts of Appeals Squarely Adopt the "Ordinary Lay Observer" Approach to the Audience Test

The Ninth Circuit made its approach to the audience issue unambiguous in *Newton*. The court held that both the *de minimis* and substantial similarity tests "look[] to the response of the average audience, or ordinary observer, to determine whether a use is infringing." *Newton III*, 388 F.3d at 1193 (App. 7a-8a); *see also id.* at 1196 ("we conclude that an average audience would not discern Newton's hand as a

composer" so that "[t]he copying was not significant enough to constitute infringement") (App. 15a).

The *Newton* court recognized that *Choir* is an exceptionally nuanced and sophisticated work. *See Newton III*, 388 F.3d at 1191 (recognizing the *Choir* composition is comprised of multiphonics, i.e. multiple pitches that arise when the performer follows the instructions on the score to simultaneously play the flute note and sing dissonant vocal notes, and that it "incorporate[s] elements of African-American gospel music, Japanese ceremonial court music, traditional African music, and classical music, among others"). (App. 3a-4a). In spite of this recognition, the court rejected the perspective of an audience that is capable of understanding such music, and chose instead to use the ordinary lay audience standard. *Newton III*, 388 F.3d at 1193 (App. 7a-8a), 1196 (App. 15a).

The *Newton* ruling is consistent with the approach the Ninth Circuit has taken for decades. The court explicitly relied on earlier Ninth Circuit precedent in *Fisher v. Dees*, 794 F.2d 432, 435 (9th Cir. 1986) for the proposition that the ordinary lay audience test applies in the context of a *de minimis* analysis. *See Newton III*, 388 F.3d at 1193. (App. 7a). With respect to the substantial similarity test, *Newton* is part of a long line of cases applying the ordinary lay audience test that began with *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977). In *Baxter v. MCA, Inc.*, 812 F2d 421 (9th Cir. 1987), the court rejected the position that "protection beyond the 'lay audience' test is required for authors of works in technical fields such as music," and stated that there are no good reasons to depart

from the Circuit's long-held principle that "the test of substantial similarity depends upon the response of the ordinary lay listener." *Id.* at 424 n. 2 (citation omitted); *see also Swirsky v. Carey*, 376 F.3d 841, 847 (9th Cir. 2004) (substantial similarity test requires that "the 'ordinary, reasonable person would find the total concept and feel of the [two choruses] to be substantially similar.'") (quoting *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000).[7]

The First Circuit similarly has embraced the blanket application of the "ordinary observer" standard. In an emphatic rejection of bringing any expertise to bear on the question of substantiality, the court has held:

> [W]e reiterate our rule that expert testimony on the topic of "substantial similarity" is not permissible... [W]here factual copying has been established, as here, there should be no expert testimony to establish whether or not there was substantial similarity. [citation omitted].

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[7] The television show at issue in *Krofft* was directed to children, and the court recognized that the lay audience must include average children as well as adults. *Krofft*, 562 F.2d at 1166; *see also Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 902 (9th Cir. 1987). The court did not address whether any special expertise should be brought to bear, and the case has been widely cited for the proposition that the substantial similarity test in the Ninth Circuit accounts only for the response of the lay observer without any technical or expert advice. *See, e.g., Baxter*, 812 F.2d at 424 ("No compelling reason appears, however, to depart from the principles enunciated in *Krofft*, which reiterates that the test of substantial similarity depends upon the response of the ordinary lay listener.").

> That is because the test is an "ordinary observer test."

Segrets, Inc. v. Gillman Knitwear Co, Inc., 207 F.3d 56, 66 n. 11 (1st Cir. 2000).

The District of Columbia, Seventh, Eighth, Tenth, and Eleventh Circuits similarly have issued rulings adopting the ordinary lay observer approach. *See Atkins v. Fischer*, 331 F.3d 988, 993 (D.C. Cir. 2003) (holding that "the question is whether 'an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.'") (citation omitted); *Susan Wakeen Doll Co. v. Ashton-Drake Galleries*, 272 F.3d 441, 451 (7th Cir. 2001) ("This court applies the 'ordinary observer' test to determine whether a substantial similarity exist[s]"); *Taylor Corp. v. Four Seasons Greetings, LLC*, 315 F.3d 1039, 1043 (8th Cir. 2003) (applying "ordinary observer" test); *Wihtol v. Crow*, 309 F.2d 777, 780 (8th Cir. 1962) (in copyright suit for infringement of musical composition of spiritual, court applied "ordinary observer" test); *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1288 (10th Cir. 1996) (the "essence" of the substantial similarity test is guided by the perspective of the "ordinary observer"); *Calhoun v. Lillenas Publishing*, 298 F.3d 1228, 1232 (11th Cir. 2002) (in copyright suit for infringement of spiritual composition, court applied "average lay observer" test).

2. The Third, Fourth, and Sixth Circuits Squarely Adopt the Specialized Audience Approach

In contrast to the blanket rule discussed above, the Third, Fourth, and Sixth Circuits take a markedly different approach. These courts recognize that the ordinary lay audience test undermines copyright law when plaintiff's work can be understood only by a specialized audience.

The approach of the Fourth Circuit in a case remarkably analogous to *Newton* serves to highlight the fissure among the circuits on the audience question. In *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731 (4th Cir. 1990), *cert. denied*, 498 U.S. 981 (1990), the Fourth Circuit addressed a copyright infringement claim concerning the arrangement of a spiritual entitled *Ezekiel Saw de Wheel*. Similarly, Newton's composition of *Choir* was inspired largely by spiritual music, and is intended to evoke the sound of four gospel singers. *See Newton III*, 388 F.3d at 1191 (App. 3a); I. Carr, D. Fairweather, B. Priestly (eds.), *Jazz: The Rough Guide*, 473 (1995) (describing *Choir* as a composition "that deals in four voices holding a tone, singing a tone and the difference tones between the two"). Both cases also involved only the written compositions, separate and apart from the performance or recording of the music. *See Dawson*, 905 F.2d at 733 (court was not presented with recordings and had "nothing before [it] other than the sheet music"); *Newton III*, 388 F.3d at 1193-94 ("we must 'filter out' the licensed elements of the sound recording to get down to the unlicensed elements of the composition") (App. 9a).

Despite the factual similarities between *Dawson* and *Newton*, the two circuits have taken diametrically opposite approaches to the law. The *Dawson* court held that when measuring substantiality of a spiritual composition or other work, the court must consider whether an understanding of the protected work requires an evaluation by persons who "possess[] specialized expertise ... that lay people would lack." *Id.* at 736. The court was especially critical of courts like the Ninth Circuit that fail to recognize this distinction:

> [O]nly a reckless indifference to common sense would lead a court to embrace a doctrine that requires a copyright case to turn on the opinion of someone who is ignorant of the relevant differences and similarities between two works. Instead, the judgment should be informed by people are familiar with the media at issue.

Id. at 735 (citation omitted). *See also Lyons Partnership, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 803 (4th Cir. 2001) (holding that "the established copyright principles of this circuit" dictate that "when it is clear that the work is intended for a more particular audience, the court's inquiry must be focused upon the perspectives of the persons who comprise that group").

Similarly, in *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222 (3rd Cir. 1986), the Third Circuit held that "the ordinary observer test is not useful and is potentially misleading when the subjects of the copyright are particularly complex." *Id.*

at 1233. At issue in *Whelan* was a computer program for dental laboratory record keeping, but the ruling reaches beyond computer technology to any case "involving exceptionally difficult materials." *Id.*[8]

Likewise, the Sixth Circuit held in *Kohus v. Mariol*, 328 F.3d 848, 857 (6th Cir. 2003): "In cases where the target audience possesses specialized expertise ... the specialist's perception of similarity may be much different from the lay observer's, and it is appropriate in such cases to consider similarity from the specialist's perspective." *Cf. Stromback v. New Line Cinema*, 384 F.3d 283, 296 (6th Cir. 2004) (recognizing that, consistent with *Kohus*, no expertise is needed to evaluate the substantiality of "a literary work aimed at a general audience.").

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[8] The Second Circuit straddles the chasm between the other circuits by drawing a sharp, albeit arbitrary, line between aesthetic work and computer technology. In *Computer Associates Intern., Inc. v. Altai, Inc.*, 982 F.2d 693, 713 (2nd Cir. 1992), the Second Circuit recognized "the reality that computer programs are likely to be somewhat more impenetrable by lay observers ...," and that "the trier of fact need not be limited by the strictures of its own lay perspective." *Id.* at 713 (citations omitted). However, the court did not apply this logic beyond the field of computer science, stating that it did not intend to disturb the "traditional role of lay observers in judging substantial similarity in copyright cases that involve the aesthetic arts, such as music, visual works or literature." *Id.* at 713-14; *cf. Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 130 (2nd Cir. 2003) (applying ordinary observer test regarding artistic design).

C. The Issue Presented by this Conflict is Recurring and of Great Practical Importance, Calling for this Court to Announce a Uniform Standard for Measuring Substantiality

The split among the circuits identified above creates a substantial problem that calls for resolution by this Court. Since virtually all of the circuits have weighed in on this issue, there is little room for further development of this area of copyright law without Supreme Court guidance.

The need for uniformity and clarity with regard to the audience test has become more and more severe in recent times. As this Court has recognized: "From its beginning, the law of copyright has developed in response to significant changes in technology." *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984). The development and meteoric rise of digital sampling over the past few decades has led to a vast expansion in the sheer quantity of musical copying that occurs. As the Sixth Circuit recently recognized:

> Advances in technology coupled with the advent of the popularity of hip hop or rap music have made instances of digital sampling extremely common and have spawned a plethora of copyright disputes and litigation.

Bridgeport Music, Inc. v. Dimension Films, 383 F.3d 390, 396 (6th Cir. 2004) (citations omitted). Given the continuing rise in copyright litigation, the problems

associated with disparate approaches to judicial resolution of infringement actions will only increase.

In tandem with these advances in technology has been a vast expansion in the breadth and diversity of style and manner among modern artists, especially musicians. This is particularly true in jazz, where one commentator has noted: "The law, for all its stages of evolution, has a long way to go before it will be able to deal intelligently with the problems specific to jazz..." Kernfeld, B., *What To Listen For In Jazz*, 117 (1995). This is certainly true as well for a wide range of non-Western and non-traditional musical works, including, for example, minimalism (e.g. Steve Reich, Philip Glass), microtonal music (e.g. Charles Ives, Harry Partch), free jazz (e.g. Ornette Coleman, Association For The Advancement of Creative Musicians [AACM]), avant-garde (e.g. György Ligeti, Stockhausen), avant-garde jazz (e.g. Cecil Taylor, the late works of John Coltrane), electronica (e.g. Orbital, Aphex Twin), as well as some rap and hip hop music (e.g. Run D.M.C., Dr. Dre). These artists, thousands of others like them, their producers, and those who choose to copy their work depend on this Court to set forth a single, practicable, and clear definition of the perspective from which these original works are to be judged when copyright claims are made. Without a uniform standard, artists with complex or sophisticated original work are at a loss in determining whether their work is protected. Similarly, those seeking to use such original work are at a loss as to whether they must pay for the use, and whether failing to do so may subject them to legal liability.

The framers of the Constitution and Congress have always viewed copyright protection as an issue of national importance. Thus, copyright is a federal issue, and its scope should not vary from jurisdiction to jurisdiction. But this is precisely the current state of affairs. The most obvious result of this situation is that litigants in similar factual scenarios, presenting the same legal issues to their respective courts, are receiving different results. The most glaring example of this is the conflicting conclusions of the Ninth Circuit in *Newton* and the Fourth Circuit in *Dawson*, as discussed above in section I.B.2.

A related ramification of the current split among the circuits is that it encourages forum shopping. For example, a copyright plaintiff in a case involving a highly technical piece of work will seek, where possible, to file suit in a circuit that allows the trier of fact to bring expertise to bear; in the converse situation, the litigant who fears the knowledge and opinions of experts will attempt to file suit in a circuit where only a lay audience's perspective is allowed.

In sum, a clear explication of a unitary audience standard from this Court will have a positive impact on the development of copyright law and, consequently, on musicians, artists, producers, and society at large.

II. The Decision of the Ninth Circuit Cannot be Reconciled with this Court's Summary Judgment Standard and Threatens to Remove the Fact-Finding Function from the Jury in Many Copyright Actions.

This Court has long held that on motions for summary judgment the lower courts should not make credibility determinations or weigh conflicting evidence, and must draw all inferences in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). In *Newton*, the Ninth Circuit acknowledged the proper legal standard, yet proceeded to flagrantly violate it in application by resolving key material issues of fact rather than identifying those issues and leaving them for trial. The court below thereby usurped the core role reserved exclusively for the jury. *See Newton III*, 388 F.3d at 1197 (Graber, J., dissenting) ("The majority, while citing the correct standard of review, fails fully to apply it"). (App. 18a). It is important for this Court to send the message to the Ninth Circuit and other federal courts that mere lip service to preserving the jury's fact-finding role will not be tolerated.

A. The Jury is Entitled to Weigh the Conflicting Evidence and Decide Whether the Choir Excerpt is Qualitatively Significant

The Ninth Circuit held that the qualitative significance of the portion of *Choir* used by respondents is due *entirely* to James Newton's skillful performance of the piece, and does not derive at all from his composition. *Newton III*, 388 F.3d at 1196. (App. 13a-

14a). The court arrived at this holding by disregarding genuinely disputed facts favoring petitioner, and by turning the meaning of key testimony by petitioner's experts on its head. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 583 (1994) (reversing summary judgment in copyright action where lower court "confin[ed] its treatment ... to one relevant fact," and gave "virtually dispositive weight" to an issue favoring defendant).

The court below held that on the question of the qualitative significance of the composition, Newton's experts "are either silent or fail to distinguish between the sound recording ... and the composition ..." *Newton III*, 388 F.3d. at 1196. (App. 14a). However, Newton's expert actually testified:

> Applying traditional analysis to this brief excerpt from Newton's "Choir" – i.e., focusing solely on the notated pitches – a theorist could conclude (erroneously in my opinion) that the excerpt contains an insignificant amount of information because it contains a simple "neighboring-tone" figure: C to D-flat and back to C . . . If, on the other hand, one considers the special playing technique *described in the score* (holding one fingered note constant while singing the other pitches) and the resultant complex, expressive effect that results, it is clear that the "unique expression" of this excerpt is not solely in the pitch choices, but is actually in those particular pitches performed in that particular way on that instrument. These

> components in this particular combination are not found anywhere else in the notated music literature, and they are *unique and distinctive* in their sonic/musical result.

See Newton III, 388 F.3d at 1198 (Graber, J., dissenting) (quoting Newton's expert Dr. Dobrian) (emphasis in dissenting opinion). (App. 19a, 91a). As the quotation above clearly indicates, and as the dissent notes, Professor Dobrian addressed the distinctiveness of Newton's underlying *composition*, not his performance. *Id.* ("The 'playing technique' is not a matter of [Newton's] personal performance, but is a built-in feature of the score itself. In essence, Dobrian is stating that *any* flautist's performance of the sampled segment would be distinctive and recognizable, *because the score itself is distinctive and recognizable.*") (Graber, J., dissenting) (emphasis added). (App. 19a).

The *Newton* court's encroachment on the jury's exclusive fact-finding role is so blatant and so important that it has subjected the Ninth Circuit to substantial outside criticism. One commentator stated that the majority erred by "mak[ing] a factual finding with competing evidence in the record [where] [t]he conflicting testimony presented a genuine issue of material fact precluding summary judgment." *See, e.g.*, Boorstyn, N., ed., *Copyright Law Journal*, Vol. XVIII, No. 2 (March-April 2004) at 16.

B. The Jury is Entitled to Weigh the Conflicting Evidence and Decide Whether the *Choir* Excerpt is Quantitatively Significant

Not only did the Ninth Circuit err in failing to recognize the complexity of the composition and its creative contribution separate from the performance, it also erred in concluding that, in quantitative terms, the sampled work is a mere "three-note sequence [that] appears only once in Newton's composition." *Newton III* at 1195.[9] (App. 13a). The court credited Beastie Boys' expert alone, who testified that the sampled excerpt is "merely a common, trite, and generic three-note sequence." *Id.* (App. 14a). However, Newton's experts testified to the opposite, i.e. that "anyone familiar with the original piece – either via recording or written score – could easily hear the excerpt in isolation and recognize its origin." (App. 90a).

The Ninth Circuit made a related factual determination that the excerpt used by Beastie Boys is quantitatively *de minimis* because it constitutes only "two percent" of the "sound recording." *Newton* III, 388 F.3d at 1196. (App. 13a). The focus on the recording, as opposed to the composition, is inconsistent

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[9] The Ninth Circuit opinion is ambiguous as to whether the court viewed the composition as comprising three or four notes. In a number of places the court refers to the "three note sequence," yet elsewhere the court recognizes that the composition contains "a background C note played on the flute." *Newton III*, 388 F.3d at 1190-91, 1195 (App 4a, 15a). Nevertheless, the court's *de minimis* analysis of this composition for solo flute fails to actually address this background C note played on flute. This omission is glaring, as the background C note is the *only* flute note specifically notated in the entire *Choir* score. *Id.*

with the court's own separation ("filtering") of the two. Moreover, an objective quantitative measurement of the excerpted portion of the *composition* establishes that the taking amounts to *nine percent* of the overall work (i.e. one of eleven notated phrases commencing on the vocal note C). *See Newton III*, 388 F.3d at 1199 (excerpt of *Choir* score); App. 104a (*Choir* score). The expert testimony and the actual relative length of the excerpt should have created material disputes of fact, but the Ninth Circuit chose to weigh the evidence instead of allowing the issue to go to a jury. *See Campbell*, 510 U.S. at 583.

The court's error here illustrates the importance of the audience question addressed in section I. above. By applying an average audience standard, the Ninth Circuit disregarded the expert testimony establishing a dispute as to the substantiality of the *Choir* excerpt and was unduly persuaded by its lay reading of the unpublished score, which appeared to the court brief and simplistic. The court thereby misapprehended the manner in which contemporary jazz and other modern forms of multiphonic, electronic, and world music are notated. Musical analysis involves substantially more than simply counting the number of notes or pitches on a page. This is particularly true for the avant-garde composition here, since "[i]n contemporary music, and particularly in the jazz music genre, musicians frequently move beyond traditional rules to create a range of dissonant and innovative sounds." *Tempo Music, Inc. v. Famous Music Corp.*, 838 F.Supp. 162, 168 (S.D.N.Y. 1993). *See also* W. Patry, 1 *Copyright Law and Practice*, 237 (1994) ("The scope of protection for music has suffered from a mistaken belief (undoubtedly limited to non-musicians) that 'the

vocabulary available for musical composition is far less rich and enables far less invention than the vocabulary of literature, drama and the visual arts.' This premise is no more true than the proposition that English literature is limited because there are only 26 letters in the alphabet.") (citation omitted).

In conclusion, by rejecting the summary judgment standard in practice (though not in word), the court below set a dangerous precedent that will affect a substantial number of musical compositions registered with the Copyright Office, especially novel or unusual forms of musical expression registered in the form of written notation. Unless this Court acts, the Ninth Circuit's abandonment of the summary judgment standard and denial of copyright protection for *Choir* renders a substantial body of jazz, electronic and contemporary works by some of America's most distinguished composers virtually unprotected by copyright law.

CONCLUSION

For the reasons discussed above, petitioner respectfully requests that the petition for a writ of certiorari be granted and the judgment below reversed.

Respectfully submitted,

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(Any footnotes trail end of each document)

No. 02-55983

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

JAMES W. NEWTON, JR., dba Janew Music,
Plaintiff-Appellant,

v.

MICHAEL DIAMOND; ADAM HOROWITZ; ADAM YAUCH, dba Beastie Boys; CAPITOL RECORDS, INC., a Delaware Corporation; GRAND ROYAL RECORDS, INC., a California Corporation; UNIVERSAL POLYGRAM INTERNATIONAL PUBLISHING, INC., a Delaware Corporation; BROOKLYN DUST MUSIC, an entity of unknown origin; MARIO CALDATO, JR., an individual; JANUS FILMS, LLC, a New York Limited Liability Company; CRITERION COLLECTION, a California Partnership; VOYAGER PUBLISHING COMPANY, INC., a Delaware Corporation; SONY MUSIC ENTERTAINMENT GROUP, a Delaware Corporation; BMG DIRECT MARKETING, INC., a Delaware Corporation; THE COLUMBIA HOUSE COMPANY, an entity of unknown origin,
Defendants-Appellees.

April 7, 2003, Argued and Submitted,
Pasadena, California
November 4, 2003, Filed

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JUDGES: Before: Mary M. Schroeder, Chief Judge, David R. Thompson, and Susan P. Graber, Circuit Judges. Opinion by Chief Judge Schroeder; Dissent by Judge Graber.

OPINION BY: SCHROEDER

OPINION: AMENDED OPINION AND AMENDED DISSENT

SCHROEDER, Chief Judge:

This appeal raises the difficult and important issue of whether the incorporation of a short segment of a musical recording into a new musical recording, i.e., the practice of "sampling," requires a license to use both the performance and the composition of the original recording. The particular sample in this case consists of a six-second, three-note segment of a performance of one of his own compositions by plaintiff, and accomplished jazz flutist, James W. Newton. The defendants, the performers who did the sampling, are the members of the musical group Beastie Boys. They

obtained a license to sample the sound recording of Newton's copyrighted performance, but they did not obtain a license to use Newton's underlying composition, which is also copyrighted.

The district court granted summary judgment to the defendants. In a scholarly opinion, it held that no license to the underlying composition was required because, as a matter of law, the notes in question -- C - D flat - C, over a held C note -- lacked sufficient originality to merit copyright protection. Newton v. Diamond, 204 F. Supp. 2d 1244, 1256 (C.D. Cal. 2002). The district court also held that even if the sampled segment of the composition were original, Beastie Boys' use of a brief segment of the sound recording of "Choir" was a de minimis use of the "Choir" composition and therefore was not actionable. Id. at 1259. We affirm on the ground that the use was de minimis.

Background and Procedural History

The plaintiff and appellant in this case, James W. Newton, is an accomplished avant-garde jazz flutist and composer. In 1978, he composed the song "Choir," a piece for flute and voice intended to incorporate elements of African-American gospel music, Japanese ceremonial court music, traditional African music, and classical music, among others. According to Newton, the song was inspired by his earliest memory of music, watching four women singing in a church in rural Arkansas. In 1981, Newton performed and recorded "Choir" and licensed all rights in the sound recording to ECM Records for $ 5000. n1 The license covered only the sound recording, and it is undisputed that Newton retained all rights to the composition of "Choir." Sound

recordings and their underlying compositions are separate works with their own distinct copyrights. 17 U.S.C. § 102(a)(2), (7).

The defendants and appellees include the members of the rap and hip-hop group Beastie Boys, and their business associates. In 1992, Beastie Boys obtained a license from ECM Records to use portions of the sound recording of "Choir" in various renditions of their song "Pass the Mic" in exchange for a one-time fee of $ 1000. n2 Beastie Boys did not obtain a license from Newton to use the underlying composition.

The portion of the composition at issue consists of three notes, C -- D flat -- C, sung over a background C note played on the flute. The score to "Choir" also indicates that the entire song should be played in a "largo/senza-misura" tempo, meaning "slowly/without-measure." The parties disagree about whether two additional elements appear in the score. First, Newton argues that the score contains an instruction that requires overblowing the background C note that is played on the flute. Second, Newton argues that multiphonics are part of the composition because they are necessarily created when a performer follows the instructions on the score to simultaneously play the flute note and sing the vocal notes. Because we review the district court's grant of summary judgment to the Beastie Boys, we must construe the evidence in Newton's favor. We therefore assume that these two elements are part of the "Choir" composition. As we will discuss more fully below, there are other elements that are part of Newton's performance that was captured in the sound recording, but that do not appear in the score.

The dispute between Newton and Beastie Boys centers around the copyright implications of the practice of sampling, a practice now common to many types of popular music. Sampling entails the incorporation of short segments of prior sound recordings into new recordings. The practice originated in Jamaica in the 1960s, when disc jockeys (DJs) used portable sound systems to mix segments of prior recordings into new mixes, which they would overlay with chanted or 'scatted' vocals. See Robert M. Szymanski, Audio Pasitiche: Digital Sampling, Intermediate Copying, Fair Use, 3 U.C.L.A. Ent. L. Rev. 271, 277 (Spring 1996). Sampling migrated to the United States and developed throughout the 1970s, using the analog technologies of the time. Id. The digital sampling involved here developed in the early 1980s with the advent of digital synthesizers having MIDI (Musical Instrument Digital Interface) keyboard controls. These digital instruments allowed artists digitally to manipulate and combine sampled sounds, expanding the range of possibilities for the use of prerecorded music. Whereas analog devices limited artists to "scratching" vinyl records and "cutting" back and forth between different sound recordings, digital technology allowed artists to slow down, speed up, combine, and otherwise alter the samples. See id.

Pursuant to their license from ECM Records, Beastie Boys digitally sampled the opening six seconds of Newton's sound recording of "Choir." Beastie Boys repeated or "looped" this six-second sample as a background element throughout "Pass the Mic," so that it appears over forty times in various renditions of the song. In addition to the version of "Pass the Mic" released on their 1992 album, "Check Your Head,"

Beastie Boys included the "Choir" sample in two remixes, "Dub the Mic" and "Pass the Mic (Pt. 2, Skills to Pay the Bills)." It is unclear whether the sample was altered or manipulated, though Beastie Boys' sound engineer stated that alterations of tone, pitch, and rhythm are commonplace, and Newton maintains that the pitch was lowered slightly.

Newton filed the instant action in federal court on May 9, 2000, alleging violations of his copyright in the underlying composition, as well as Lanham Act violations for misappropriation and reverse passing off. The district court dismissed Newton's Lanham Act claims on September 12, 2000, and granted summary judgment in favor of Beastie Boys on the copyright claims on May 21, 2002. Newton v. Diamond, 204 F. Supp. 2d 1244 (C.D. Cal. 2002). The district court held that the three-note segment of the "Choir" composition could not be copyrighted because, as a matter of law, it lacked the requisite originality. 204 F. Supp. 2d at 1256. The court also concluded that even if the segment were copyrightable, Beastie Boys' use of the work was de minimis and therefore not actionable. Id. at 1259. Newton appealed.

Whether Defendants' Use was De Minimis

We may affirm the grant of summary judgment on any basis supported by the record and need not reach each ground relied upon by the district court. See Venetian Casino Resort L.L.C. v. Local Joint Executive Bd. of Las Vegas, 257 F.3d 937, 941 (9th Cir. 2001), cert. denied, 535 U.S. 905, 152 L. Ed. 2d 142, 122 S. Ct. 1204 (2002). Assuming that the sampled segment of the composition was sufficiently original to merit copyright

protection, we nevertheless affirm on the ground that Beastie Boys' use was de minimis and therefore not actionable.

For an unauthorized use of a copyrighted work to be actionable, the use must be significant enough to constitute infringement. See Ringgold v. Black Entertainment TV, 126 F.3d 70, 74-75 (2d Cir. 1997). This means that even where the fact of copying is conceded, no legal consequences will follow from that fact unless the copying is substantial. See Laureyssens v. Idea Group, Inc., 964 F.2d 131, 140 (2d Cir. 1992); 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.03[A], at 13-30.2. The principle that trivial copying does not constitute actionable infringement has long been a part of copyright law. Indeed, as Judge Learned Hand observed over 80 years ago: "Even where there is some copying, that fact is not conclusive of infringement. Some copying is permitted. In addition to copying, it must be shown that this has been done to an unfair extent." West Publ'g Co. v. Edward Thompson Co., 169 F. 833, 861 (E.D.N.Y. 1909). This principle reflects the legal maxim, de minimis non curat lex (often rendered as, "the law does not concern itself with trifles"). See Ringgold, 126 F.3d at 74-75.

A leading case on de minimis infringement in our circuit is Fisher v. Dees, 794 F.2d 432 (9th Cir. 1986), where we observed that a use is de minimis only if the average audience would not recognize the appropriation. See id. at 434 n.2 ("[A] taking is considered de minimis only if it is so meager and fragmentary that the average audience would not recognize the appropriation."). This observation reflects the relationship between the de minimis maxim and the general test for substantial

similarity, which also looks to the response of the average audience, or ordinary observer, to determine whether a use is infringing. See, e.g., Cavalier v. Random House, Inc., 297 F.3d 815, 822 (9th Cir. 2002); Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc., 150 F.3d 132 (2d Cir. 1998) ("Two works are substantially similar where 'the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal [of the two works] as the same.'" (quoting Arica Inst., Inc. v. Palmer, 970 F.2d 1067, 1072 (2d Cir. 1992) (quoting Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960) (L. Hand, J.)))). To say that a use is de minimis because no audience would recognize the appropriation is thus to say that the use is not sufficiently significant.

On the facts of Fisher, this court rejected the de minimis defense because the copying was substantial: the defendant had appropriated the main theme and lyrics of the plaintiff's song, both of which were easily recognizable in the defendant's parody. 794 F.2d at 434 & n.2. Specifically, the defendant copied six of the thirty-eight bars to the 1950s standard, "When Sunny Gets Blue," to make the parody, "When Sonny Sniffs Glue," and paralleled the original lyrics with only minor variations. Id. However, despite the works' substantial similarities, we held that the use was nevertheless non-infringing because, as a parody, it was "fair use" under 17 U.S.C. § 107. Id. at 440. We explained that the defendant's successful fair use defense precluded a finding that the use was insubstantial or unrecognizable because "the parodist must appropriate a substantial enough portion of [the original] to evoke recognition." Id. at 435 n.2.

This case involves not only use of a composition, as was the case in Fisher, but also use of a sound recording of a particular performance of that composition. Because the defendants were authorized to use the sound recording, our inquiry is confined to whether the unauthorized use of the composition itself was substantial enough to sustain an infringement claim. Therefore, we may consider only Beastie Boys' appropriation of the song's compositional elements and must remove from consideration all the elements unique to Newton's performance. Stated another way, we must "filter out" the licensed elements of the sound recording to get down to the unlicensed elements of the composition, as the composition is the sole basis for Newton's infringement claim. See Cavalier, 297 F.3d at 822; Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1446 (9th Cir. 1994).

In filtering out the unique performance elements from consideration, and separating them from those found in the composition, we find substantial assistance in the testimony of Newton's own experts. Because we are reviewing a grant of summary judgment in favor of the Beastie Boys, we must view the evidence in the light most favorable to Newton and affirm only if there is no genuine issue of material fact. Newton's experts, however, reveal the extent to which the sound recording of "Choir" is the product of Newton's highly developed performance techniques, rather than the result of a generic rendition of the composition. As a general matter, according to Newton's expert Dr. Christopher Dobrian, "the contribution of the performer is often so great that s/he in fact provides as much musical content as the composer." This is particularly true with works like "Choir," given the

improvisational nature of jazz performance and the minimal scoring of the composition. Indeed, as Newton's expert Dr. Oliver Wilson explained:The copyrighted score of "Choir", as is the custom in scores written in the jazz tradition, does not contain indications for all of the musical subtleties that it is assumed the performer-composer of the work will make in the work's performance. The function of the score is more mnemonic in intention than prescriptive.And it is clear that Newton goes beyond the score in his performance. For example, Dr. Dobrian declared that "Mr. Newton blows and sings in such a way as to emphasize the upper partials of the flute's complex harmonic tone, [although] such a modification of tone color is not explicitly requested in the score." Dr. Dobrian also concludes that Newton "uses breath control to modify the timbre of the sustained flute note rather extremely" and "uses portamento to glide expressively from one pitch to another in the vocal part." Dr. Dobrian concedes that these elements do not appear in the score, and that they are part of Newton's performance of the piece.

A crucial problem with the testimony of Newton's experts is that they continually refer to the "sound" produced by the "Newton technique." A sound is protected by copyright law only when it is "fixed in a tangible medium." 17 U.S.C. § 102(a). Here, the only time any sound was fixed in a tangible medium was when a particular performance was recorded. Newton licensed the recording at issue to ECM Records over twenty years ago, and ECM Records in turn licensed the interest in the recording to the Beastie Boys. Newton's copyright extends only to the elements that he fixed in a tangible medium -- those that he wrote on

the score. Thus, regardless of whether the average audience might recognize the "Newton technique" at work in the sampled sound recording, those performance elements are beyond consideration in Newton's claim for infringement of his copyright in the underlying composition.

Once we have isolated the basis of Newton's infringement action -- the "Choir" composition, devoid of the unique performance elements found only in the sound recording -- we turn to the nub of our inquiry: whether Beastie Boys' unauthorized use of the composition, as opposed to their authorized use of the sound recording, was substantial enough to sustain an infringement action. In answering that question, we must distinguish between whether there is a high enough degree of similarity between the works to establish copying, and whether that copying is substantial enough to constitute infringement. Cf. Ringgold, 126 F.3d at 74-75; 4 Nimmer § 13.03[A][2], at 13-45. The practice of music sampling will often present cases where the degree of similarity is high. Indeed, unless the sample has been altered or digitally manipulated, it will be identical to the sampled portion of the original recording. Yet as Nimmer explains, "[if] the similarity is only as to nonessential matters, then a finding of no substantial similarity should result." 4 Nimmer § 13.03[A][2], at 13-48; cf. Warner Bros. v. Am. Broad. Cos., 720 F.2d 231, 242 (2d. Cir. 1983). This reflects the principle that the substantiality requirement applies throughout the law of copyright, including cases of music sampling, even where there is a high degree of similarity.

The high degree of similarity between the works here (i.e., "Pass the Mic" and "Choir"), but the limited scope of the copying, place Newton's claim for infringement into the class of cases that allege what Nimmer refers to as "fragmented literal similarity." 4 Nimmer § 13.03[A][2], at 13-45. Fragmented literal similarity exists where the defendant copies a portion of the plaintiff's work exactly or nearly exactly, without appropriating the work's overall essence or structure. Id. Because the degree of similarity is high in such cases, the dispositive question is whether the copying goes to trivial or substantial elements. Substantiality is measured by considering the qualitative and quantitative significance of the copied portion in relation to the plaintiff's work as a whole. See, e.g., Worth v. Selchow & Righter Co., 827 F.2d 569, 570 n. 1 (9th Cir. 1987) ("The relevant inquiry is whether a substantial portion of the protectible material in the plaintiff's work was appropriated -- not whether a substantial portion of defendant's work was derived from plaintiff's work."); Jarvis v. A&M Records, 827 F. Supp. 282, 289-90 (D.N.J. 1993); 4 Nimmer § 13.03[A][2], at 13-47 to 48 & n.97. This focus on the sample's relation to the plaintiff's work as a whole embodies the fundamental question in any infringement action, as expressed more than 150 years ago by Justice Story: whether "so much is taken[] that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another." Folsom v. Marsh, 9 F. Cas. 342, 348, F. Cas. No. 4901 (C.C. Mass. 1841) (No. 4901). Courts also focus on the relationship to the plaintiff's work because a contrary rule that measured the significance of the copied segment in the defendant's work would allow an unscrupulous defendant to copy

large or qualitatively significant portions of another's work and escape liability by burying them beneath non-infringing material in the defendant's own work, even where the average audience might recognize the appropriation. Cf. Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 56 (2d Cir. 1936) ("It is enough that substantial parts were lifted; no plagiarist can excuse the wrong by showing how much of his work he did not pirate."). Thus, as the district court properly concluded, the fact that Beastie Boys "looped" the sample throughout "Pass the Mic" is irrelevant in weighing the sample's qualitative and quantitative significance. See Newton, 204 F. Supp. 2d at 1257.

On the undisputed facts of this record, no reasonable juror could find the sampled portion of the composition to be a quantitatively or qualitatively significant portion of the composition as a whole. Quantitatively, the three-note sequence appears only once in Newton's composition. It is difficult to measure the precise relationship between this segment and the composition as a whole, because the score calls for between 180 and 270 seconds of improvisation. When played, however, the segment lasts six seconds and is roughly two percent of the four-and-a-half-minute "Choir" sound recording licensed by Beastie Boys. Qualitatively, this section of the composition is no more significant than any other section. Indeed, with the exception of two notes, the entirety of the scored portions of "Choir" consist of notes separated by whole- and half-steps from their neighbors and is played with the same technique of singing and playing the flute simultaneously; the remainder of the composition calls for sections of improvisation that range between 90 and 180 seconds in length.

The Beastie Boys' expert, Dr. Lawrence Ferrara, concludes that the compositional elements of the sampled section do not represent the heart or the hook of the "Choir" composition, but rather are "simple, minimal and insignificant." The sampled section may be representative of the scored portions of the composition as Newton's expert's contend. Newton has failed to offer any evidence, however, to rebut Dr. Ferrara's testimony and to create a triable issue of fact on the key question, which is whether the sampled section is a qualitatively significant portion of the "Choir" composition as a whole. Instead, Newton's experts emphasize the uniqueness of the "Newton technique," which is found throughout the "Choir" composition and in Newton's other work.

Newton nevertheless maintains that the testimony of his experts creates a genuine issue of material fact on the substantiality of the copying. To the extent the expert testimony is relevant, it is not helpful to Newton. On the key question of whether the sample is quantitatively or qualitatively significant in relation to the composition as a whole, his experts are either silent or fail to distinguish between the sound recording, which was licensed, and the composition, which was not. Moreover, their testimony on the composition does not contain anything from which a reasonable jury could infer the segment's significance in relation to the composition as a whole. In contrast, Dr. Ferrara stated that the sampled excerpt from the "Choir" composition "is merely a common, trite, and generic three-note sequence, which lacks any distinct melodic, harmonic, rhythmic or structural elements." He described the sequence as "a common building block tool" that "has been used over and over again by major composers in

the 20th century, particularly in the '60s and '70s, just prior to James Newton's usage."

Because Newton conceded that "Choir" and "Pass the Mic" "are substantially dissimilar in concept and feel, that is, in [their] overall thrust and meaning" and failed to offer any evidence to rebut Dr. Ferrara's testimony that the sampled section is not a quantitatively or qualitatively significant portion of the "Choir" composition, the Beastie Boys are entitled to prevail on summary judgment. On the undisputed facts of this case, we conclude that an average audience would not discern Newton's hand as a composer, apart from his talent as a performer, from Beastie Boys' use of the sample. The copying was not significant enough to constitute infringement. Beastie Boys' use of the "Choir" composition was de minimis. There is no genuine issue of material fact, and the grant of summary judgment was appropriate.

Conclusion

Because Beastie Boys' use of the sound recording was authorized, the sole basis of Newton's infringement action is his remaining copyright interest in the "Choir" composition. We hold that Beastie Boys' use of a brief segment of that composition, consisting of three notes separated by a half-step over a background C note, is not sufficient to sustain a claim for infringement of Newton's copyright in the composition "Choir". We affirm the district court's grant of summary judgment on the ground that Beastie Boys' use of the composition was de minimis and therefore not actionable.

AFFIRMED

Footnotes

n1 In relevant part, the license reads as follows:1) [Newton] herewith grants, transfers and assigns to ECM without limitations and restrictions whatsoever the exclusive rights to record his performances and to exploit these recordings in perpetuity throughout the world in any manner whatsoever.

. . . .

3) The grant of rights according to section 1) especially, includes the rights to manufacture in quantitiy [sic], to distribute, to license to others, as well as to perform the recordings in public and to utilize it in radio, TV, or in other ways without any restrictions.

n2 In relevant part, the license reads as follows:[ECM Records], as owner of the applicable sound recording rights, including but not limited to recording, reproduction, synchronization and performing rights, grants to Beastie Boys, its licensees, assigns, employees and agents (the "Licensed Parties"), the irrevocable non-exclusive license and right to copy portions (if any) of the sound recording entitled "Choir" performed by James Newton (the "Sample"); to embody the sample in some or all versions of the selection entitled "Pass the Mic" by the Beastie Boys (all versions of "Pass the Mic" which contain the Sample are referred to as the "Selection"); to reproduce, distribute and otherwise exploit the Sample as part of the Selection in all media, whether now known or hereinafter developed, including, without limitation, all record formats throughout the world in perpetuity.

DISSENTBY: GRABER

DISSENT: GRABER, Circuit Judge, dissenting:

I respectfully dissent. The majority has laid out correctly the legal principles that apply in this case, and I agree with the majority's assumption that the sampled portion of "Choir" qualifies as "original" and therefore is copyrightable. Maj. op. at 15783. However, on the record before us, a finder of fact reasonably could find that Beastie Boys' use of the sampled material was not de minimis. Therefore, summary judgment is inappropriate.

As the majority observes, a use is de minimis only if an average audience would not recognize the appropriation. Fisher v. Dees, 794 F.2d 432, 434 n.2 (9th Cir. 1986). The majority is correct that James Newton's considerable skill adds many recognizable features to the performance sampled by Beastie Boys. Even after those features are "filtered out," however, the composition, standing alone, is distinctive enough for a fact-finder reasonably to conclude that an average audience would recognize the appropriation of the sampled segment and that Beastie Boys' use was therefore not de minimis.

Newton has presented evidence that the compositional elements of "Choir" are so compositionally distinct that a reasonable listener would recognize the sampled segment even if it were performed by the featured flautist of a middle school orchestra. It is useful to begin by observing that the majority's references to the sampled segment of "Choir" as a "3 note sequence" n1 are overly simplified. The sampled segment is actually a

three-note sequence sung above a fingered held C note, for a total of four separate tones. n2 Even passages with relatively few notes may be qualitatively significant. The opening melody of Beethoven's Fifth Symphony is relatively simple and features only four notes, but it certainly is compositionally distinctive and recognizable.

The majority, while citing the correct standard of review, fails fully to apply it. First, the majority usurps the function of the fact-finder by weighing the opinions of the various experts and emphasizing some parts of their testimony over others. Maj. op. at 15785-87, 15789-90. The majority also fails to interpret the evidence in Newton's favor when, for example, it asserts that Newton's experts failed to distinguish between the sound recording and the composition. Id. at 15790. To the contrary, Newton presented expert evidence that the composition alone is distinctive and recognizable.

First, Newton offered a letter from Professor Olly Wilson of the University of California at Berkeley. Professor Wilson acknowledges that much of the distinctiveness of the sampled material is due to Newton's performance and that the copyrighted score does not fully convey the quality of the piece as performed. Nevertheless, Professor Wilson concludes that the scoreclearly indicates that the performer will simultaneously sing and finger specific pitches, gives a sense of the rhythm of the piece, and also provides the general structure of this section of the piece. Hence, in my opinion, the digital sample of the performance . . . is clearly a realization of the musical score filed with the copyright office.

Second, Newton presented a letter from Professor Christopher Dobrian of the University of California, Irvine, which concludes:Applying traditional analysis to this brief excerpt from Newton's "Choir"--i.e., focusing solely on the notated pitches--a theorist could conclude (erroneously, in my opinion) that the excerpt contains an insignificant amount of information because it contains a simple "neighboring-tone" figure: C to D-flat and back to C. . . . If, on the other hand, one considers the special playing technique described in the score (holding one fingered note constant while singing the other pitches) and the resultant complex, expressive effect that results, it is clear that the "'unique expression" of this excerpt is not solely in the pitch choices, but is actually in those particular pitches performed in that particular way on that instrument. These components in this particular combination are not found anywhere else in the notated music literature, and they are unique and distinctive in their sonic/musical result.(Emphasis added.)

Professor Dobrian is not talking about Newton's performance of the sampled portion. Rather, he is speaking of the distinctiveness of the underlying composition. The "playing technique" is not a matter of personal performance, but is a built-in feature of the score itself. In essence, Dobrian is stating that any flautist's performance of the sampled segment would be distinctive and recognizable, because the score itself is distinctive and recognizable.

The majority, then, reads the record selectively when it states that Newton failed to offer sufficient evidence that the sampled material is qualitatively significant. In fact, Newton presented evidence, as described above,

to show that an average and reasonable listener would recognize Beastie Boys' appropriation of the composition of the sampled material. n3

The majority also asserts that Newton failed to offer evidence to rebut Beastie Boys' expert on the question whether the sampled section of "Choir" is qualitatively significant. Maj. op. at 15789-90. Again, the majority improperly discounts, or improperly interprets, Dr. Dobrian's unequivocal description of the sampled passage: "These components in this particular combination are not found anywhere else in the notated music literature, and they are unique and distinctive in their sonic/musical result." A fact-finder would be entitled to find either that the sampled passage is trivial and trite (Beastie Boys' expert) or, instead, that it is "unique and distinctive" in the musical literature (Newton's expert).

Because Newton has presented evidence establishing that reasonable ears differ over the qualitative significance of the composition of the sampled material, summary judgment is inappropriate in this case. Newton should be allowed to present his claims of infringement to a fact-finder. I therefore dissent from the majority's conclusion to the contrary.

[SEE APPENDIX IN ORIGINAL]
Footnotes

n1 Maj. op. at 15779, 15789.

n2 The sampled segment of the composition is scored as shown in the Appendix.

n3 Because Newton has established that a fact-finder reasonably could find that the sampled portion of "Choir" is qualitatively significant, we need not address the question of the portion's quantitative significance. See Worth v. Selchow & Righter Co., 827 F.2d 569, 570 n.1 (9th Cir. 1987) (noting that "a determination of the qualitative importance of the material to the plaintiff's work is more significant than a quantitative calculation of the portion allegedly appropriated by the defendant").

No. 02-55983

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

JAMES W. NEWTON, JR., dba Janew Music,
Plaintiff-Appellant,

v.

MICHAEL DIAMOND; ADAM HOROWITZ; ADAM YAUCH, dba Beastie Boys; CAPITOL RECORDS, INC., a Delaware Corporation; GRAND ROYAL RECORDS, INC., a California Corporation; UNIVERSAL POLYGRAM INTERNATIONAL PUBLISHING, INC., a Delaware Corporation; BROOKLYN DUST MUSIC, an entity of unknown origin; MARIO CALDATO, JR., an individual; JANUS FILMS, LLC, a New York Limited Liability Company; CRITERION COLLECTION, a California Partnership; VOYAGER PUBLISHING COMPANY, INC., a Delaware Corporation; SONY MUSIC ENTERTAINMENT GROUP, a Delaware Corporation; BMG DIRECT MARKETING, INC., a Delaware Corporation; THE COLUMBIA HOUSE COMPANY, an entity of unknown origin,
Defendants-Appellees.

November 4, 2003, Filed

COUNSEL: Alan Korn, Law Offices of Alan Korn, Berkeley, California, for the plaintiff-appellant.

Adam F. Streisand and David C. Nelson, Loeb & Loeb, LLP, and Barry E. Mallen, Manatt, Phelps & Phillips,

LLP, Los Angeles, California, for the defendants-appellees.

Todd M. Gascon, Law Offices of Todd M. Gascon, and Sarah Sevier Farnbach, Phillips & Erlewin, LLP, San Francisco, California, for the amici curiae.

JUDGES: Before: Mary M. Schroeder, Chief Judge, David R. Thompson, and Susan P. Graber, Circuit Judges. Opinion by Chief Judge Schroeder; Dissent by Judge Graber.

OPINION BY: Mary M. Schroeder

OPINION: SCHROEDER, Chief Judge:

This appeal raises the difficult and important issue of whether the incorporation of a short segment of a musical recording into a new musical recording, i.e., the practice of "sampling," requires a license to use both the performance and the composition of the original recording. The particular sample in this case consists of a six-second, three-note segment of a performance of one of his own compositions by plaintiff, and accomplished jazz flutist, James W. Newton. The defendants, the performers who did the sampling, are the members of the musical group Beastie Boys. They obtained a license to sample the sound recording of Newton's copyrighted performance, but they did not obtain a license to use Newton's underlying composition, which is also copyrighted.

The district court granted summary judgment to the defendants. In a scholarly opinion, it held that no license to the underlying composition was required

because, as a matter of law, the notes in question -- C - D flat - C, over a held C note -- lacked sufficient originality to merit copyright protection. Newton v. Diamond, 204 F. Supp. 2d 1244, 1256 (C.D. Cal. 2002). The district court also held that even if the sampled segment of the composition were original, Beastie Boys' use was de minimis and therefore not actionable. Id. at 1259. We affirm on the ground that the use was de minimis.

Background and Procedural History

The plaintiff and appellant in this case, James W. Newton, is an accomplished avant-garde jazz flutist and composer. In 1978, he composed the song "Choir," a piece for flute and voice intended to incorporate elements of African-American gospel music, Japanese ceremonial court music, traditional African music, and classical music, among others. According to Newton, the song was inspired by his earliest memory of music, watching four women singing in a church in rural Arkansas. In 1981, Newton performed and recorded "Choir" and licensed all rights in the sound recording to ECM Records for $ 5000. n1 The license covered only the sound recording, and it is undisputed that Newton retained all rights to the composition of "Choir." Sound recordings and their underlying compositions are separate works with their own distinct copyrights. 17 U.S.C. § 102(a)(2), (7).

The defendants and appellees include the members of the rap and hip-hop group Beastie Boys, and their business associates. In 1992, Beastie Boys obtained a license from ECM Records to use portions of the sound recording of "Choir" in various renditions of their song

"Pass the Mic" in exchange for a one-time fee of $ 1000. n2 Beastie Boys did not obtain a license from Newton to use the underlying composition.

The portion of the composition at issue consists of three notes, C - D flat - C, sung over a background C note played on the flute. When played on the sound recording licensed by Beastie Boys, the segment lasts for approximately six seconds. The score to "Choir" also indicates that the entire song should be played in a "largo/senza-misura" tempo, meaning "slowly/without-measure." Apart from an instruction that the performer sing into the flute and finger simultaneously, the score is not further orchestrated.

The dispute between Newton and Beastie Boys centers around the copyright implications of the practice of sampling, a practice now common to many types of popular music. Sampling entails the incorporation of short segments of prior sound recordings into new recordings. The practice originated in Jamaica in the 1960s, when disc jockeys (DJs) used portable sound systems to mix segments of prior recordings into new mixes, which they would overlay with chanted or 'scatted' vocals. See Robert M. Szymanski, Audio Pasitiche: Digital Sampling, Intermediate Copying, Fair Use, 3 U.C.L.A. Ent. L. Rev. 271, 277 (Spring 1996). Sampling migrated to the United States and developed throughout the 1970s, using the analog technologies of the time. Id. The digital sampling involved here developed in the early 1980s with the advent of digital synthesizers having MIDI (Musical Instrument Digital Interface) keyboard controls. These digital instruments allowed artists digitally to manipulate and combine sampled sounds, expanding the

range of possibilities for the use of pre-recorded music. Whereas analog devices limited artists to "scratching" vinyl records and "cutting" back and forth between different sound recordings, digital technology allowed artists to slow down, speed up, combine, and otherwise alter the samples. See id.

Pursuant to their license from ECM Records, Beastie Boys digitally sampled the opening six seconds of Newton's sound recording of "Choir." Beastie Boys repeated or "looped" this six-second sample as a background element throughout "Pass the Mic," so that it appears over forty times in various renditions of the song. In addition to the version of "Pass the Mic" released on their 1992 album, "Check Your Head," Beastie Boys included the "Choir" sample in two remixes, "Dub the Mic" and "Pass the Mic (Pt. 2, Skills to Pay the Bills)." It is unclear whether the sample was altered or manipulated, though Beastie Boys' sound engineer stated that alterations of tone, pitch, and rhythm are commonplace, and Newton maintains that the pitch was lowered slightly.

Newton filed the instant action in federal court on May 9, 2000, alleging violations of his copyright in the underlying composition, as well as Lanham Act violations for misappropriation and reverse passing off. The district court dismissed Newton's Lanham Act claims on September 12, 2000, and granted summary judgment in favor of Beastie Boys on the copyright claims on May 21, 2002. Newton v. Diamond, 204 F. Supp. 2d 1244 (C.D.Cal. 2002). The district court held that the three-note segment of the "Choir" composition could not be copyrighted because, as a matter of law, it lacked the requisite originality. 204 F. Supp. 2d at 1256.

The court also concluded that even if the segment were copyrightable, Beastie Boys' use of the work was de minimis and therefore not actionable. Id. at 1259. Newton appealed.

Whether Defendants' Use was De Minimis

We may affirm the grant of summary judgment on any basis supported by the record and need not reach each ground relied upon by the district court. See Venetian Casino Resort L.L.C. v. Local Joint Executive Bd. of Las Vegas, 257 F.3d 937, 941 (9th Cir. 2001), cert. denied, 535 U.S. 905, 152 L. Ed. 2d 142, 122 S. Ct. 1204 (2002). Assuming that the sampled segment of the composition was sufficiently original to merit copyright protection, we nevertheless affirm on the ground that Beastie Boys' use was de minimis and therefore not actionable.

For an unauthorized use of a copyrighted work to be actionable, there must be substantial similarity between the plaintiff's and the defendants' works. See Ringgold v. Black Entm't Television, Inc., 126 F.3d 70, 74 (2d Cir. 1997); Ideal Toy Corp. v. Fab-Lu Ltd. (Inc.), 360 F.2d 1021, 1022 (2d Cir. 1966). This means that even where the fact of copying is conceded, no legal consequences will follow from that fact unless the copying is substantial. See Laureyssens v. Idea Group, Inc., 964 F.2d 131, 140 (2d Cir. 1992); 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.03[A], at 13-30.2. The principle that trivial copying does not constitute actionable infringement has long been a part of copyright law. Indeed, as Judge Learned Hand observed over 80 years ago: "Even where there is some copying, that fact is not conclusive of

infringement. Some copying is permitted. In addition to copying, it must be shown that this has been done to an unfair extent." West Publ'g Co. v. Edward Thompson Co., 169 F. 833, 861 (E.D.N.Y. 1909). This principle reflects the legal maxim, de minimis non curat lex (often rendered as, "the law does not concern itself with trifles"). See Ringgold, 126 F.3d at 74-75.

The leading case on de minimis infringement in our circuit is Fisher v. Dees, 794 F.2d 432 (9th Cir. 1986), where we observed that a use is de minimis only if the average audience would not recognize the appropriation. See id. at 434 n.2 ("[A] taking is considered de minimis only if it is so meager and fragmentary that the average audience would not recognize the appropriation."). This observation reflects the relationship between the de minimis maxim and the general test for substantial similarity, which also looks to the response of the average audience, or ordinary observer, to determine whether a use is infringing. See, e.g., Cavalier v. Random House, Inc., 297 F.3d 815, 822 (9th Cir. 2002); Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc., 150 F.3d 132 (2d Cir. 1998) ("Two works are substantially similar where 'the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal [of the two works] as the same.'" (quoting Arica Inst., Inc. v. Palmer, 970 F.2d 1067, 1072 (2d Cir. 1992) (quoting Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960) (L. Hand, J.)))). To say that a use is de minimis because no audience would recognize the appropriation is thus to say that the works are not substantially similar.

On the facts of Fisher, this court rejected the de minimis defense because the copying was substantial: the defendant had appropriated the main theme and lyrics of the plaintiff's song, both of which were easily recognizable in the defendant's parody. 794 F.2d at 434 & n.2. Specifically, the defendant copied six of the thirty-eight bars to the 1950s standard, "When Sunny Gets Blue," to make the parody, "When Sonny Sniffs Glue," and paralleled the original lyrics with only minor variations. Id. However, despite the works' substantial similarities, we held that the use was nevertheless non-infringing because, as a parody, it was "fair use" under 17 U.S.C. § 107. Id. at 440. We explained that the defendant's successful fair use defense precluded a finding that the use was insubstantial or unrecognizable because "the parodist must appropriate a substantial enough portion of [the original] to evoke recognition." Id. at 435 n.2.

This case involves not only use of a composition, as was the case in Fisher, but also use of a sound recording of a performance of that composition. Because the defendants licensed the sound recording, our inquiry is confined to whether the unauthorized use of the composition itself was substantial enough to sustain an infringement claim. Therefore, we may consider only Beastie Boys' appropriation of the song's compositional elements and must remove from consideration all the elements unique to Newton's performance. Stated another way, we must "filter out" the licensed elements of the sound recording to get down to the unlicensed elements of the composition, as the composition is the sole basis for Newton's infringement claim. See Cavalier, 297 F.3d at 822; Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1446 (9th Cir. 1994).

In filtering out the unique performance elements from consideration, and separating them from those found in the composition, we find substantial assistance in the testimony of Newton's own experts. His experts reveal the extent to which the sound recording of "Choir" is the product of Newton's highly developed performance techniques, rather than the result of a generic rendition of the composition. As a general matter, according to Newton's expert Dr. Christopher Dobrian, "the contribution of the performer is often so great that s/he in fact provides as much musical content as the composer." This is particularly true with works like "Choir," given the nature of jazz performance and the minimal scoring of the composition. Indeed, as Newton's expert Dr. Oliver Wilson explained:The copyrighted score of "Choir", as is the custom in scores written in the jazz tradition, does not contain indications for all of the musical subtleties that it is assumed the performer-composer of the work will make in the work's performance. The function of the score is more mnemonic in intention than prescriptive.And it is clear that Newton goes beyond the score in his performance. For example, Dr. Dobrian declared that "Mr. Newton blows and sings in such a way as to emphasize the upper partials of the flute's complex harmonic tone, [although] such a modification of tone color is not explicitly requested in the score." More generally, Dr. Wilson explained Newton's performance technique as follows:The Newton technique produces a musical event in which the component sounds resulting from the simultaneous singing of one or more pitches and the interaction of this pitch or pitches with the various components of the multiphonic array of pitches produced on the flute create a relatively dense cluster

of pitches and ambient sounds that sometimes change over time.

Whatever copyright interest Newton obtained in this "dense cluster of pitches and ambient sounds," he licensed that interest to ECM Records over twenty years ago, and ECM Records in turn licensed that interest to Beastie Boys. Thus, regardless of whether the average audience might recognize "the Newton technique" at work in the sampled sound recording, those performance elements are beyond consideration in Newton's claim for infringement of his copyright in the underlying composition. Having licensed away his interest in the recording of his performance, Newton's only claim is for a violation of his rights in the three-note sequence transcribed in the composition.

Once we have isolated the basis of Newton's infringement action -- the "Choir" composition, devoid of the unique performance elements found only in the sound recording -- we turn to the nub of our inquiry: whether Beastie Boys' unauthorized use of the composition, as opposed to their authorized use of the sound recording, was substantial enough to sustain an infringement action. In answering that question, we must distinguish between the degree and the substantiality of the works' similarity. Cf. Ringgold, 126 F.3d at 74-75; 4 Nimmer § 13.03[A][2], at 13-45. The practice of music sampling will often present cases where the degree of similarity is high. Indeed, unless the sample has been altered or digitally manipulated, it will be identical to the original. Yet as Nimmer explains, "[if] the similarity is only as to nonessential matters, then a finding of no substantial similarity should result." 4 Nimmer § 13.03[A][2], at 13-48; cf.

Warner Bros. v. Am. Broad. Cos., 720 F.2d 231, 242 (2d. Cir. 1983). This reflects the principle that the substantiality requirement applies throughout the law of copyright, including cases of music sampling, even where there is a high degree of similarity.

The high degree but limited scope of similarity between the works here place Newton's claim for infringement into the class of cases that allege what Nimmer refers to as "fragmented literal similarity." 4 Nimmer § 13.03[A][2], at 13-45. Fragmented literal similarity exists where the defendant copies a portion of the plaintiff's work exactly or nearly exactly, without appropriating the work's overall essence or structure. Id. Because the degree of similarity is high in such cases, the dispositive question is whether the similarity goes to trivial or substantial elements. The substantiality of the similarity is measured by considering the qualitative and quantitative significance of the copied portion in relation to the plaintiff's work as a whole. See, e.g., Worth v. Selchow & Righter Co., 827 F.2d 569, 570 n. 1 (9th Cir. 1987) ("The relevant inquiry is whether a substantial portion of the protectible material in the plaintiff's work was appropriated -- not whether a substantial portion of defendant's work was derived from plaintiff's work."); Jarvis v. A&M Records, 827 F. Supp. 282, 289-90 (D.N.J. 1993); 4 Nimmer § 13.03[A][2], at 13-47 to 48 & n.97. This focus on the sample's relation to the plaintiff's work as a whole embodies the fundamental question in any infringement action, as expressed more than 150 years ago by Justice Story: whether "so much is taken[] that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another." Folsom v.

Marsh, 9 F. Cas. 342, 348, F. Cas. No. 4901 (C.C. Mass. 1841) (No. 4901). Courts also focus on the relationship to the plaintiff's work because a contrary rule that measured the significance of the copied segment in the defendant's work would allow an unscrupulous defendant to copy large or qualitatively significant portions of another's work and escape liability by burying them beneath non-infringing material in the defendant's own work, even where the average audience might recognize the appropriation. Cf. Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 56 (2d Cir. 1936) ("It is enough that substantial parts were lifted; no plagiarist can excuse the wrong by showing how much of his work he did not pirate."). Thus, as the district court properly concluded, the fact that Beastie Boys "looped" the sample throughout "Pass the Mic" is irrelevant in weighing the sample's qualitative and quantitative significance. See Newton, 204 F. Supp. 2d at 1257.

When viewed in relation to Newton's composition as a whole, the sampled portion is neither quantitatively nor qualitatively significant. Quantitatively, the three-note sequence appears only once in Newton's composition. It is difficult to measure the precise relationship between this segment and the composition as a whole, because the score calls for between 180 and 270 seconds of improvisation. When played, however, the segment lasts six seconds and is roughly two percent of the four-and-a-half-minute "Choir" sound recording licensed by Beastie Boys. Qualitatively, this section of the composition is no more significant than any other section. Indeed, with the exception of two notes, the entirety of the scored portions of "Choir" consist of notes separated by whole- and half-steps from their

neighbors; the remainder of the composition calls for sections of improvisation that range between 90 and 180 seconds in length. Although the sampled section may be representative of the scored portions of the composition, Newton has failed to offer any evidence as to this section's particular significance in the composition as a whole. Instead, his experts emphasize the significance of Newton's performance, the unique elements of which Beastie Boys properly licensed.

Yet Newton maintains that the testimony of his experts creates a genuine issue of material fact on the substantiality of the copying. To the extent the expert testimony is relevant, it is not helpful to Newton. On the key question of whether the sample is quantitatively or qualitatively significant in relation to the composition as a whole, his experts are either silent or fail to distinguish between the sound recording, which was licensed, and the composition, which was not. Moreover, their testimony on the composition does not contain anything from which a reasonable jury could infer the segment's significance in relation to the composition as a whole: rather, Dr. Dobrian described the three-note sequence at issue as "a simple 'neighboring tone' figure." The district court cited two pieces by Gyorgy Ligeti and Jacob Druckman employing similar figures. Newton, 204 F. Supp. 2d at 1255. This evidence is consistent with the opinion of Beastie Boys' expert, Dr. Lawrence Ferrara, who stated that the sampled excerpt from the "Choir" composition "is merely a common, trite, and generic three-note sequence, which lacks any distinct melodic, harmonic, rhythmic or structural elements." Dr. Ferrara also described the sequence as "a common building block tool" used over and over again by major

composers in the 20th century, particularly the '60s and '70s, just prior to James Newton's usage."

Having failed to demonstrate any quantitative or qualitative significance of the sample in the "Choir" composition as a whole, Newton is in a weak position to argue that the similarities between the works are substantial, or that an average audience would recognize the appropriation. In this respect, the minimal scoring of the "Choir" composition bears emphasis, as does the relative simplicity of the relevant portion of the composition. On the undisputed facts of this case, we conclude that an average audience would not discern Newton's hand as a composer, apart from his talent as a performer, from Beastie Boys' use of the sample. The works are not substantially similar: Beastie Boys' use of the "Choir" composition was de minimis. There is no genuine issue of material fact, and the grant of summary judgment was appropriate.

Conclusion

Because Beastie Boys' use of the sound recording was authorized, the sole basis of Newton's infringement action is his remaining copyright interest in the "Choir" composition. We hold today that Beastie Boys' use of a brief segment of that composition, consisting of three notes separated by a half-step over a background C note, is not sufficient to sustain a claim for copyright infringement. We affirm the district court's grant of summary judgment on the ground that Beastie Boys' use of the composition was de minimis and therefore not actionable.

AFFIRMED

APPENDIX

[SEE FIGURE IN ORIGINAL]

Footnotes

n1 In relevant part, the license reads as follows:1) [Newton] herewith grants, transfers and assigns to ECM without limitations and restrictions whatsoever the exclusive rights to record his performances and to exploit these recordings in perpetuity throughout the world in any manner whatsoever.

. . . .

3) The grant of rights according to section 1) especially, includes the rights to manufacture in quantitiy [sic], to distribute, to license to others, as well as to perform the recordings in public and to utilize it in radio, TV, or in other ways without any restrictions.

n2 In relevant part, the license reads as follows:[ECM Records], as owner of the applicable sound recording rights, including but not limited to recording, reproduction, synchronization and performing rights, grants to Beastie Boys, its licensees, assigns, employees and agents (the "Licensed Parties"), the irrevocable non-exclusive license and right to copy portions (if any) of the sound recording entitled "Choir" performed by James Newton (the "Sample"); to embody the sample in some or all versions of the selection entitled "Pass the Mic" by the Beastie Boys (all versions of "Pass the Mic" which contain the Sample are referred to as the "Selection"); to reproduce, distribute and otherwise exploit the Sample as part of the Selection in all media,

whether now known or hereinafter developed, including, without limitation, all record formats throughout the world in perpetuity.

DISSENT BY: Susan P. Graber

DISSENT: GRABER, Circuit Judge, dissenting:

I respectfully dissent. The majority has laid out correctly the legal principles that apply in this case, and I agree with the majority's assumption that the sampled portion of "Choir" qualifies as "original" and therefore is copyrightable. Maj. op. at 15772. However, on the record before us, a jury reasonably could find that Beastie Boys' use of the sampled material was not de minimis. Therefore, summary judgment is inappropriate.

As the majority observes, a use is de minimis only if an average audience would not recognize the appropriation. Fisher v. Dees, 794 F.2d 432, 434 n.2 (9th Cir. 1986). The majority is correct that James Newton's considerable skill adds many recognizable features to the performance sampled by Beastie Boys. Even after those features are "filtered out," however, the composition, standing alone, is distinctive enough for a jury reasonably to conclude that an average audience would recognize the appropriation of the sampled segment and that Beastie Boys' use was therefore not de minimis.

Newton has presented evidence that the compositional elements of "Choir" are so compositionally distinct that a reasonable listener would recognize the sampled segment even if it were performed by the featured

flautist of a middle school orchestra. It is useful to begin by observing that the majority's repeated references to the sampled segment of "Choir" as a "3-note sequence" n1 are overly simplified. The sampled segment is actually a three-note sequence sung above a fingered held C note, for a total of four separate tones. n2 Even passages with relatively few notes may be qualitatively significant. The opening melody of Beethoven's Fifth Symphony is relatively simple and features only four notes, but it certainly is compositionally distinctive and recognizable.

The majority is simply mistaken in its assertion, maj. op. at 15778, that Newton's experts did not present evidence of the qualitative value of the compositional elements of the sampled material sufficient to survive summary judgment. The majority is similarly mistaken when it says, id., that Newton's experts failed to distinguish between the sound recording and the composition. To the contrary, Newton presented considerable expert evidence that the composition alone is distinctive and recognizable.

First, Newton offered a letter from Professor Olly Wilson of the University of California at Berkeley. Professor Wilson acknowledges that much of the distinctiveness of the sampled material is due to Newton's performance and that the copyrighted score does not fully convey the quality of the piece as performed. Nevertheless, Professor Wilson concludes that the scoreclearly indicates that the performer will simultaneously sing and finger specific pitches, gives a sense of the rhythm of the piece, and also provides the general structure of this section of the piece. Hence, in my opinion, the digital sample of the performance . . . is

clearly a realization of the musical score filed with the copyright office.

Second, Newton presented a letter from Professor Christopher Dobrian of the University of California, Irvine. The majority deals with Professor Dobrian's evidence by stating: "Dr. Dobrian described the three-note sequence at issue as 'a simple, "neighboring tone" figure.'" Maj. op. at 15778. As the passage quoted below demonstrates, the majority fundamentally misreads Professor Dobrian's statement by taking it out of context; in the process the majority reverses his intended meaning. Professor Dobrian actually concludes:Applying traditional analysis to this brief excerpt from Newton's "Choir"--i.e., focusing solely on the notated pitches--a theorist could conclude (erroneously, in my opinion) that the excerpt contains an insignificant amount of information because it contains a simple "neighboring-tone" figure: C to D-flat and back to C. . . . If, on the other hand, one considers the special playing technique described in the score (holding one fingered note constant while singing the other pitches) and the resultant complex, expressive effect that results, it is clear that the "unique expression" of this excerpt is not solely in the pitch choices, but is actually in those particular pitches performed in that particular way on that instrument. These components in this particular combination are not found anywhere else in the notated music literature, and they are unique and distinctive in their sonic/musical result.(Emphasis added.)

It is important to note that Professor Dobrian is not talking about Newton's performance of the sampled portion. Rather, he is speaking of the distinctiveness of

the underlying composition. The "playing technique" is not a matter of personal performance, but is a built-in feature of the score itself. In essence, Dobrian is stating that any flautist's performance of the sampled segment would be distinctive and recognizable, because the score itself is distinctive and recognizable.

The majority, then, misreads the record when it states that Newton failed to offer evidence that the sampled material is qualitatively significant. In fact, Newton presented evidence, as described above, to show that an average and reasonable listener would recognize Beastie Boys' appropriation of the composition of the sampled material. n3

Because Newton has presented evidence establishing that reasonable ears differ over the qualitative significance of the composition of the sampled material, summary judgement is inappropriate in this case. Newton should be allowed to present his claims of infringement to a jury. I therefore dissent from the majority's conclusion to the contrary.

Footnotes

n1 Maj. op. at 15776, 15777, 15778.

n2 The sampled segment of the composition is scored as shown in the Appendix.

n3 Because Newton has established that a jury reasonably could find that the sampled portion of "Choir" is qualitatively significant, we need not address the question of the portion's quantitative significance. See Worth v. Selchow & Righter Co., 827 F.2d 569, 570

n.1 (9th Cir. 1987) (noting that "a determination of the qualitative importance of the material to the plaintiff's work is more significant than a quantitative calculation of the portion allegedly appropriated by the defendant").

CASE NO. CV 00-04909 NM (MANx)

UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA

JAMES W. NEWTON, JR. dba JANEW MUSIC,
Plaintiff,

v.

MICHAEL DIAMOND, et al.,
Defendants

May 20, 2002, Decided
May 21, 2002, Filed; May 22, 2002, Entered

COUNSEL: For JAMES W NEWTON, JR, dba Janew Music, plaintiff: Jeffrey Alan Berchenko, Berchenko & Korn, Alan Michael Korn, Alan M Korn Law Offices, Berkeley, CA.

For MICHAEL DIAMOND, ADAM HOROWITZ, ADAM YAUCH, DBA Beastie Boys, CAPITOL RECORDS INC, GRAND ROYAL RECORDS INC, UNIVERSAL POLYGRAM INTERNATIONAL PUBLISHING INC, BROOKLYN DUST MUSIC, defendants: Daniel J Friedman, Joseph Geisman, Loeb & Loeb, Los Angeles, CA.

For MICHAEL DIAMOND, ADAM HOROWITZ, ADAM YAUCH, CAPITOL RECORDS INC, GRAND ROYAL RECORDS INC, UNIVERSAL POLYGRAM INTERNATIONAL PUBLISHING INC, BROOKLYN DUST MUSIC, MARIO CALDATO, JR, CRITERION COLLECTION,

VOYAGER PUBLISHING COMPANY INC, defendants: Adam F Streisand, Gabrielle A Vidal, Loeb & Loeb, Los Angeles, CA.

For JANUS FILMS, LLC, CRITERION COLLECTION, VOYAGER PUBLISHING COMPANY INC, defendants: Jeffrey D Ullman, Adam Streisand, Ullman Furhman Broeman & Platt, Morristown, NJ.

For SONY MUSIC ENT INC, BMG DIRECT MARKING NC, THE COLUMBIA HOUSE COMPANY, defendants: Barry E Mallen, Manatt Phelps & Phillips, Los Angeles, CA.

For SONY MUSIC ENT INC, BMG DIRECT MARKING INC, THE COLUMBIA HOUSE COMPANY, defendants: Steven M Hayes, David R Baum, Parcher Hayes & Snyder, New York, NY.

JUDGES: Nora M. Manella, United States District Judge.

OPINION BY: Nora M. Manella

OPINION:

ORDER

1) GRANTING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT

2) DENYING PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT

I. INTRODUCTION

The Beastie Boys, an alternative rock and hip-hop band, and their business associates ("Defendants") sampled a six-second, three-note sequence of a flute composition composed and performed by James W. Newton, Jr. ("Plaintiff"). Plaintiff concedes that Defendants licensed the sound recording of his work, but alleges that Defendants' use of the sample infringed upon the underlying musical composition. Both parties have filed motions for summary judgment.

II. FACTS

This case involves sampling. "The practice of sampling portions of pre-existing recordings and compositions into new songs is apparently common among performers of the genre known as rap. . . . Musicians sample pre-existing works either digitally, by lifting part of a song from a pre-existing master recording and feeding it through a digital sampler, or by hiring musicians who replay or re-sing portions of the pre-existing composition." Williams v. Broadus, 2001 U.S. Dist. LEXIS 12894, No. 99 Civ. 10957 MBM, 2001 WL 984714, at *1 n.1 (S.D.N.Y. Aug. 27, 2001).

Plaintiff, a flautist and composer, is the sole author of the musical composition Choir, which was registered with the Copyright Office in 1978. Defendants' Statement of Uncontroverted Facts P 1; Plaintiff's Statement of Genuine Issues P 1; Plaintiff's Statement of Uncontroverted Facts P 1; Defendants' Statement of Genuine Issues P 1. Defendants assert that Choir is one movement of a multi-movement musical composition titled The Change Suite, registered by Plaintiff with

the U.S. Copyright Office. Defendants' Statement of Uncontroverted Facts P 1. Plaintiff asserts that Choir is one of multiple songs permissibly covered by single copyright registration. Plaintiff's Statement of Genuine Issues P 1. It is undisputed that Plaintiff holds a valid copyright to the musical composition at issue in this case. Defendants' Reply Brief at 2. It is also undisputed that Plaintiff has no rights to the sound recording of his performance of Choir, having licensed it to ECM Records in 1981. First Amended Complaint ("FAC") P 26, Ex. D.

On February 26, 1992, the Beastie Boys ("Defendants"), an alternative rock and hip-hop band, obtained a license from ECM Records to sample the copyrighted sound recording of Plaintiff's performance of Choir. Defendants' Statement of Uncontroverted Facts P 3; Plaintiff's Statement of Genuine Issues P 3. n1 Pursuant to their license, Defendants copied a three-note sequence with one background note, approximately six seconds long, from Choir and looped the passage throughout their song, Pass the Mic. Plaintiff's Statement of Uncontroverted Facts P 4; Defendants' Statement of Genuine Issues P 4; Korn Decl., Ex. 1, Track # 2 (Pass the Mic). Choir itself runs approximately four and a half minutes. See Korn Decl., Ex. 1, Track # 1 (Choir). It is undisputed that Choir and Pass the Mic "are substantially dissimilar in concept and feel, that is, in there [sic] overall thrust and meaning." Id., Ex. 3. (Dobrian Report) at 16.

Defendants represent that the sample consists of a six-second segment in which the performer fingers a "C" above middle "C" on the flute, while singing the same "C," ascending one-half step to a "D-flat," and

descending again to the "C." Defendants Statement of Uncontroverted Facts P 6. Plaintiff concedes that Defendants sampled "melody and harmony created by interaction of the underlying flute note of C and the simultaneous vocalization of the notes C, D-flat, and C." Korn Decl., Ex. 5, Plaintiff's Response to Defendants' Interrogatory No. 1. n2 However, Plaintiff alleges that Defendants also sampled the unique musical sound and characteristics created by his distinctive performance techniques. Id.

It is undisputed that Defendants' license allowed them to sample the sound recording of Plaintiff's performance of Choir. FAC P 26; Korn Decl., Ex. 15; Defendants' Statement of Uncontroverted Facts PP 3-4; Plaintiff's Statement of Genuine Issues PP 3-4; Plaintiff's Statement of Uncontroverted Facts P 3; Defendants' Statement of Genuine Issues P 3; Plaintiff's Motion at 3. However, Plaintiff contends that Defendants were required to obtain a separate license for derivative use of the copyrighted musical composition of Choir. Defendants' Statement of Uncontroverted Facts P 3; Plaintiff's Statement of Genuine Issues P 3; Plaintiff's Statement of Uncontroverted Facts P 3; Defendants' Statement of Genuine Issues P 3; Plaintiff's Motion at 3.

Plaintiff filed suit May 9, 2000, asserting claims for: 1) copyright infringement in violation of the Copyright Act, 17 U.S.C. § 101 et seq.; 2) international copyright infringement in violation of the Universal Copyright Convention; 3) reverse passing-off in violation of the Lanham Act, 15 U.S.C. § 1125, et seq.; and 4) misappropriation of identity in violation of the Lanham Act. The court dismissed Plaintiff's third and fourth

claims pursuant to Fed. R. Civ. P. 12(b)(6). See Court's Order Granting Defendants' Motion to Dismiss, September 12, 2000.

Defendants filed their motion for summary judgment on Plaintiff's remaining two claims for copyright infringement February 28, 2002. Defendants argue that the portion of the musical composition Choir they sampled cannot be protected as a matter of law. In the alternative, Defendants argue that any misappropriation is de minimis, and thus not actionable as copyright infringement. Defendants also contend that Plaintiff cannot seek extraterritorial damages because he cannot establish that Defendants infringed upon his copyright. Finally, Defendants argue that any infringement claim and damages Plaintiff may have are limited by the three-year statute of limitations.

Plaintiff filed a motion for summary judgment March 12, 2000. Plaintiff argues that the portion of Choir Defendants sampled is legally protectable, and that Defendants' alleged infringement is not de minimis. Plaintiff also argues that he is entitled to injunctive relief.

III. LEGAL STANDARD

Summary judgment is appropriate when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). Summary judgment is "properly regarded not as a disfavored procedural shortcut, but rather as an integral part of

the Federal Rules as a whole, which are designed 'to secure the just, speedy and inexpensive determination of every action.'" Celotex Corporation v. Catrett, 477 U.S. 317, 327, 106 S. Ct. 2548, 2555, 91 L. Ed. 2d 265 (1986) (quoting Fed. R. Civ. P. 1). Determinations of credibility, however, should be left to the trier of fact. See Hanon v. Dataproducts Corp., 976 F.2d 497, 507 (9th Cir. 1992). Accordingly, issues that turn on such determinations should not be resolved at the summary judgment stage. See id.; see also Palacios v. City of Oakland, 970 F. Supp. 732, 738 (N.D. Ca. 1997) ("In judging evidence at the summary judgment stage, the Court does not make credibility determinations or weigh conflicting evidence[.]").

In a trio of 1986 cases, the Supreme Court clarified the applicable standards for summary judgment. See Celotex, supra; Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986); Matsushita Electrical Industry Co. v. Zenith Radio Corp., 475 U.S. 574, 106 S. Ct. 1348, 89 L. Ed. 2d 538 (1986). The moving party bears the initial burden of demonstrating the absence of a genuine issue of material fact. See Anderson, 477 U.S. at 256, 106 S. Ct. at 2514. The governing substantive law dictates whether a fact is material; if the fact may affect the outcome, it is material. See id. at 248, 2510. If the moving party seeks summary adjudication with respect to a claim or defense upon which it bears the burden of proof at trial, it must satisfy its burden with affirmative, admissible evidence. By contrast, when the non-moving party bears the burden of proving the claim or defense, the moving party can meet its burden by pointing out the absence of evidence submitted by the non-moving party. The moving party need not

disprove the other party's case. See Celotex, 477 U.S. at 325, 106 S. Ct. at 2554.

If the moving party meets its initial burden, the "adverse party may not rest upon the mere allegations or denials of the adverse party's pleadings, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial." Fed. R. Civ. P. 56(e). When assessing whether the non-moving party has raised a genuine issue, the court must believe the evidence and draw all justifiable inferences in the non-movant's favor. Anderson, 477 U.S. at 255, 106 S. Ct. at 2513 (citing Adickes v. S.H. Kress & Co., 398 U.S. 144, 158-59, 90 S. Ct. 1598, 1608-09, 26 L. Ed. 2d 142 (1970)). Nonetheless, "the mere existence of a scintilla of evidence" is insufficient to create a genuine issue of material fact. 477 U.S. at 252, 2512. As the Supreme Court explained in Matsushita,

when the moving party has carried its burden under Rule 56(c), its opponent must do more than simply show that there is some metaphysical doubt as to the material facts... Where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no "genuine issue for trial."

Id., 475 U.S. at 586-87, 106 S. Ct. at 1356 (citations omitted).

To be admissible for purposes of summary judgment, declarations or affidavits must be based on personal knowledge, must set forth "such facts as would be admissible in evidence," and must show that the declarant or affiant is competent to testify concerning

the facts at issue. Fed. R. Civ. P. 56(e). Declarations on information and belief are insufficient to establish a factual dispute for purposes of summary judgment. See Taylor v. List, 880 F.2d 1040, 1045 (9th Cir. 1989).

IV. DISCUSSION

A. Copyright Act Claim

1. The Difference Between the Musical Composition and the Sound Recording

Sound recordings and their underlying musical compositions are separate works with their own distinct copyrights. See 17 U.S.C. § 102 (a)(2), (7). "When a copyrighted song is recorded on a phonorecord, there are two separate copyrights: one in the musical composition and the other in the sound recording." T.B. Harms Co. v. Jem Records, Inc., 655 F. Supp. 1575, 1576 n.1 (D.N.J. 1987). See also BTE v. Bonnecaze, 43 F. Supp. 2d 619, 627 (E.D. La. 1999); Jarvis v. A & M Records, 827 F. Supp. 282, 292 (D.N.J. 1993) ("Under the Copyright Act, there is a well-established distinction between sound recordings and musical compositions."). The rights of a copyright in a sound recording do not extend to the song itself, and vice versa. BTE, 43 F. Supp. 2d at 627; T.B. Harms, 655 F. Supp. at 1576 n.1.

It is undisputed that Plaintiff has no rights to the sound recording of his performance of Choir, having licensed it for a fee to ECM Records, who, in turn, granted Defendants a license to sample it. FAC P 26, Ex. D. Defendants' Statement of Uncontroverted Facts P 3; Plaintiff's Statement of Genuine Issues P 3. However,

Plaintiff contends that Defendants' sampling infringed upon his underlying musical composition. Accordingly, the court must first determine what elements of Plaintiff's work are protected by his copyright in the musical composition, as opposed to those protected by the copyright in the sound recording, and "filter out" the latter. See Sony Pictures Enter., Inc. v. Fireworks Enter. Group, Inc., 156 F. Supp. 2d 1148, 1157 (C.D. Cal. 2001). "Because only those elements of a work that are protectable and used without the author's permission can be compared when it comes to the ultimate question of illicit copying, [courts use] analytic dissection to determine the scope of copyright protection before works are considered as a 'whole.'" Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1443 (9th Cir. 1994).

Plaintiff argues that analytic dissection is not required, because copyright law automatically protects copyrightable expression reduced to a musical score or phonorecord. Plaintiff's argument begs the question as to what is protected by his copyright over the musical composition, as opposed to ECM's copyright over the sound recording. Had Plaintiff held both copyrights, analytic dissection would be unnecessary. However, as Plaintiff cannot base his infringement action on elements unique to the sound recording, the court must first determine precisely what is protected by Plaintiff's copyright over his musical composition.

A musical composition consists of rhythm, harmony, and melody, and it is from these elements that originality is to be determined. 1 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 2.05[D]. A musical composition captures an artist's music in

written form. A. Dustin Mets, Did Congress Protect the Recording Industry Into Competition? The Irony of the Digital Performance Right in Sound Recordings Act, 22 U. DAYTON L. REV. 371, 372-73 (1997). A musical composition's copyright protects the generic sound that would necessarily result from any performance of the piece.

Sound recordings are "works that result from the fixation of a series of musical, spoken or other sounds. . . ." T.B. Harms, 655 F. Supp. at 1576 n.1 (quoting 17 U.S.C. § 101). "The sound recording is the aggregation of sounds captured in the recording while the song or tangible medium of expression embodied in the recording is the musical composition." Id. (citing H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 56, reprinted in 1976 U.S. Code Cong. & Ad. News 5659, 5669). See also BTE, 43 F. Supp. 2d at 627-28; Jarvis, 827 F. Supp. at 292. In other words, the sound recording is the sound produced by the performer's rendition of the musical work. See generally Nimmer on Copyright § 2.10.

Plaintiff's musical composition of the sample at issue consists of a "C" note played on the flute while the performer sings a "C," ascends one-half step to "D-flat," and descends again to the "C." The score is not further orchestrated and contains neither time nor key signatures. n3 The score also calls for between 90 and 180 seconds of improvisation. The C -- D-flat -- C sequence appears only once in the composition.

Plaintiff's expert, Christopher Dobrian, concludes that following the "special playing technique described in the score" will necessarily create unique expression. Korn Decl., Ex. 3 (Dobrian Report) at 12. Dobrian

acknowledges, however, that the technique of vocalization -- simultaneously singing and playing the flute -- is not unique to Plaintiff's musical composition. Id. at 14. Similarly, Plaintiff's other expert, Oliver Wilson, acknowledges that "vocalization performance techniques" have been used in Africa and were prevalent throughout the Twentieth Century, particularly in avant-garde music. Korn Decl., Ex. 3 (Wilson Report) at 20-21 ("Multiphonic and particularly vocalization of performance techniques exist as part of the performance tradition of specific SubSaharan African cultures and has [sic] also been clearly established in the second half of the Twentieth century as a relatively common performance practice in the avant-garde music which grows out of the cultivated Western written music tradition.").

Defendants' expert, Lawrence Ferrara, confirms that vocalization involving a flute may be found in numerous flute pieces that pre-date Plaintiff's 1978 musical composition. See Streisand Decl., Ex. 3 (Ferrara Report) at 7-8. For example, acclaimed composer George Crumb's 1971 composition "Voice of the Whale" contains the same technique. See id., Ex. 3 (Ferrara Report) at 7-8, Ex. C (recordings of Crumb's work). Like Plaintiff's technique in Choir, Crumb plays one note on the flute while simultaneously singing the note into the flute, ascending a half-step, and returning to the note being played. See id., Ex. 3 (Ferrara Report) at 7-8, Ex. C (recordings of Crumb's work). Numerous other composers have used vocalization to create a distinctive sound. See id., Ex. 3 (Ferrara Report) at 7-8. See also id., Ex. D, Track # 1 (Robert Dick, Afterlight); Track # 2 (African folk song Bengsimbe of the Fula people); Track # 3 (Toru Takemitsu, Voice); Track # 4

(Domino, recorded by Roland Kirk); Tracks # 5 & # 6 (My Ship, recorded by Roland Kirk); Track # 7 (We'll Be Together Again, recorded by Roland Kirk); Track # 8 (People, recorded by Roland Kirk); and Track # 9 (Szerelem, Szerelem, Hungarian Folk Song). Moreover, academic literature recognized the technique of singing while playing the flute before Plaintiff wrote and performed Choir. See, e.g., id., Ex. B (DAVID COPE, NEW MUSIC NOTATION at 67 (1976); ROBERT DICK, THE OTHER FLUTE: A PERFORMANCE MANUAL OF CONTEMPORARY TECHNIQUES at 135 ("Singing and Playing Simultaneously") (1975); THOMAS HOWELL, THE AVANT-GARDE FLUTE: A HANDBOOK FOR COMPOSERS AND FLUTISTS at 30 ("Special Effects: Singing with the Flute") (1974)).

Plaintiff largely ignores the distinction between musical compositions and sound recordings. Plaintiff argues only that his own techniques render his musical composition unique, as they contribute "something more than a merely trivial variation, something recognizably [his] own" to a prior expression. ZZ Top v. Chrysler Corp., 54 F. Supp. 2d 983 (W.D. Wa. 1999). See also Tempo Music v. Famous Music Corp., 838 F. Supp. 162, 168-69 (S.D.N.Y. 1993). n4 While Plaintiff concedes that he did not invent generic vocalization -- simultaneously singing and playing the flute -- he argues that his unique approach to vocalization, in particular using breath control to emphasize certain notes, which his expert Wilson terms "the Newton technique," renders Choir original. Plaintiff also identifies his technique of overblowing the "C" note to produce multiple pitches ("multiphonics") as the source of his work's originality. Korn Decl., Ex. 3 (Wilson Report) at 20.

However, neither the "Newton technique" nor any mention of overblowing the "C" note appears on the musical composition. The musical composition contains only a notation that the piece is performed using generic vocalization, simultaneously singing and playing the flute. Plaintiff concedes as much, acknowledging that all elements of his performance are not reflected in the musical composition. Plaintiff's Opposition Brief at 15. Plaintiff's expert Wilson confirms that the copyrighted score of Choir does not contain notations for all of the "musical subtleties" that the performer of the work "will make in the work's performance." Korn Decl., Ex. 3 (Wilson Report) at 20-21 (emphasis added). Moreover, Wilson acknowledges that the copyrighted score of Choir does not delineate the techniques necessary to reproduce Plaintiff's "unique sound." See id. at 21.

Plaintiff's expert, Christopher Dobrian, opines that because every composer of a musical work assumes that the performer will add his or her individual interpretation to the notation, "the contribution of the performer is often so great that s/he in fact provides just as much musical content as the composer." Korn Decl., Ex. 3 (Dobrian Report) at 15. Dobrian concludes that "in Newton's own performance of his composition he uses breath control to modify the timbre of the sustained flute note rather extremely . . . and he uses portamento to glide expressively from one pitch to the other in the vocal part." Id. at 15 (emphasis added). Dobrian concedes that "neither the timbral effect nor the portamento is notated in the score." Id. at 15. Dobrian further emphasizes that "Mr. Newton blows and sings in such a way as to emphasize the upper partials of the flute's complex harmonic tone," but

acknowledges that "such a modification of tone color is not explicitly requested in the score." Id. Indeed, Dobrian concludes that Plaintiff's allegedly unique sound "is the result of Mr. Newton's refined breath control for interpretive use of tone color," which Plaintiff's expert Wilson calls "the Newton technique." Id. at 14.

As Plaintiff's specific techniques of performing Choir, viz., "the Newton technique" -- Newton's practice of overblowing the "C" note to create a multiphonic sound, and his unique ability to modify the harmonic tone color -- do not appear in the musical composition, they are protected only by the copyright of the sound recording of Plaintiff's performance of Choir, which Defendants licensed. Accordingly, Plaintiff's copyright protects only the sound that would invariably result from playing the "C" note on the flute while singing into the flute a "C," ascending to a "D-flat," and descending to the "C."

At oral argument, Plaintiff's counsel suggested that any flautist performing the six-second segment would produce sounds comparable to those achieved by Plaintiff. This proposition is both unsupported by the record and contradicted by Plaintiff and his experts. Throughout this litigation, Plaintiff has insisted that the harmonic sounds and timbral effects achieved in his composition are a result of his unique performing techniques. His expert Dobrian confirms this. He cannot now claim that any flautist fingering a C and blowing C -- D-flat -- C would achieve the unique sound that results from his use of techniques not notated in the score. n5

In sum, what makes Plaintiff's performance "unique," according to his own experts, is the combination of performance techniques Plaintiff employs in the execution of his composition, consisting largely of techniques not notated in the score. n6 It is undisputed that Plaintiff could have notated "overblowing," as he did in other compositions. See, e.g., FAC, Ex. B (Toru) at 17 (containing notation to "overblow harmonics"). Therefore, whether Defendants' sample sounds like Plaintiff's performance of Choir is not relevant to the court's inquiry. Rather, the court must decide whether Defendants' creation of a three-note sequence with one background note from a six-second segment of Choir constitutes copyright infringement of the underlying musical composition.

2. The Sample of Plaintiff's Musical Composition Is Unprotectable

At the outset, Plaintiff argues that his copyright creates a presumption of originality which Defendants must refute. However, this presumption applies only to whether the copyright itself is valid. North Coast Indus. v. Jason Maxwell, Inc., 972 F.2d 1031, 1033 (9th Cir. 1992) ("Under our copyright law, the registration of the copyright certificate itself establishes a prima facie presumption of validity of the copyright in a judicial proceeding. . . ."). See also Three Boys Music Corp. v. Bolton, 212 F.3d 477, 488-89 (9th Cir. 2000) ("Registration is prima facie evidence of the validity of a copyright."); Smith v. Jackson, 84 F.3d 1213, 1219 (9th Cir. 1996) (holding that presumption of originality not relevant to "scenes a faire" inquiry, because "[a] Certificate of Registration only creates a rebuttable presumption of originality applicable to a defendant's

attack on the originality applicable to a defendant's attack on the validity of a plaintiff's copyright.") (emphasis in original). In the instant case, Defendants do not dispute that Plaintiff's copyright over the musical composition is valid. Even were the validity of Plaintiff's copyright at issue, the presumption of originality applies only if "the judicial proceeding is commenced within five years of the copyright's first publication." North Coast Indus., 972 F.2d at 1033. Plaintiff registered his copyright August 4, 1978 and commenced this suit over 20 years later on May 9, 2000.

The protectability of elements of a copyrighted work is a question of law for the court. See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 348, 113 L. Ed. 2d 358, 111 S. Ct. 1282-51 (1991). Although the musical composition of Choir is protected as a complete work, not every element of a song is per se protected. See, e.g., Rogers v. Koons, 960 F.2d 301, 307 (2d Cir. 1992). Copyright protection extends only to those components of the work that are original and non-trivial. Feist, 499 U.S. at 348-51. In assessing originality, courts must be "mindful of the limited number of notes and chords available to composers and the resulting fact that common themes frequently appear in various compositions, especially in popular music." Gaste v. Kaiserman, 863 F.2d 1061, 1068 (2d Cir. 1988). See also Jarvis, 827 F. Supp. at 291 ("Easily arrived at . . . chord progressions are usually not copyrightable.").

In the instant case, Plaintiff's three-note sequence (C -- D-flat -- C) with one background note (C), segregated from the entire piece, cannot be protected, as it is not original as a matter of law. Many courts have found that nearly identical or more substantial samples are not

susceptible to copyright protection. In Jean v. Bug Music, Inc., 2002 U.S. Dist. LEXIS 3176, No. 00 Civ 4022 (DC), 2002 WL 287786 (S.D.N.Y. Feb. 27, 2002), the defendant allegedly copied a three-note sequence consisting of "C," followed by a "B-flat," followed by another "C," accompanied by the lyric "clap your hands." The court held that this excerpt of the song at issue could not be protected by the plaintiff's copyright "because the sequence of the three notes and the lyrics lack the requisite originality." Id. at *5, 2002 U.S. Dist. LEXIS 3176. The court recognized that the musical note sequence "C" -- "B-flat" -- "C" appears commonly in music, rendering the sequence not susceptible to copyright protection. Id. at *6, 2002 U.S. Dist. LEXIS 3176. The court further found that the three-word lyric "clap your hands," either standing alone or in combination with the music, was too common to render the otherwise unoriginal three-note sequence original.

The facts of Jean are strikingly similar to the instant case -- a three-note sequence in which the first and third notes are identical and the second note is a half-step away. Unlike the snippet in Jean, however, Plaintiff's three-note sequence is unaccompanied by any lyrics. The vocalization notated in the score is, as Plaintiff concedes, a commonly used technique. Just as the Jean court found a commonly used word phrase insufficient to render the three-note sequence original, this court finds the widely used vocalization technique insufficiently original to render the three-note segment protectable. n7

In McDonald v. Multimedia Entertainment, Inc., 1991 U.S. Dist. LEXIS 10649, 20 U.S.P.Q.2d 1372 (S.D.N.Y. 1991), the court found that the three-note sequence the

defendant allegedly misappropriated from the plaintiff's jingle could not be protected by copyright. The court noted the "absurdity" of Plaintiff's claim, given that the three-note sequence is a "common and much-used tone in traditional western music." Id. at 1375. Similarly, in Tisi v. Patrick, 97 F. Supp. 2d 539 (S.D.N.Y. 2000), the court found that the plaintiff's claim of copyright infringement was based entirely upon non-protectable elements of his song, viz., the key of A major, the tempo, a chord structure/harmonic common to rock music, the guitar rhythm, and the fact that the chords of both songs are in "root" position.

In Intersong-USA v. CBS, Inc., 757 F. Supp. 274, 282 (S.D.N.Y. 1991), the court held that the defendants had not copied "protectible expression" contained in plaintiff's copyrighted song. The plaintiff alleged that the defendants had copied his descending scale step motive, but the court found this to be a "commonly used compositional device," citing the example of "Twinkle, Twinkle Little Star." Id. at 282. Although the defendants allegedly copied the plaintiff's structure patterns, use of a certain harmonic progression, and a recurring eighth-note rhythm, "these common elements are found in many other well-known songs." Id.

Plaintiff identifies cases in which courts have held that short sequences of notes may be protected by copyright. However, those cases involved sequences consisting of more than three notes. In Baxter v. MCA, Inc., 812 F.2d 421, 425 (9th Cir. 1987), for example, the defendant allegedly used the first six notes of Plaintiff's composition "Joy" to create the theme for the movie "E.T." and conceded that both his composition and the plaintiff's composition conveyed similar ideas. The

court, rejecting the defendant's characterization of the sequence as necessarily consisting of only six notes, held that the sequence could be protected by the copyright laws. Id. See also Fisher v. Dees, 794 F.2d 432, 434 n.2 (defendants allegedly misappropriated first six bars of the song's 38 bars and used similar lyrics); Jarvis, 827 F. Supp. at 292 (defendants allegedly misappropriated "the last several minutes" of plaintiff's song's distinctive keyboard riff, as well as distinctive lyrics).

Cases finding that sequences of less than six notes could be qualitatively distinctive have involved: 1) sequences with accompanying lyrics; 2) sequences at the heart of the musical compositions; 3) sequences and lyrics that were repetitive; and/or 4) sequences that were based upon analyses of both the written composition and the sound recording. See, e.g., Santrayll v. Burrell, 1996 U.S. Dist. LEXIS 3538, 39 U.S.P.Q.2d 1052, 1054 (S.D.N.Y. 1996) (one measure "hook" and repetition of word "uh-oh" may be distinctive); Elsmere Music, Inc. v. National Broadcasting Co., 482 F. Supp. 741, 744 (S.D.N.Y. 1980) (four notes and phrase "I Love" at heart of copyrighted song may be distinctive). Plaintiff also relies upon cases holding that a few words or sounds may be distinctive. See, e.g., Tin Pan Apple, Inc. v. Miller Brewing Co., Inc., 1994 U.S. Dist. LEXIS 2178, 30 U.S.P.Q.2d 1791, 1793-94 (S.D.N.Y. 1994) (sounds "hugga-hugga" and "brrr" in Plaintiff's composition sufficient to warrant copyright protection). However, unusual words or sounds are necessarily more distinctive than a few generic notes of music.

Moreover, the reports of both Defendants' and Plaintiff's experts confirm that the main three-note sequence at issue -- C -- D-flat -- C -- is not original. Defendants' expert, Lawrence Ferrara, concludes that the portion of Plaintiff's musical composition that Defendants sampled is not original or unique, as "it is merely a common, trite, and generic three-note sequence, which lacks any distinct melodic, harmonic, rhythmic or structural elements." Streisand Decl., Ex. 3, (Ferrara Report) at 1. Ferrara concludes that "these three notes of music alone do not constitute an original or distinct piece of music" because "by any conventional methodological approach, these three simple notes are insignificant, and utterly insufficient to constitute original expression." Id. at 1-2. In fact, the same three-note sequence with a sustained pitch "has been used over and over again by major composers in 20th Century music, particularly the '60s and '70s, just prior to [Plaintiff's] usage." Streisand Decl., Ex. 7 (Ferrara Depo.) at 171, Exs. 9-11. Specifically, Jacob Druckman used this "basic building block tool" in his 1972 Pulitzer Prize winning composition Windows and again in his 1976 composition Other Voices, as did Gyorgy Ligeti in his 1968 String Quartet No. 2. Id. at 171, Exs. 9-11. n8

Plaintiff's expert Dobrian acknowledges that Plaintiff's musical composition "contains a simple 'neighboring tone' figure: C to D-flat and back to C." Korn Decl., Ex. C (Dobrian Report) at 11. Dobrian contends that a sequence of "simple" and "unremarkable" notes may be significant, like the sample at issue. Id. at 12. However, Dobrian's conclusion, based upon his "independent assessment" of the sample, does not benefit Plaintiff's position, as it focuses upon elements of Plaintiff's performance which are not notated in the score.

Dobrian asserts that to the extent Plaintiff's performance techniques are not notated in the score they represent, "Newton's desired interpretation of the score." Id. at 16. He refers repeatedly to the "sound of Newton's playing," id. at 8, noting that the sound produced on the recording "is the result of Mr. Newton's refined breath control for interpretive use of tone color." Id. at 14. Elsewhere, he notes that "Mr. Newton blows and sings in such a way as to emphasize the upper partials of the flute's complex harmonic tone color," noting that "such a modification of tone color is not explicitly requested in the score." Id. at 15.

Dobrian's opinion is thus based on his assessment of the sound resulting from Mr. Newton's unique interpretation -- including the use of portamento/glissando, and modified tone color -- of a score that contains no notation of either. While it may be expected that every performer will impart some interpretive flavor to any piece, Dobrian's focus on the sonic effects achieved by Newton's unique performance prevents his opinion from addressing the primary issue before this court -- the protectability of the elements of the composition itself, not the "richness and complexity" of the "timbral result" achieved through "Mr. Newton's desired interpretation of the score." Id. at 16. Moreover, Dobrian's insistence that each performer brings his own unique interpretation to any work undercuts his argument that the uniqueness of Plaintiff's performance is inherent in the three-note musical notation. Finally, to the extent Dobrian attempts to base his conclusion on the uniqueness of the notes and notated technique alone, as discussed above, neither the three-note sequence nor the vocalization

technique -- or the two in combination -- are sufficiently original to be protectable.

Oliver Wilson's opinion is similarly unavailing to Plaintiff's position, as it is based upon elements of Plaintiff's performance. See Korn Decl., Ex. 3 (Wilson Report) at 20. Wilson repeatedly refers to "the Newton technique" as the "source" of the sample's originality. See id. "To be more precise, the Newton technique produces a musical event in which the component sounds resulting from the simultaneous singing of one or more pitches produced on the flute create a relatively dense cluster of pitches and ambient sounds that sometimes change over time." Id. Indeed, while Wilson acknowledges that vocalization was a common technique prior to Plaintiff's arrangement and performance of Choir, he concludes that Plaintiff's unique approach to vocalization ("the Newton technique") renders the sample original. Id. Specifically, Wilson points to Newton's technique of combining vocalization with multiphonics. Id. "Newton's technique involves the exploitation of simultaneous usage of vocalization and multiphonics. . . . This technique is the source of Newton's ability to produce his unique sound and hence, in large part, constitutes his musical signature." Id. Wilson states that Plaintiff "is not simply using a technique that is common in contemporary musical practice, but rather creating a specific musical event in the composition Choir that reflects his specific artistic vision." Id. at 21. Accordingly, any originality of the sample comes from Plaintiff's particular performance techniques, which are not at issue in this litigation.

Plaintiff attempts to create a triable issue by citing the remaining portions of Dobrian's report. However, some of Dobrian's conclusions are beyond the scope of his expertise. Dobrian concludes that because Defendants obtained a license to use the recording and acknowledged Plaintiff as the source of the sample, it must be unique. Id. at 11. However, Dobrian provides no foundation for his conclusion that a sample is original merely because its author is acknowledged in a derivative work. For example, Dobrian does not contend that such attribution occurs in the music industry only with respect to original work. Nor is Dobrian qualified to render such an expert opinion, as he is proffered as an expert in music composition, not sampling practices by popular music artists. Indeed, Dobrian was retained to analyze the music at issue, not to draw legal conclusions based upon facts falling outside his area of expertise.

In sum, the relevant portion of Plaintiff's musical composition is not subject to copyright protection as a matter of law. While Plaintiff and his experts contend that the six-second segment -- consisting of two notes in a three-note sequence with one background note -- constitutes unique expression, their analyses rely upon sound elements created by Plaintiff's admittedly unique technique of performing Choir, utilizing performance elements not notated in the score. Plaintiff's performance techniques, however, are not at issue in this litigation, as Defendants obtained a license to sample the sound recording of Plaintiff's performance of Choir. After filtering out the performance elements, the court is left with a six-second snippet of Plaintiff's composition consisting of a fingered "C" note and a sung three-note sequence C -- D-flat -- C. Courts have

held that such small and unoriginal portions of music cannot be protected by copyright. See, e.g., Jean v. Bug Music, Inc., F. Supp. 2d , 2002 U.S. Dist. LEXIS 3176, 2002 WL 287786 (S.D.N.Y. Feb. 27, 2002). Accordingly, the sample at issue -- a six-second, three-note sequence with a single background note, isolated from the sounds created by Plaintiff's performance techniques -- cannot be protected as a matter of law.

3. Defendants' Sampling of Plaintiff's Work Is De Minimis

Even if Plaintiff could establish that this three-note sequence is subject to copyright protection, Pass the Mic and Choir are not substantially similar as a matter of law, as Defendants' alleged infringement was de minimis. To establish that the infringement of a copyright is de minimis, and therefore not actionable, the alleged infringer must demonstrate that the copying of the protected material is so trivial "as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying." Sandoval v. New Line Cinema Corp., 147 F.3d 215, 217 (2d Cir. 1998) (citations omitted). No "substantial similarity [will] be found if only a small, common phrase appears in both the accused and complaining songs . . . unless the reappearing phrase is especially unique or qualitatively important." Jean, 2002 U.S. Dist. LEXIS 3176, 2002 WL 287786, at *6 (citations omitted). A taking is de minimis if the average audience would not recognize the misappropriation. Fisher v. Dees, 794 F.2d 432, 435 n.2 (9th Cir. 1986).

Courts generally consider both quantitative and qualitative factors in determining whether a taking is de minimis. Courts follow this approach in cases involving "fragmented literal similarity," which exists when a small portion of the original work is copied into the new song. Nimmer on Copyright § 13.03 [A][2]. In such cases, "where there unquestionably is copying, albeit of only a portion of [a] plaintiff's song, . . . the proper question to ask is whether the defendant appropriated, either quantitatively or qualitatively, 'constituent elements of the work that are original' such that the copyright rises to the level of an unlawful appropriation." Jarvis, 827 F. Supp. 289-91.

A quantitative analysis focuses upon the amount of the copyrighted work that was allegedly copied, as those who appropriate large parts of another's copyrighted work may be liable for copyright infringement. Id. at 290-91. "The relevant question in copyright infringement cases is whether the segment in question constituted a substantial portion of the plaintiff's work, not whether it constituted a substantial portion of the defendant's work." Id. at 290 (emphasis added). Thus, it is not relevant that Defendants played the six-second snippet throughout their entire song, as the focus is on whether the sample comprises a substantial portion of Plaintiff's song. Id. See also Williams v. Broadus, 2001 U.S. Dist. LEXIS 12894, No. 99 Civ. 10957 MBM, 2001 WL 984714, at *4 (S.D.N.Y. Aug. 27, 2001) (fact that sample was replayed throughout allegedly infringing song irrelevant) (citing Nimmer on Copyright § 13.03[A][2]; Twin Peaks Prod. v. Publications Int'l, 996 F.2d 1366, 1373 (2d Cir. 1993); Warner Bros., Inc. v. American Broadcasting Co., Inc., 720 F.2d 231, 242 (2d Cir. 1983); Elsmere Music, 482 F. Supp. at 741).

Courts also consider whether the sample is qualitatively important to the plaintiff's entire song. n9 "Even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity." Baxter, 812 F.2d at 423. "Quantitatively insignificant infringement may be substantial if the material is qualitatively important to plaintiff's work." Apple Computer, Inc. v. Microsoft, Corp., 821 F. Supp. 616, 624 (N.D. Cal. 1993), aff'd, 35 F.3d 1435 (9th Cir. 1994) (emphasis added). "It is not the significance of the copied material in the allegedly infringing work that determines substantial similarity. Rather, it is the significance of such material in the work allegedly infringed that is important." Williams v. Broadus, 2001 U.S. Dist. LEXIS 12894, No. 99 Civ. 10957 MBM, 2001 WL 984714, at *4 (S.D.N.Y. Aug. 27, 2001) (citing Nimmer on Copyright § 13.03[A][2]; Twin Peaks, 996 F.2d at 1373; Warner Bros., 720 F.2d at 242; Elsmere Music, 482 F. Supp. at 741). Accordingly, it is not relevant whether the sample was qualitatively important to Defendants' song. n10

In the instant case, Plaintiff may rely only upon those elements protected by his copyright over the musical composition -- not those attributable to his performance of the piece or the sound recording -- to establish that the sample is quantitatively or qualitatively important enough to be recognized by the average audience. See Apple Computer, 35 F.3d at 1443. Assuming Choir is a ~~distinct~~ song, as Plaintiff contends, Defendants copied a quantitatively insignificant amount of Plaintiff's work. n11 Defendants appropriated a six-second sample consisting of a three-note sequence from a musical composition that takes approximately four and a half

minutes to play. See Korn Decl., Ex. 1, Track # 1 (Choir). Quantitatively, the sample is thus approximately 2% of the piece. Moreover, it is undisputed that the three-note sequence appears only once in the piece. Although Plaintiff argues that the snippet is "quantitatively significant," most of his argument and cases cited focus on qualitative factors. Courts have found similar or more substantial sequences quantitatively insignificant. See, e.g., Jean, 2002 U.S. Dist. LEXIS 3176, 2002 WL 287786, at *7-8 (three-note sequence and lyric "clap your hands" not quantitatively significant to copyrighted song); McDonald, 20 U.S.P.Q.2d at 1375 (three-note sequence of proposed television show jingle not quantitatively significant to copyrighted song). Even Baxter, which held that alleged misappropriation of at least six notes in the theme to the movie "E.T." was not necessarily de minimis, based its holding on qualitative factors, recognizing that the sample was quantitatively small. See Baxter, 812 F.2d at 425 ("Even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find similarity."). Accordingly, Plaintiff must rely upon qualitative factors to establish that Defendants' sampling was not de minimis.

Plaintiff argues that the sample is distinctive because anyone familiar with Choir would instantly recognize its use throughout Pass the Mic. However, Plaintiff acknowledges that Choir and Pass the Mic "are substantially dissimilar in concept and feel, that is, in there [sic] overall thrust and meaning." Id., Ex. 3. (Dobrian Report) at 16. Moreover, Plaintiff identifies no factors -- separate and apart from those attributable to his unique performance techniques -- that would render

the three-note sequence qualitatively important to Plaintiff's entire composition of Choir. Plaintiff argues that Defendants' expert admitted that Defendants sampled a recognizable excerpt from the musical composition of Choir. See Korn Decl., Ex. 26 (Ferrara Depo.) at 251-52. However, Ferrara merely testified that someone listening to the sound recording of Plaintiff's performance of Choir may recognize the sample in Defendants' song. The issue is not whether someone might recognize the snippet as coming from Plaintiff's sound recording -- for which Defendants obtained a license; the question is whether someone might recognize -- from a performance of the notes and notated vocalization alone -- the source as the underlying musical composition. As Dr. Ferrara notes, because both the note sequence and vocalization technique are common, any analysis of distinctiveness must necessarily come from the performance elements, not the musical composition. See generally Streisand Decl., Ex. 3 (Ferrara Report).

Citing the deposition of Michael Diamond, a member of The Beastie Boys, Plaintiff argues that Defendants concede the sample is qualitatively significant. While Diamond testified that Defendants took the "best bit" of Choir, he also testified that the sound created by Plaintiff's distinctive performance is what makes the sample distinctive. See Korn Decl., Ex. 7 (Diamond Decl. at 78-80). The sound created by Plaintiff's distinctive performance techniques is not at issue in this litigation.

Plaintiff cites several cases in support of the proposition that a short sequence of notes can be qualitatively distinctive. However, as discussed above, cases that

have survived summary judgment have involved larger portions of music than are at issue in this case. Moreover, these case have involved sequences with accompanying lyrics that are distinctive, sequences at the heart of the musical compositions, sequences that repeated throughout the composition, and/or an analysis of both the written composition and sound recording. See Section IV.A.1 at 15-16. n12

In sum, Plaintiff identifies nothing distinctive about the three-note sequence taken from his musical composition. Neither the two notes in the three-note sequence, the common vocalization technique, nor the combination thereof imparts qualitative importance or distinctiveness to the six-second excerpt. Plaintiff cannot rely upon any allegedly unique sound elements created by his own performance of those three notes to establish its distinctiveness, as he licensed the right to the sound recording of that performance over 20 years ago. Neither Plaintiff nor his experts identify any elements of the musical composition itself, as opposed to those related to the sound recording, that make the three-note sequence distinctive or qualitatively significant. The sequence contains no accompanying lyrics. Defendants' expert contends that the sample is not distinctive or memorable. See Streisand Decl., Ex. 3 (Ferrara Report). Plaintiff's experts do not contend that the sequence -- devoid of the characteristics of Plaintiff's performance -- is "the heart" of the composition or comprises a distinctive "hook." See id. at 24. Moreover, Plaintiff acknowledges that the three-note sequence appears only once in his composition. n13 In short, there is nothing about this sequence making it distinctive, and courts have found misappropriation of similar sequences to be de minimis. See, e.g., Jean, 2002

U.S. Dist. LEXIS 3176, 2002 WL 287786, at *6-7. Accordingly, the court concludes that any use by Defendants was de minimis and cannot form the basis of a copyright infringement action.

B. International Copyright Infringement Claim

Plaintiff alleges that he is entitled to damages for Defendants' "international copyright infringement," viz., reproducing, distributing, and publicly performing Pass the Mic outside the United States. However, in order to recover for extraterritorial damages, "at least one alleged [act of] infringement must be completed entirely within the United States" that would subject the defendant to liability under the Copyright Act. Los Angeles News Service v. Reuters Television Int'l Ltd., 149 F.3d 987, 992 (9th Cir. 1998). As Plaintiff cannot establish a violation of the Copyright Act, his claim for extraterritorial damages fails as a matter of law.

C. Statute of Limitations

Even were Plaintiff permitted to proceed on his copyright infringement claim, the Copyright Act of 1976 provides that "no civil action shall be maintained unless it is commenced within three years after the claim accrued." 17 U.S.C. § 507(b). A claim accrues when an act of infringement occurs, not when consequent damage is suffered. Los Angeles News Service v. Reuters Television Int'l, Ltd., 149 F.3d 987, 992 (9th Cir. 1998). Moreover, a plaintiff's right to damages is limited to those suffered during the statutory period for filing suit, regardless of when they may have been incurred. Id. See also Roley v. New World Pictures, Ltd., 19 F.3d 479, 481 (9th Cir. 1994).

n14 Plaintiff alleges that Defendants have been infringing upon his work since they created Pass the Mic in 1991 or 1992. As Plaintiff filed suit April 9, 2001, however, he may seek damages only for acts of infringement that occurred after April 9, 1998.

V. CONCLUSION

This case is distinct from many copyright infringement actions involving sampling. It does not involve Defendants sampling without a license both the sound recording and the musical composition of a work. Rather, Plaintiff licensed the rights to the sound recording of his performance of Choir, and Defendants obtained a license to sample from this sound recording, leaving the court to inquire only whether the three-note sequence of Plaintiff's musical composition, devoid of the distinctive sound elements created by his unique performance techniques, can be protected by copyright law. The court concludes that it cannot. Moreover, even were this six-second snippet subject to copyright protection, the court concludes that Defendants' use was de minimis, as the sample was neither quantitatively nor qualitatively significant to Choir. Accordingly, the court GRANTS Defendants' motion for summary judgment and DENIES Plaintiff's motion for summary judgment.

IT IS SO ORDERED

DATED: May 20, 2002

Nora M. Manella
United States District Judge

Footnotes

n1 Defendants obtained "the irrevocable non-exclusive license and right to copy portions (if any) of the sound recording entitled Choir performed by James Newton. . . ." FAC, Ex. G at 1; Korn Decl., Ex. 15 at 1.

n2 Despite this concession, Plaintiff inexplicably disputes Defendants' proposed uncontroverted fact concerning the notes they sampled. However, he provides no description in his Statement of Genuine Issues of the notes at issue. The portions of the record cited by Plaintiff do not contradict Defendants' description of the notes they sampled. Moreover, the court's inspection of the sheet music and sound recording confirms that, as Defendants allege and Plaintiff concedes, Defendants sampled a portion of the score in which the performer fingers a "C" note on the flute while singing C -- D-flat -- C.

n3 The notation "senza misura" (without measure) and "largo" (slowly, broadly) appear above the first note, along with a footnote indicating that the performer must sing into the flute and finger simultaneously.

n4 Citing Tempo Music, 838 F. Supp. at 168-69, Plaintiff argues that innovative sounds in jazz may be protected by copyright. Regardless, Plaintiff licensed the innovative sounds created by his technique in performance to Defendants.

n5 The allegations of the original complaint further confirm that Plaintiff considers his playing techniques unique and not susceptible to copyright. Plaintiff's claims for trademark infringement (ultimately

dismissed) focused upon "the Newton signature" consisting of "unique musical characteristics" which create his "unique musical sound." Complaint PP 65-67. As none of the compositional characteristics -- vocalization or three half-steps -- are, individually or combined, "unique," Plaintiff could only have been referring to his unique performance techniques.

n6 Plaintiff argues that this techniques are not inconsistent with the score. This is not the point. A trill may be consistent with performance techniques of a particular piece, but if The Beastie Boys had sampled an unnotated trill, it could not seriously be argued that their doing so infringed on the underlying musical composition that contained no such trill.

n7 Plaintiff attempts to distinguish Jean by arguing that the court did not assess the distinctiveness of the notes and lyrics together. However, the court clearly held that "the lyrical phrase and the three notes are so common and unoriginal that even when they are combined they are not protectible." Jean, 2002 U.S. Dist. LEXIS 3176, 2002 WL 287786, at *6.

n8 Plaintiff criticizes Dr. Ferrara's report because it does not reference the sound recording of Plaintiff's performance of Choir. Plaintiff's Memorandum of Points & Authorities at 12. However, the sound recording is not at issue, as Plaintiff licensed his rights to the recording to ECM Records in 1981, and Defendants obtained a license from ECM in 1992 to sample from it.

n9 A sample may also be qualitatively important or unique standing alone. This court has already concluded

that the sample is not original as a matter of law. See Section IV.A.2.

n10 Throughout this litigation, the court has held that the proper focus is whether the sample is quantitatively or qualitatively important to Plaintiff's work, not Defendants' work. See, e.g., Magistrate Judge's Order on Plaintiff's Motion to Compel Further Responses to Requests for Production, September 28, 2002, at 7-8.

n11 Were the trier of fact to conclude that Choir is simply one movement of the multi-movement song, The Change Suite, as Defendants contend, this six-second, three-note sample would be even less quantitatively significant.

n12 ZZ Top v. Chrysler Corp., 54 F. Supp. 2d 983, 984-85 (W.D. Wa. 1999) does not benefit Plaintiff's position. The court provided only a brief discussion of the facts and did not discuss the length of the sequence allegedly misappropriated. Clearly the sequence there was longer than that at issue here, as the court stated that a jury could find the sequence distinctive "even if they were exposed to only six or eight seconds of each. . . ." Id. at 985.

n13 Mere recognizability of a de minimis taking is insufficient to create a triable issue. See, e.g., Sandoval v. New Line Cinema Corp., 147 F.3d 215, 217 (2d Cir. 1998).

n14 Plaintiff argues that the court should disregard the Ninth Circuit's holding in Roley in favor of the Seventh Circuit's approach of tolling the statute of limitations in copyright infringement actions. While Plaintiff

contends that the Seventh Circuit's approach is "the better rule," Ninth Circuit precedent is to the contrary.

JUDGMENT - DATED: May 21, 2002

On February 28, 2002, Defendants filed the instant motion for summary judgment. Upon full consideration of the moving, opposition, and reply papers, the relevant authorities, the parties' arguments, and the entire file herein, the court granted Defendants' motion. The issues having been duly heard, and a decision having been duly rendered,

It is Ordered and Adjudged that Plaintiff take nothing.

DATED: May 21, 2002

Nora M. Manella
United States District Judge

No. 02-55983

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

JAMES W. NEWTON, JR., dba Janew Music,
Plaintiff-Appellant,

v.

MICHAEL DIAMOND; ADAM HOROWITZ; ADAM YAUCH, dba Beastie Boys; CAPITOL RECORDS, INC., a Delaware Corporation; GRAND ROYAL RECORDS, INC., a California Corporation; UNIVERSAL POLYGRAM INTERNATIONAL PUBLISHING, INC., a Delaware Corporation; BROOKLYN DUST MUSIC, an entity of unknown origin; MARIO CALDATO, JR., an individual; JANUS FILMS, LLC, a New York Limited Liability Company; CRITERION COLLECTION, a California Partnership; VOYAGER PUBLISHING COMPANY, INC., a Delaware Corporation; SONY MUSIC ENTERTAINMENT GROUP, a Delaware Corporation; BMG DIRECT MARKETING, INC., a Delaware Corporation; THE COLUMBIA HOUSE COMPANY, an entity of unknown origin,
Defendants-Appellees.

November 9, 2004, Filed

JUDGES: Before: Mary M. Schroeder, Chief Judge, David R. Thompson, and Susan P. Graber, Circuit Judges.

OPINION: ORDER AMENDING OPINION AND DENYING REHEARING

ORDER

The Opinion filed on November 4, 2003, is hereby amended. The clerk shall file the attached Amended Opinion. With this Amended Opinion, the panel has voted unanimously to deny the petition for panel rehearing and petition for rehearing en banc.

The full court has been advised of the petition for rehearing en banc and no active judge has requested a vote on whether to hear the matter en banc. Fed. R. App. P. 35.

The petition for panel rehearing and the petition for rehearing en banc are DENIED. No further petitions for rehearing will be entertained.

Christopher Dobriain
303 Music & Media Building
University of California Irvine, CA 92697-2775

June 15, 2001

Statement regarding James Newton v. Beastie Boys, et al; Case No. 00-04909 NM

I. Qualifications of Christopher Dobrian as an expert witness in the field of music

A. Training and professional experience

- Associate Professor of Music, University of California, Irvine (UCI), specializing in composition, theory, and music technology: Director of music technology studies at UCI, Director of UCI's Gassmann Electronic Music Studio, Director of UCI's Realtime Experimental Audio Laboratory.

- Previous position, Assistant Professor of Music and interim Director of Graduate Studies in the Department of the Arts at Rensselaer Polytechnic Institute, Troy, NY.

- Ph.D. in Music Composition, University of California, San Diego: Composition studies with Joji Yuasa, Robert Erickson, Morton Feldman, Bernard Rands, and others; computer music studies with F. Richard Moore, George Lewis, Mark Dolson, and Marc Battier; studies in classical guitar with Pepe and Celin Romero.

- Works composed for flute as a solo or featured instrument:

Play for Me (Interproviplation III) for flute and realtime computer processing (2001)
Insta-pene- playtion (Interproviplaytion II) for flute and computer processing (2000)
Parable for bass flute, bass oboe, and bass clarinet (1987)
Nine Haiku for mezzo-soprano, flute, and guitar (1955)
Now and Their for flute, viola, guitar, and percussion (1984)

B. Publications

1. Books

MSP: The Documentation (1997, rev. 1995) published by Cycling '74 and l'IRCAM
Max Manual Addendum (1996) published by Opcode Systems, Inc.
Max Reference Manual (1995) published by Opcode Systems, Inc.
Getting Started With Max (1995) published by Opcode Systems, Inc.
Max User's Manual (1990) published by Opcode Systems, Inc.

2. Articles

Aesthetic Consideratiotis in the Use of "Virtual" Music Instruments (2001), submitted for the CHI workshop on New Interfaces for Musical Expression, April 1 & 2, 2001; Seattle, WA, USA.

ICMC Studio Report: The Gassmann Electronic Music Studio (2000), published in the proceedings of the (2000) International Computer Music Conference.

Programming New Realtime DSP Possibilities with MSP (1999), published in the proceedings of the the 2nd COST G-b Workshop on Digital Audio Effects (DAFx99), NTNU, Trondheim, Norway.

Computer Pitch Techniques in Musical Composition (1998), published in the proceedings of the 1998 International Symposium on Music and Computers (Corfu).

Digital Audio (1997), from MSP: The Documentation published by Cycling '74 and l'IRCAM

Algorithmic Generation of Temporal Form: Hierarchical Organization of Stasis and Transition (1995), published in the proceedings of the 1995 International Computer Music Conference and the proceedings of the 1995 International Symposium of Electronic Art.

ICMC Studio Report: iEAR Studios (1995), published in the proceedings of the 1995 International Computer Music Conference.

Music and Language (1990), internet publication

Textural Orchestration (1993), internet publication

Music and Artificial Intelligence (1993), internet publication

Thoughts on Composition and Improvisation (1991), internet publication Music Programming (1988), internet publication

C. Expert testimony in past cases

None.

D. Remuneration for this testimony

$500.

II. Questions to be addressed

A. Questions posed by counsel for the plaintiff regarding this case

1. Is the digital sample taken from James Newton's "Choir" reflected in the musical score filed with the Copyright Office?

2. Does this digital sample contain sufficient unique expression such that it is entitled to protection under copyright law?

B. Issues raised by the expert witness for the defendants

1. "The Sample Constitutes an Insubstantial Appropriation"

2. "The Sample Embodies Nothing More than the Idea of a Basic Multiphonic Flute Technique"

3. "The Sample Used by Beastie Boys is not Representative of What Mr. Newton Copyrighted"

4. "The Song and the Composition are Substantially Dissimilar"

III. Responses to questions and issues raised in part II above A. Questions posed by counsel for the plaintiff regarding this case

1. Is the digital sample taken from James Newton's "Choir" reflected in the musical score filed with the Copyright Office?

When I first heard "Pass the Mic" and the solo flute excerpt from "Choir" that is used in it, I quite naturally was attentive to the interesting flute sound and I performed a mental analytical dictation of the sound. My analysis, based purely on hearing the music, was that the sound was the result of one person playing and singing into a flute, with the voice starting on the same pitch as was being played on the flute, then performing a glissando (sliding pitch) to the pitch a semitone higher, and then back down to the original pitch, all the while keeping the played pitch constant.

Part of a classical musician's training is this very type of "dictation", the ability to listen to music and notate it on paper; in other words, to figure out what the composer most likely wrote that caused the performer to produce that sonic result. When a composer works, s/he imagines musical sound, or improvises it on an instrument, and then makes a notation on paper that s/he feels is most likely to cause a performer to play a substantially similar musical sound at a later time.

Music "dictation", then, is a way of "reverse-engineering" the composer's notation; based on the heard music. Trained musicians frequently take mental dictation while listening to music, and this enhances their understanding of the musical content.

When I later saw a photocopy of the score to the piece "Choir" that is certified as having been placed in the Copyright Office, I had no trouble identifying the point in the written score that the note C (an octave above middle C) is to be fingered while the notes C, D-flat, and C are to be sung. A footnotes instructs "This piece requires singing into the flute + fingering simultaneously." This is precisely the combination of pitches and the means of sound production that I expected to see – that is, the score corresponded very closely to the mental dictation I had taken before seing it – so I had no doubt that the opening notes of the score to "Choir" were a notated version of what I had heard. (Or, to state the matter more appropriately, the recording I had heard was clearly a performance of the same music as was notated in the score.)

The fact that I had no trouble making this correspondence between the recording and the notation is not in the least remarkable. Any musician trained in dictation, especially a musician experienced in hearing this type of dissonant tone combination and this contemporary flute technique, would recognize that the notation is a viable representation of the recoreded sound, and conversely that the sound is a reasonably accurate performance of the notation. I asseret that any musician with similar training would recongize this correspondence.

Furthermore, the fact that Mr. Newton notated this part of the composition in relatively standard classical notation – whereas other parts of the piece are notated with much less detail, for example simply with a notation to the flutist to perform "90 – 180 seconds of improvisation"—shows that he inteded for this particular portion of the piece to observe the notated characteristics in performance.

There is a long history of composers performing their own compositions, and in the past century there is also a tradition of composers making recording of their own works. Such recording have always been regarded as being in some way "diffinitive" performances, carrying a certain authority because the composer has demonstrated him/herself how s/he feels the notation – for example plays at a tempo slightly differendt from the one notated, etc. – or adds individual timbral expression (such as vibrato), this is considered to be an important commentary on the appropriate performance of the notated score. It is not considered to mean that the composer is no longer playing the same piece!

The expert witness for the defendants claims that the notation simply "is not representative of what Mr. Newton copyrighted". I contend that this witness's opinion is built on an erroneous idea of the role of notation (notation is intended by composeres to be descriptive of the performer's actions rather than of the resultant sound), an extremely restrictive view of the interpretive qualities a performer – especially the composer/performer – may bring to notated music, and perhaps on an incomplete understanding of the practical technical details of the performance of such

contemporary flute techniques. I will discuss these matters in section III.B.3.

My disagreemenets with this witness are based on my two decades of experience as a composer of modern music, including several works for flute involving modern techniques, and on my studies of the historical and contemporary role of music notation.

2. Does this digital sample contain sufficient unique expression such that it is entitled to protection under copyright law?

I would first point out that the CD on which the song "Pass the Mic" first appeared bears a written attribution to James Newton, and that the defendants did seek and receive permission to use the recorded excerpt from "Choir". The fact that they acknowledged Mr. Newton publicly indicates to me a) that they acknowledge him as the source of this music and b) that they acknowledge that the musical excerpt is sufficiently substantial to warrant public recognition for its originator. The fact that they sought also to obtain permission to use the recording as the sonic basis of their song similarly demonstrates that they considered the excerpt to be sufficiently distinctive and substantial to be protected intellectual property.

An attempt by the defendants or their expert witness at this point to state retrospectively that the excerpt used is too minimal to warrant protection appears decidedly revisionist, and ignores the fact that the defendants previously made acknowtedgements that belie their later deprecation of the source music.

That having been said, one can still make an independent assessment of whether the sample contains "sufficient unique expression" to be entitled to protection. This is a judgement on which even experts may reasonably differ, based on their own training. experience, and musical worldview. Of particular significance in this instance are:

a) the distinction between "sampling" a digital signal (using the audio data from one piece of music as an element in another piece of music by another artist) and plagiarizing or appropriating abstract musical ideas in the traditional sense, such as melody, chord progression, etc., and

b) the question of how traditional ideas of melody, motive, idea, and expression (largely based on pre-twentieth-century musical thought) may have to be modified to deal with the music of today, specifically the contemporary music of James Newton and the rap music of Beastie Boys.

a. The appropriation of digital samples is different from traditional plagiarism of a melodic, harmonic, or structural idea. First, there is the fact that the digital audio recording--even if modified electronically--can be demonstrated to have been derived from the original audio data itself, rather than from an abstract concept or idea. (In this case the point seems moot since the defendants have already acknowledged the source of the recording.) Secondly, the compositional technique of "sampling" (direct use of short excerpts taken from prior recordings by other artists), as practiced in many popular styles, almost invariably involves "repurposing" the excerpt, i.e., placing it in a new

context so that its structural role in the composition has changed from the original. Thus, a distinctive or recognizable excerpt of an earlier work "sampled" for such usage may be smaller than a traditional melody or chord progression which musicians would formerly have required to consider appropriated material protectable by copyright.

In any event, the time duration of a musical excerpt is not in itself sufficient measurement of the excerpt's protectability. Rather, it is the excerpt's uniqueness, recognizability, and embodied musical ideas which together comprise its quality of being original, and thus protectable. This could take a long or short time duration, depending on the musical material itself.

An example from well-known classical music literature may serve to clarify this matter. The opening four notes of Beethoven's Fifth Symphony in C Minor take only a couple of seconds to play, are remarkably simple (one might even say simplistic) as a melody, and contain only a single melodic interval (the major third). However, the rhythm and the melodic contour of these four notes (three repeated pitches in even rhythm, followed by a downward leap of a major third) make this brief excerpt eminently recognizable and unique, so much so that even non-musicians who are familiar with the Fifth Symphony can identify this as Beethoven's musical idea on hearing it. The question is really, "Would a person familiar with the composition [in this example, Beethoven's Fifth Symphony] recognize this two-second sample as being taken from--and perhaps even emblematic of that work written by Beethoven?" The answer is. "Yes."

Naturally this example is not meant to compare James Newton's composition with Beethoven's Fifth Symphony in terms of its cultural significance, nor are the two excerpts equivalent in terms of their compositional usage within the full piece from which they are extracted. The point of the example is simply that although the individual characteristics of the excerpts, as analyzed by a musicologist, may be simple and even unremarkable, each excerpt is recognizable as unique to that musical work. The example also highlights the fact that the material need not be lengthy nor a complete "melody" several measures in length. The Beethoven excerpt cannot really be said to be a "profound", "complex", or "expressive" statement by the composer. But, like the Newton excerpt, it is distinctive, and anyone familiar with the original piece--either via recording or written score--could easily hear the excerpt in isolation and recognize its origin.

b. Classical music theory attributes great importance to the pitches notated by the composer in a score, and argues (often naively) that the musical expression is largely embodied in the formations of the notated pitches. This type of musical analysis (although restrictive and incomplete) is often valuable for understanding traditional classical music. However, it is nearly useless for much other music that relies heavily on rhythm, percussive sounds. and unique instrumental timbres (tone colors) rather than pitch for musical content. In much contemporary instrumental music, as in rap music, the musical expression is not embodied solely in the choice of pitches or an extended lyrical "tune"; rather, it is in the rhythm, timbre, dynamics, cultural evocations, etc.

Applying traditional analysis to this brief excerpt from Newton's "Choir"--i.e., focusing solely on the notated pitches--a theorist could conclude (erroneously, in my opinion) that the excerpt contains an insignificant amount of information because it contains a simple "neighboring-tone" figure: C to D-flat and back to C. That might possibly be true if this were a melody from the baroque or classical periods (although such an analysis of even the Beethoven excerpt would disregard its orchestration, dynamics, etc., and would conclude that Beethoven's idea was insignificant, too). If, on the other hand, one considers the special playing technique described in the score (holding one fingered note constant while singing the other pitches) and the resultant complex, expressive effect that results, it is clear that the "unique expression" of this excerpt is not solely in the pitch choices, but is actually in those particular pitches performed in that particular way on that instrument. These components in this particular combination are not found anywhere else in the notated music literature, and they are unique and distinctive in their sonic/musical result.

The use of such tone color (a.k.a. "timbre"), in addition to pitch, to carry musical significance is very common in twentieth-century music. The palette of available musical sounds is much broader in the twentieth century than it was in earlier centuries (thanks mostly to the technology of sound recording). Similarly, in rap music, the tone colors of a diverse palette of pre-recorded sound samples are essential to the unique expression in the music. In this regard, contemporary "classical" music and rap music share some common aesthetic around. It happens that in "Pass the Mic"

Beastie Boys used the tone quality of Newton's music as the timbral foundation for their own.

B. Issues raised by the expert witness for the defendants

I recognize that music is a sufficiently complex art form that two experts may have very differing views of the same music. For this reason, opinions rendered by each expert cannot be viewed as purely objective; any such opinions are necessarily shaped by the individual's training, experience, and way of understanding the culture and the art.

In the paragraphs below, I provide reasons why I dispute claims made by the defendants' expert music witness, Lawrence Ferrara.

l. "The Sample Constitutes an Insubstantial Appropriation"

Mr. Ferrara says, "The Sample consists of a 'multiphonic' sound which overshadows singing which occurs within an extremely narrow range and which is barely perceptible." The statement that the singing is barely perceptible is quite subjective. To my ears the sinning was entirely obvious, even before I saw the written score. This subjective difference in perceptions can be attributed to my careful attention to detail in sounds as a result of my work as a composer and my analysis of sonic details in my work as a computer musician. It can also be attributed to my experience in contemporary music, in which such dissonant blends of sounds are heard.

The multiphonic sound is the result of both the flutist overblowing for timbral effect and the complex interaction of voice and flute in a dissonant relationship. For this reason; what Mr. Ferrara deprecates as "no more than a half step" pitch interval is in fact highly effective in creating a dissonant conflict between voice and flute that creates new frequencies, turbulence, and the unique sound of the excerpt. As this excerpt demonstrates, the significance of a musical pitch interval is not proportional to its size (contrary to what Mr. Ferrara implies).

To examine the frequency content of this excerpt in more detail, I did a computer analysis of the "Choir" excerpt to see what frequencies are present in the sound as it evolves over the course of the excerpt.

The attached pictures are spectral plots of two passages from Choir by James Newton. The plots show time going from the "front" of the picture toward the "back". Frequency is leftto-right from 100 Hz to 2000 Hz (0.1 KHz to 2.0 KHz). Amplitude is shown by the height and color at each frequency at each moment in time.

The picture called "ChoirExcerpt" shows the excerpt that the Beastie Boys extracted, as it originally appears in Newton's recording. Note that it has no less than seven(!) prominent frequency bands, each one changing amplitude at a different rate, including many harmonics of the main tone, some energy that's even lower than what he played (caused by difference tones and/or turbulence), and additional low level energy distributed throughout the spectrum. The main point here is that there are seven distinct main regions of energy in the frequency range being analyzed, and that the regions

evolve with a great deal of independence. This is the result of Mr. Newton's refined breath control for interpretive use of tone color. The independent prominences of the different component frequencies can be likened to 7-part counterpoint, demonstrating that the sound (notated rather simply in the score) is in fact way more complex than a normal single flute note.

The picture called "OneFluteNote" is included simply for purposes of comparison. It is an analysis of a point about l'30" into the piece. It's a single normal flute note (preceded by a very brief "grace note"). This is just for comparison purposes to show how simple the spectrum of a single focused normal flute note looks. It shows energy in a single frequency band (with a tiny bit of extra stuff at the beginning during the grace note). Very simple compared to the sound of Newton's playing in the appropriated excerpt.

The point of these analyses is to demonstrate that what the defendants' music expert regards as a very simple, minimal, and insignificant sound is in fact a complex and subtle counterpoint of sounds caused by the composed relationship between flute and voice and by the timbral shading imparted by the flutist. Viewed in this way (as I contend such timbral music should in fact be analyzed). the excerpt is significant and substantial enough to be distinctive and recognizable.

2. "The Sample Embodies Nothing More than the Idea of a Basic Multiphonic Flute Technique"

This statement assumes that Mr. Newton's claim to originality in the appropriated excerpt is based entirely on the fact that it uses vocalization and multiphonics.

Mr. Ferrara reduces the value of the excerpt down to nothing more than the techniques used to produce it, stating, "The Sample is not a copyrightable sound, in that it is a combination of basic flute techniques (also employed by other instruments) that has been used prior to Mr. Newton's 1978 copyright in the Composition, and continues to be used by jazz and avant-garde flute players..." Mr. Ferrara then lists a number of other works by other musicians which also use vocalization and multiphonics, indicating that this invalidates Newton's claim to originality in his own music.

This is a classic "red herring". First of all, no music can be discounted out-of-hand as being nothing more than the embodiment of the techniques used to produce it. This would be analogous to saying, "That picture is nothing more than some paint brushed onto a canvas. Plenty of artists had already done that." One need not have invented the technique used to make art or music in order to be inventive artistically. Furthermore, I doubt that Mr. Newton makes any claim to being the inventor of the idea of singing and playing simultaneously. In fact, as a virtuoso flutist of eclectic styles Mr. Newton is certainly well aware of all of the works cited by Mr. Ferrara. The recorded excerpt of Newton's music must be evaluated in terms of its sonic and musical content and concept, not in terms of whether it employs newly invented techniques.

3. "The Sample Used by Beastie Boys is not Representative of What Mr. Newton Copyrighted"

Mr. Ferrara bases this assertion on the fact that in the recorded performance Mr. Newtown blows and sings in

such a way as to emphasize the upper partials of the flute's complex harmonic tone color, to the extent that the upper partials become even more prominent than the fundamental tone. Because such a modification of tone color is not explicityly requested in the score, he concludes that the music on the recording is not what is in the score. His conclusion is based on a false and hyper-conservative notion of the relationship between score and sound, and the role of a performer in interpreting the score.

a) No notated score is a complete representation of the musical idea. Any score is necessarliy incomplete, and assumes that the performer will add his or her individual interpretation to the naotation. Usually the performer makes artisitc decision regarding specifics of the instrument's tone color (also termed its "timbre"), expressive effects such as vibrato, expressive sliding from one pitch to another (known as "portamento" or "glissando"), variations in tempo (known as "rubato"), variations in dynamics (cresendo, diminuendo), etc. The contribution of the perforer is often so great that s/he in fact provides just as much musical content as the composer. This is a well-known fact to musicians, and is the reason that we say that notated music is "interpreted" by the performer.

Performers often take rather extreme "liberties" with notated music. The score is there as a text, by the perforer adds the interpretation, and often adds many original inflection never imagined by the composer. Fore example, an opera singer might commonly hold a particular note for a much longer time than is indicated in the score (for aesthetic reasons, or simply to demonstrate prowess), and might to large expressive

glides in pitch from one note to antoher that are not notated by the composer. This is an accepted part of performance, and although musicians debate the tastefulness and appropriateness of such liberties, nobody would ever dream of serioulsly claiming that the performer is no longer singing the same piece of music.

In Newton's performance of his own compostion he uses breath control to modify the timbre of the sustained flute not rather extremely – to the point that its harmonic richness becomes so great that the listener can distinguish several of its component frequencies, thus the term "multiphonic" – and he uses portamento to glide expressively from one pitch to the other in the vocal part. Neither the timbral effect nor the portamento is notated in the score, but both of these performance ideas are well withing the norm of interpretive expression, especially in the genre of contemporary avant-garde music.

b) Any notated score is no so much a description of the sound as it is an instruction to the perforer of what to do to produce the sound. Thus, a notation of what Mr. Newton desired sonically in this passage from "Choir: would not attempt to write our every component frequency cuased by the complex interaction of voice and flute Insead, a composer notates the actions the player should take to achieve the sound (in this case playing and singing specific pitches), and knows how that action will result in sound. Thus, to say tat a score does not represent a recording because it does not visually depict every component sound that results is to grossly misunderstand the historical and practical role of music notation.

4. "The Song and the Composition are Substantially Dissimilar"

As I noted earlier (in section II.A.2.a), "sampling" as practiced by rap musicians is a technique that involves taking a musical excerpt and recontextualizing it in a new musical fabric. Frequently the sampled music (or sound) is "looped" repetitively to emphasize its immanent rhythmic characteristics, even if the sound is not repeated in that way in the original piece from which it was sampled. Despite this "repurposing" of the musical fragment in a new context and role, the rhythm and timbre of the fragment become important features in the new music, setting the tone in a significant way.

In the case of Beastie Boys' use of the excerpt from Newton's "Choir", they first present the excerpt by itself in its original form. This solo appearance of the excerpt at the very beginning of the song, lend it a special importance already. From then on, the excerpt continues as a constant part of the musical texture. Because of its initial solo introduction, the excerpt continues to be an important part of the tone color of the son, even when it is largely overshadowed by other instruments.

I agree with Mr. Ferrara's statement that the two pieces "are substantially dissimilar in concept and feel, that is, in there [sic] overall thrust and meaning", I feel that this is another "red herring" because it is in the nature of rap music to recontextualize, reuse, and change the overall meaning of the samples used. This does not mean that the sample has not been used; it only means that it has been used in a particular way. In this case, the sample contributes substantially to the

tone color and rhythm of the song, and the defendants effectively acknowledged that fact by thanking Newton in the liner notes of the CD.

IV. Summary and conclusions

A. The recorded excerpt of "Choir" used on Beastie Boys' "Pass the Mic" is truly a performance by composer/flutist James Newton of the copyrighted score for the music entitled "Choir" composed by James Newton, Conversely, the copyrighted score entitled "Choir" by James Newton is a notated documentation of how a flutist (in this case the composer himself) performs that music. Discrepancies between Newton's score of "Choir" and Newton's recording of "Choir", as pointed out by the defendants' expert music witness, all fall well within the bounds of standard accepted interpretation of a score by a performer, and/or demonstrate Newton's desired interpretation of the score; such variances cannot reasonably be considered a complete departure from the score. Therefore, even if the title were removed from both recording and score of "Choir", I would affirm that the recording and the notation are of the same piece of music.

To state the matter more simply, one can note that:

a) James Newton copyrighted a score of composed music entitled "Choir".

b) James Newton recorded the work "Choir", on a CD by ECM Records.

c) James Newton has only one composition entitled "Choir" recorded on ECM records, and has copyrighted only one score entitled "Choir".

d) There is thus no dispute possible. The recording is of the score, and vice versa. This does not require a "music expert" to determine.

e) On the CD "Check Your Head" on which the song "Pass the Mic" appears, Beastie Boys thank "James Newton for 'Choir,' (ASCAP) Courtesy of ECM Records."

f) Beastie Boys thus acknowledge using the recording, which is by logical deduction necessarily the recording of the copyrighted score.

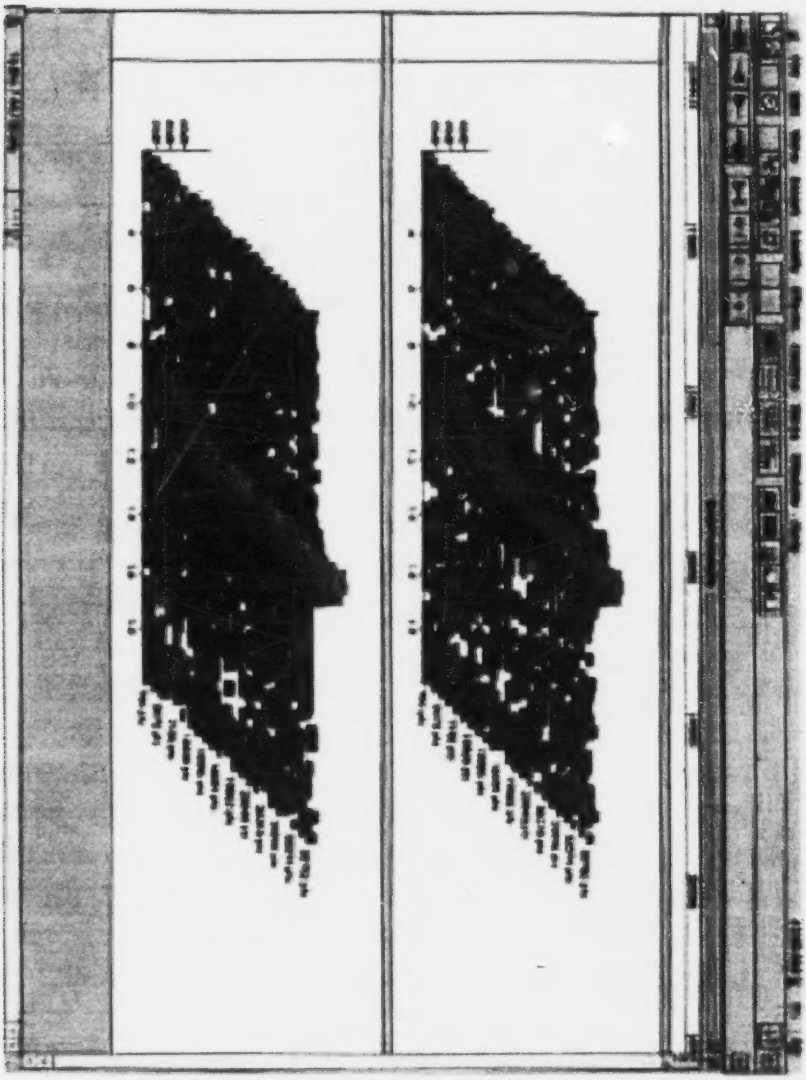
g) Efforts to disprove this intuitively obvious conclusion by pointing to discrepancies between the score and the recording-in light of the fact that all music performances contain ideas of timbre, portamento, etc. that are provided by the performer and that are not fully notated in the score by the composer-appear disingenuous on the face of it, and in any event have been disputed in my explanations in sections III.A. l and III.B.3.

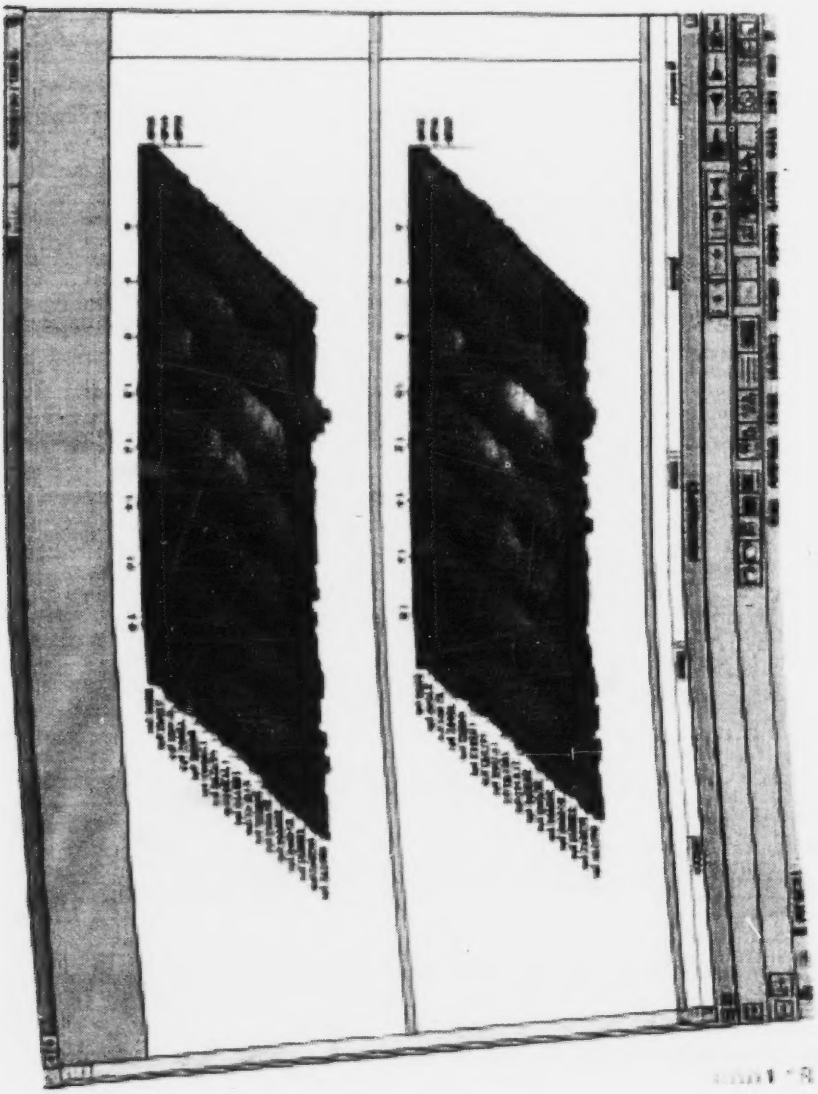
B. The excerpt from the recording of James Newton's "Choir" used by Beastie Boys in "Pass the Mic" contains sufficient unique musical expression to be protected by copyright law. It is possible to use seemingly objective criteria such as duration, number of notated pitches, etc. to try to deprecate the musical substance of a musical excerpt; however, it is my opinion that such criteria are of dubious utility in

evaluating traditional music, and are nearly meaningless when evaluating contemporary timbral music such as the excerpt from Newton's "Choir" or predominantly timbral elements looped repeatedly in a rap recording.

The notation for the Newton excerpt is brief and relatively simple, yet the timbral result of that notation is internally rich in complexity. It is precisely this combination of structural simplicity and sonic richness which makes the passage distinctive, recognizable, and easily identifiable as a particular moment in a particular original composition by James Newton.

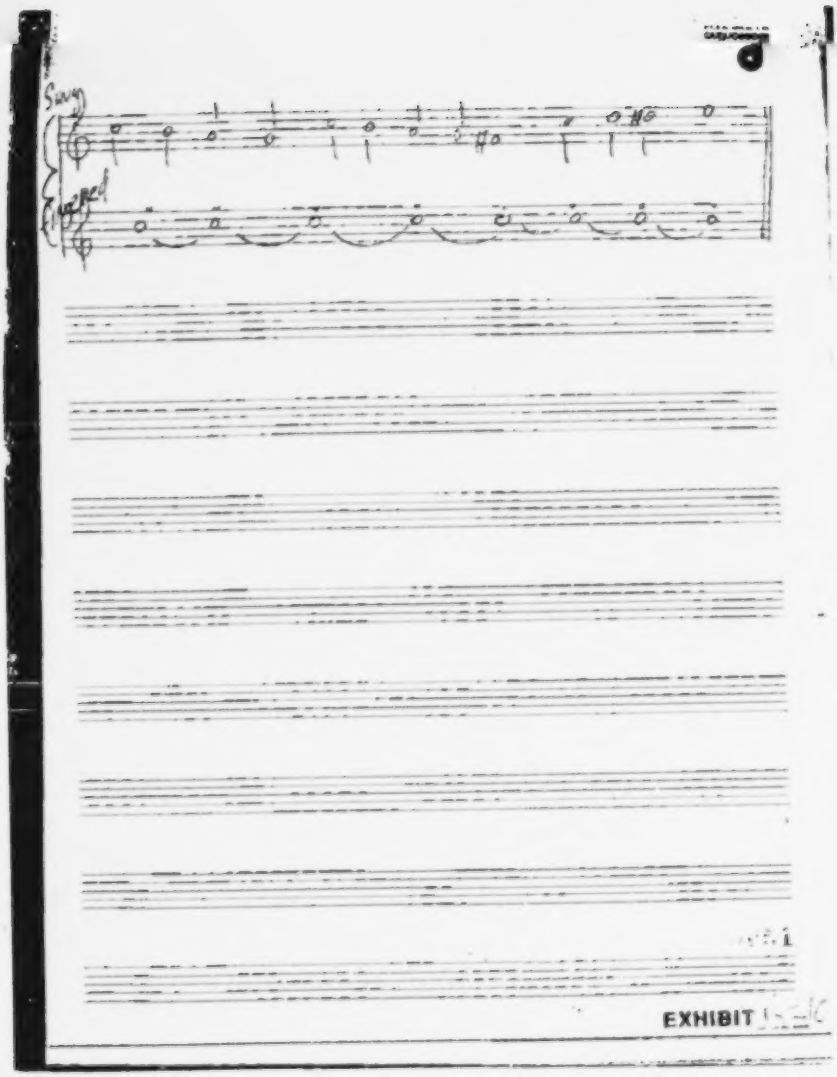
Signed,
/s/
Christopher Dobrian
Associate Professor of Music
University of California, Irvine





BEST AVAILABLE COPY

Choir -
Jaren Music : ASCAP
Flute Solo
Approx. 90 seconds of improvisation
Seven Misura
Largo
Sing
Finger
Sing
Finger
Sing
Finger
050
90-150 Seconds of improvisation
OVER
* This piece requires singing into the flute & fingering simultaneously
EXHIBIT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(3)

No. 04-1219

Supreme Court, U.S.
FILED
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IN THE

Supreme Court of the United States

JAMES W. NEWTON, JR., dba JANEW MUSIC,

Petitioner,

v.

MICHAEL DIAMOND, *et al.*,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

BRIEF IN OPPOSITION

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CORPORATE DISCLOSURE STATEMENT

Respondent Capitol Records, Inc. is a wholly-owned subsidiary of EMI Group North America Holdings, Inc., a privately owned company. The ultimate parent company, through a series of privately owned intermediate entities, is EMI Group, PLC, a United Kingdom public company.

Respondent Grand Royal Records, Inc. is a privately owned company. It is not a subsidiary of any other company and has no shareholders that are publicly held companies.

Respondent Universal Polygram International Publishing, Inc. is a wholly-owned subsidiary of Vivendi Universal S.A., a public company.

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SUMMARY OF THE ARGUMENT

Respondents oppose Petitioner's request for *certiorari* because his case does not pose any disputed question of federal law deserving of this Court's time and attention. Petitioner has fabricated a "Circuit split" and an appellate court error where none exist in a futile attempt to reverse his losses at both levels of the lower courts. There is no split between the Circuits concerning whether to take a "specialized audience" into account in assessing similarity in a copyright case, as evidenced by the fact that the district court and the Ninth Circuit *did* consider the view of a "specialized audience" (via expert testimony) in finding against the Petitioner. The lower courts' consideration of both parties' experts also refutes Petitioner's second ground for his request, namely that disputed issues of fact raised by the experts were ignored by the lower courts. The Supreme Court's counsel and resources should not be squandered on addressing the grievances of a disgruntled plaintiff, one whose case was fully and fairly heard and decided under black letter law about which there is no dispute among the Circuits. Petitioner's request for *certiorari* should be denied.

I. THERE IS NO CONFLICT BETWEEN THE CIRCUITS SUFFICIENT TO MERIT SUPREME COURT INTERVENTION.

There is no Circuit split regarding the recognition of the perspective of a specialized audience when determining the substantial similarity between two works. The cases that Petitioner relies upon, and other cases in these jurisdictions, reveal that courts consider the view of specialized audiences on a case-by-case basis based upon the facts of the particular case, even in those Circuits that the Petitioner claims do not consider "specialized audiences." *See, e.g., Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173,

1176 n.4 (9th Cir. 1989) ("By 'reasonable person' we mean a reasonable person in the intended audience."); *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 210 F. Supp. 2d 147, 161-62 (E.D.N.Y. 2002) ("Slight reverberations in Second Circuit case law suggest that the perceptions of the specialized intended audience may be significant. . . ."), *aff'd*, 354 F.3d 112 (2d Cir. 2003); *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 373 (5th Cir. 2004) (affirming use of jury instruction: "The test for expression of ideas is whether the intended audience would find the total concept and feel of the two songs to be substantially similar.")

In fact, the Fourth Circuit case[1] on which Petitioner places so much weight, relies upon Second[2] and Ninth[3] Circuit cases for its holding that inquiry into the perspective of the specialized audience was appropriate at the Court's discretion in assessing substantial similarity. *See Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 734 (4th Cir.), *cert. denied*, 498 U.S. 981 (1990). There is no line drawn in the sand, as Petitioner would have this Court believe, regarding the use of a "specialized audience" perspective versus a refusal to do so.[4] In fact, the Nimmer treatise explains at

1. *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731 (4th Cir.), *cert. denied*, 498 U.S. 981 (1990).

2. *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

3. *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).

4. At bottom, what Petitioner is actually referring to is whether Courts allow the use of expert testimony during the substantial similarity analysis because, practically, experts are the only way a trier of fact can understand the perspective of a specialized audience. It is undisputed that all jurisdictions allow the use of experts to assess similarity. *See, e.g., Baxter v. MCA, Inc.*, 812 F.2d 421, 424 (Cont'd)

length the various formulations of the "audience test" applied across the Circuits, but makes no mention of a distinction between use of a lay audience versus a specialized audience. *See* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03 [E][3] (2005) (hereinafter cited as "NIMMER"); *cf.*, *e.g.*, *Dawson*, 905 F.2d at 733 n.1 ("Some courts use a different set of labels for the two-prong inquiry. . . . The difference in labels need not concern us because the apparent consensus as to the nature of the tests applicable to each prong of the substantial similarity inquiry smooths[sic] over . . . underlying differences in the inquiry's two characterizations.").

At most, some commentators (but not Nimmer) identify the Fourth Circuit alone as one which has turned the factual inquiry regarding audience perspective used by all the Circuits into an actual "intended audience" rule. *See* Kristin Klick, *Lyons Partnership, L.P. v. Morris Costumes, Inc. – The Fuzzy Test Is Appropriate for Barney: The Fourth Circuit Casts Aside Adult Reasoning in Determining The Substantial Similarity Between The Famous Purple Dinosaur and an Imposter*, 61 Md. L. Rev. 1162, 1166, 1170-71 (2002); Leon Friedman, *Substantive and Procedural Aspects of Copyright Litigation*, 787 PLI/Pat 349, 371-71 (2004) ("If audience for works is specialized, test of substantial similarity is with respect to the reaction of the specialized audience. [The] [sic] Fourth Circuit has developed the 'intended audience' rule. . . .").

(Cont'd)

n.2 (9th Cir.) ("Upon remand . . . expert testimony and analytic dissection offered as to 'striking similarity' [of musical works] would certainly merit submission to a jury. . . ."), *cert. denied*, 484 U.S. 954 (1987); *Stromback v. New Line Cinema*, 384 F.3d 283, 295 (6th Cir. 2004).

Petitioner cites no basis or reason for imposing the Fourth Circuit "rule" (which is simply a common law codification of how the test is practically applied elsewhere) on the Circuit in which the case was brought and ignoring its black letter precedent. Moreover, even the Fourth Circuit does not require that the "intended audience" rule be applied in every copyright case, or even in most of them. *See Dawson*, 905 F.2d at 736 (the burden of the rule would be a "substantial one if our holding were read as an invitation . . . to put before the court the seemingly unanswerable question of whether a product's audience is sufficiently specialized to justify departure from . . . the ordinary observer test. . . . [Therefore] in any given case, a court should be hesitant to find that the lay public does not fairly represent" the intended audience.)

Petitioner also mischaracterizes the issue that is "ripe" for Supreme Court review identified by the Nimmer treatise. *See* 4 NIMMER, § 13.03 [E][1][b], at 13-86 n.202.15. The issue the Nimmer treatise is referring to is not whether the "audience test" should be applied from the perspective of the ordinary lay observer versus a specialized audience member, but rather whether the "audience test" should be applied *at all*, and, in a footnote (*id.*), cites the differing applications of the test across the Circuits as one reason Supreme Court review for the entire doctrine may be appropriate. *See also id.* § 13.03 [E][1][b], at 13-86-87 ("Given the questionable doctrinal footing for the audience test and . . . the myriad exceptions in the way it is applied. . . . [i]t would seem preferable, in short, to discard the audience test."). Nimmer believes that the "audience test" is a departure from this Court's formulation of the copyright infringement test in *Fiest Publications, Inc. v. Rural Telephone Service Co.*[5], and therefore should be reviewed by this Court. *See id.*, § 13.03[E][1][b], at 13-85-87. This issue, however, is not the question that Petitioner poses this Court, which is

5. 499 U.S. 340 (1991).

far narrower and concerns *how* the "audience test" should be applied, not whether it should be applied at all. If this Court were to reconsider and abandon the "audience test" overall in reviewing Petitioner's case, such a holding would only be dictum here. This case is not the case to reconsider the "audience test" if such a review is even necessary.

Moreover, Petitioner is not correct that the "audience test" application is the only "disagreement" among the Circuits in copyright law ripe for Supreme Court review. To name only one example, just this past March this Court heard arguments in *Metro-Goldwyn-Mayer Studios, Inc. et al. v. Grokster Ltd., et al.*, No. 04-480, which concerned a split between the Seventh and Ninth Circuits in the application of the doctrine of contributory and vicarious liability for copyright infringement.

Even if the differing applications of the "audience" test identified by the Petitioner could be considered a true Circuit split worthy of Supreme Court attention, the instant case does not concern that particular difference of opinion. Not one of the cases Petitioner cites as evidence of this split from either one of the two groups of Circuits concerns the same issue as the case at bar — the determination of whether the portion used from Petitioner's work was a *de minimis* portion of the asserted work overall. All of the cases cited concern the assessment of *similarity* between the works, not a *de minimis* analysis. *See cases cited in Pet'r. Br.*, pp. 13-18. Although related, there is a distinction between these two analyses as the Ninth Circuit noted. *See Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004); *see also* 2 NIMMER, § 8.01[G], at 8-24 (the defense of *de minimis* copying is the "converse" of substantial similarity). Thus, the so-called "Circuit split" identified by Petitioner does not concern the specific issue in this case, and its resolution would not provide Petitioner the relief he is seeking.

Finally, Petitioner has no basis for claiming that the perspective of a "specialized audience", *i.e.* an expert, was not used in his case because in fact it was. Both the district court and the Ninth Circuit clearly relied on both sides' experts to assess the *de minimis* nature of Respondents' use. *See Newton*, 388 F.3d at 1194, 1196. The experts' opinions on both sides of the case are quoted extensively in the Ninth Circuit's opinion. *Id.* Clearly, neither the district court nor the Ninth Circuit relied on a lay audience perspective to conclude that the Respondents used a *de minimis* portion of Petitioner's composition. *See*, *e.g.*, *id.* at 1194. The Ninth Circuit's reliance on experts here demonstrates that the "critical split" identified by Petitioner among the Circuits is a fabrication. And, again, provided such a split does exist, its resolution will have no affect on Petitioner's case because the lower courts here did rely on a specialized, expert perspective to find for the Respondents.

II. THE NINTH CIRCUIT DID NOT ERR IN AFFIRMING SUMMARY JUDGMENT.

The two sides of Petitioner's argument are inconsistent. In the first section of his brief, Petitioner complains that the courts below did not take expert analysis (in order to understand the perspective of a "specialized audience") into sufficient account; in the second section of his brief, he complains that the courts below did not allow the trier of fact (a jury that would undoubtedly consist of non-experts in the majority if not the entirety) to make factual determinations. The two sides of Petitioner's entire argument are fundamentally at odds.

Furthermore, Petitioner's claim that the courts below disregarded the expert testimony, and thereby ignored disputed issues of fact, is incorrect. The courts below extensively analyzed and relied upon both parties'

experts to reach their conclusion. Petitioner's true concern is not that the lower courts disregarded his experts, but that they found his experts' testimony supported Respondents' argument. *See Newton*, 388 F.3d at 1194 ("In filtering out the unique performance elements from consideration, and separating them from those found in the composition, we find substantial assistance in the testimony of Newton's own experts."), 1196 ("Newton ... maintains that the testimony of his experts creates a genuine issue of material fact. ... To the extent the expert testimony is relevant, it is not helpful to Newton.") Petitioner is simply hoping for another chance to prevail on his case. Respectfully, Petitioner's loss in the courts below does not concern legal questions of sufficient import to require the Supreme Court's attention and resolution.

CONCLUSION

For all the reasons cited above, Respondents' respectfully request that this Court deny the Petition for Writ of Certiorari.

Respectfully submitted,

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No. 04-1219

IN THE

Supreme Court of the United States

JAMES W. NEWTON, JR.,
DBA JANEW MUSIC, PETITIONER

v.

MICHAEL DIAMOND; ADAM HOROWITZ; ADAM YAUCH, DBA BEASTIE BOYS; CAPITOL RECORDS, INC., A DELAWARE CORPORATION; GRAND ROYAL RECORDS, INC., A CALIFORNIA CORPORATION; UNIVERSAL POLYGRAM INTERNATIONAL PUBLISHING, INC., A DELAWARE CORPORATION; BROOKLYN DUST MUSIC, AN ENTITY OF UNKNOWN ORIGIN; MARIO CALDATO, JR., AN INDIVIDUAL; JANUS FILMS, LLC, A NEW YORK LIMITED LIABILITY COMPANY; CRITERION COLLECTION, A CALIFORNIA PARTNERSHIP; VOYAGER PUBLISHING COMPANY, INC., A DELAWARE CORPORATION; SONY MUSIC ENTERTAINMENT GROUP, A DELAWARE CORPORATION; BMG DIRECT MARKETING, INC., A DELAWARE CORPORATION; THE COLUMBIA HOUSE COMPANY, AN ENTITY OF UNKNOWN ORIGIN

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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INTRODUCTION

Respondents' opposition to the petition for certiorari is remarkable for what it both admits and omits. Respondents essentially admit the audience issue is ripe for Supreme Court review, ignore the vast majority of authorities cited in the petition, and misconstrue the few cases they do cite. Ultimately, respondents merely quibble with the breadth of the existing circuit split (petitioner establishes an 8-3 split, while respondents concede a 6-2 split) and the result this Court should reach (i.e. whether the audience test should be clarified or abandoned). Respondents' opposition cannot obscure that the issue presented by the petition – whether the substantiality of sophisticated or complex aesthetic expression should be evaluated by an ordinary lay audience – reflects a gulf between the circuits, is of great public importance, and deserves Supreme Court review.

ARGUMENT

I. A Genuine and Acknowledged Circuit Split Exists Concerning the Audience Test

A. The Plain Language of the Ninth Circuit Opinion in *Newton* is Unambiguous

To avoid review, respondents argue the Ninth Circuit panel in *Newton* somehow did not mean what it explicitly and repeatedly said. In the majority opinion, the *Newton* court states "a use is de minimis only if the *average audience* would not recognize the appropriation" (App. 7a); the de minimis and substantial similarity tests both "look[] to the response

of the *average audience*, or *ordinary observer*, to determine whether a use is infringing" (App. 8a); and "we conclude that an *average audience* would not discern Newton's hand as a composer." (App. 15a) (emphasis added). Likewise, Judge Graber's dissent applies the "average audience" or "reasonable listener" standard. (App. 17a). These plain words speak for themselves. The Ninth Circuit used an ordinary lay audience test when evaluating the substantiality of petitioner's work. *See Dugger v. Adams*, 489 U.S. 401, 416 n. 5 (1989) (Supreme Court reviews lower court opinions based on their plain language); *cf. Robinson v. Shell Oil Co.*, 519 U.S. 337, 340 (1997) (in statutory interpretation, courts do not look beyond the plain meaning of the language used).

B. Respondents Concede a Wide Circuit Split

Petitioner identified six circuits besides the Ninth Circuit that uniformly apply the ordinary lay audience standard. (Pet. at 12-15). Respondents do not discuss any of the cases cited by petitioner, or any other case law, from those six circuits.

Petitioner also identified three circuits applying the specialized audience standard. (Pet. at 16-18). Respondents discuss the Fourth Circuit (which petitioner addresses in § I.C below), but ignore whether this specialized audience standard also applies in the Third and Sixth Circuits, as petitioner argued. (Pet. at 17-18). At minimum, therefore, respondents concede by omission at least a 6-2 circuit split on the audience issue.

C. Respondents Fabricate a "Case-By-Case" Standard Where None Exists

Respondents argue that all the circuits actually apply the specialized audience test on a so-called "case-by-case" basis. (Opp. at 1). This proposition has no basis in reality, and contradicts the case law and all the commentators. Indeed, respondents fail to cite a single authority supporting this proposition.

First, respondents apply their "case-by-case" concept to those circuits employing the specialized audience test when addressing the aesthetic arts. (Opp. at 2-3). However, respondents mislead this Court, and undermine their own argument, by taking liberty with the holding of the single case they cite. Respondents argue the Fourth Circuit in *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731 (4th Cir. 1990), *cert. denied*, 498 U.S. 981 (1990) held that "inquiry into the perspective of the specialized audience was appropriate *at the Court's discretion* in assessing substantial similarity." (Opp. at 2) (emphasis added). However, the *Dawson* court actually held that "a district court *must* consider the nature of the intended audience of the plaintiff's work." *Dawson*, 905 F.2d at 736 (emphasis added).[1] Thus, the

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[1] Respondents quote from *Dawson* to imply that the difference between the ordinary lay audience and the specialized audience standards is merely a matter of "labels" that need not concern the Court because there is a "consensus as to the nature of the tests applicable to each prong of the substantial similarity inquiry [that] smooths over ... underlying differences in the inquiry's two characterizations." (Opp. at 3, quoting *Dawson*, 905 F.2d at 733 n. 1). However, this quotation does *not* address the issue of audience perspective, and respondents' use is completely out of context and misleading. *See Dawson*, 905 F.2d at 733.

specialized audience test is, in fact, a "line in the sand," as respondents put it.[2]

Second, as to those circuits applying the ordinary lay audience test, respondents try to draw a case-by-case standard out of *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1176 n. 4 (9th Cir. 1989). That decision is inapposite, because it involved an evaluation of highly sophisticated computer software. As petitioner previously noted, courts generally view computer technology as a field apart from the aesthetic arts, and hold that software programs require analysis by persons with expertise in the field. (Pet. at 17-18 & n. 8). *See Computer Associates Intern., Inc. v. Altai, Inc.*, 982 F.2d 693, 713 (2nd Cir. 1992) (recognizing that computer technology is evaluated by the specialized audience standard); M. Nimmer & D. Nimmer, *Nimmer on Copyright*, § 13.03[E][4] at 13-101 (2005). The Ninth Circuit's holding in the computer arena therefore is irrelevant to the issue presented by this petition.[3]

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[2] *See also Lyons Partnership, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 803 (4th Cir. 2001) ("the court's inquiry *must* be focused upon the perspectives of the persons who comprise" a particular audience) (emphasis added); Binder, Perry Z., *Proof of Music Sampling in Copyright Infringement*, 26 Am.Jur. Proof of Facts 3d 537, § 24 ("several federal circuits have recognized" that certain cases demand that the audience have "the expertise to distinguish among the nuances in the musical compositions presented to them.").

[3] Respondents also cite *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 210 F.Supp. 2d 147, 161-62 (E.D.N.Y.), *aff'd on other grounds*, 354 F.3d 112 (2d Cir. 2003). However, that district court decision is trumped by the Second Circuit holding in *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d

Thus, in the aesthetic arts seven circuits universally apply the ordinary lay audience test, and three others apply the specialized audience test when presented with complex or sophisticated artistic material. The difference between these two tests is real, significant, and worthy of Supreme Court resolution. (Pet. at 12-21; Brief Amicus Curiae of Meet the Composer, *et al.* at 9-11).

D. The *Newton* Opinion is the Appropriate Vehicle for this Court's Review

To evade the undeniable circuit split on the audience issue, respondents argue the *Newton* case is an inappropriate vehicle for review. (Opp. at 5).

1. The *Newton* Opinion Properly Addresses the Substantiality Issue

Respondents argue *Newton* is distinguishable from all other cases cited in the petition because *Newton* concerns a *de minimis*, rather than a substantial similarity, analysis. But as petitioner explained, *both* analyses use the *exact same test* for substantiality. (Pet. at 11). In fact, the *Newton* court held:

> [A] use is de minimis only if the average audience would not recognize the appropriation... This observation reflects the relationship between the de minimis maxim and the general test for

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127, 130 (2nd Cir. 2003) (applying ordinary observer test), as cited in the Petition (at 18 n. 8).

> substantial similarity, which also looks to the response of the average audience, or ordinary observer, to determine whether a use is infringing... *To say that a use is de minimis because no audience would recognize the appropriation is thus to say that the use is not sufficiently significant.*

(7a-8a) (citations omitted) (emphasis added).

Respondents also cite Nimmer's statement that "'*de minimis* copying' represents simply the converse of substantial similarity." *Nimmer* § 8.01[G] at 8-24. (Pet. at 11; Opp. at 5). Respondents take this statement out of context and turn the intended meaning on its head. In context, Nimmer's statement means where a portion of copied work is so small that it is *de minimis*, the taking is not substantial. In this sense, works that fall on opposite sides of the line between *de minimis* and substantial are deemed the "converse" of one another.[4]

2. The *Newton* Court's Discussion of Expert Testimony is Irrelevant

Respondents also argue the Ninth Circuit in *Newton* contradicts its ordinary lay audience standard by relying on expert testimony. (Opp. at 2). While the Ninth Circuit did discuss expert testimony, this in itself is not remarkable. Respondents' attempt to make it

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[4] *See also Nimmer* § 8.01[G] at 8-24 ("for similarity to be substantial, and hence actionable, it must apply to more than simply a *de minimis* fragment."); *id.* § 13.03[F][5] at 13-145.

seem so is based on an oversimplification of the legal analysis and a misreading of the Ninth Circuit's opinion.

The *Newton* court addressed the expert testimony in the context of separating the elements of Newton's work that are unique to his performance from those contained in the composition. (App. 9a) ("In filtering out the unique performance elements from consideration, and separating them from those found in the composition, we find substantial assistance in the testimony of Newton's own experts."). This was the main point upon which expert testimony was considered. (App. 9a-11a).

The *Newton* court then addressed the substantial similarity test, holding that from the perspective of an ordinary lay audience the sampled compositional material was not substantial. (App. 13a-15a). In its analysis, the court did reference some expert testimony, but did so only in dictum to show that, in the majority's opinion, Newton's own evidence could not support his position. This is clear in the court's preface to this discussion: "To the extent the expert testimony is relevant, it is not helpful to Newton." (App. 14a). If, as respondent argues, expert testimony were necessary to the court's decision, there would be no need for this limiting statement. Similarly, in *Baxter v. MCA, Inc.*, 812 F.2d 421, 423 (9th Cir. 1987), *cert. denied* 484 U.S. 954 (1987), the Ninth Circuit approved the district court's review of lay *and expert* testimony on the question of how an ordinary lay audience would respond to the music under consideration. The district court was faithful to the Ninth Circuit standard, despite its consideration of expert testimony, by restricting its ultimate conclusion

to a subjective reasonableness standard, stating: "This Court's 'ear' is as lay as they come." *Id.*[5] The Ninth Circuit's *holding* in *Newton*, as in *Baxter*, is consistent with the ordinary lay audience standard.[6]

E. Respondents Recognize that the Audience Issue is Ripe for Supreme Court Review

Respondents concede that of all the issues in copyright law, the only one identified by Nimmer as ripe for review is the audience issue. (Opp. at 4-5). Petitioners attempt to limit the damage by arguing the distinction between the ordinary lay audience and the specialized audience is a subset of the broader position taken by Nimmer, i.e. that the audience test ought to be abandoned in each of its configurations. (*Id.*). But Nimmer's central concern is that the ordinary lay

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[5] Respondents attempt to mislead the Court by conflating the objective and subjective prongs of the substantial similarity test. *See Sid & MartyKrofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (describing two-prong test). Respondents selectively quote from *Baxter* by omitting that the court's ultimate reliance on the expert testimony was to be limited to the objective prong. *Baxter*, 812 F.2d at 423.

[6] Even if the Ninth Circuit did consider some of the expert testimony in its substantiality holding, this would not mean that the case is unsuitable for Supreme Court review. At most, it would show the Ninth Circuit may be of a mixed mind as to the interplay between the ordinary lay audience standard and the admission of expert testimony. Regardless, the *Newton* case still presents the audience issue as ripe for review, since the question of which audience perspective to apply when evaluating substantiality lies at the heart of the case. In addressing that issue, the Court is free to address the related issue of whether the Ninth Circuit erred in considering expert testimony when addressing a subjective audience response.

audience test "may not always prove an accurate guide to ferreting out the existence of" artistic theft in those cases where the "immediate and spontaneous observations of a person untrained in the special requirements and techniques" of a particular art form "may fail to note similarities that, if analyzed and dissected, would be only too apparent" from a specialized perspective. *Nimmer* § 13.03[E][2] at 13-92. Thus, the issue presented by this petition is precisely the issue motivating Nimmer's conclusion that the audience test is ripe for Supreme Court review.[7]

II. Petitioner's Arguments are Consistent

Petitioner also claims the Ninth Circuit in *Newton* usurped the jury's role by resolving key material issues of fact on summary judgment. Respondents mistakenly allege this claim is inconsistent with petitioner's other argument regarding the audience test.

Petitioner raises two arguments regarding the *Newton* court's misapplication of the summary judgment standard: (1) that the court disregarded expert testimony establishing that the *Choir* excerpt is *qualitatively* significant (Pet. at 22-26), and (2) that the court substituted its own lay opinion of substantiality for that of the jury (Pet. at 26-27). On the first argument, petitioner addressed whether the unique elements of *Choir* derive from the sound recording or

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[7] Even taking respondents' argument at face value, the petition certainly raises the validity of the audience test and presents the Court with the opportunity to abandon the test altogether, clarify which version of the test to validate, create a new application of the test, or devise any other remedy for the circuit split.

the composition. This issue is not relevant to the audience test, as discussed in § I.D.2 above, so there can be no inconsistency. On the second argument, petitioner contends the Ninth Circuit ignored numerous compositional elements by applying an ordinary lay audience standard, rather than a specialized audience standard, in analyzing the unpublished score. There is no inconsistency.

CONCLUSION

Petitioner respectfully requests that the petition for a writ of certiorari be granted.

Respectfully submitted,

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(2)

Supreme Court, U.S.
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No. 04-1219

IN THE

Supreme Court of the United States

JAMES W. NEWTON, JR.,
DBA JANEW MUSIC, PETITIONER

v.

MICHAEL DIAMOND; ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

BRIEF AMICUS CURIAE OF MEET THE COMPOSER, AMERICAN COMPOSERS FORUM, ELECTRONIC MUSIC FOUNDATION, SAN FRANCISCO CONTEMPORARY MUSIC PLAYERS, DR. BILLY TAYLOR, OSVALDO GOLIJOV, JON JANG, GRANT GERSHON, STANELEY CROUCH, GARY GIDDINS, MARTY EHRLICH, FARAH JASMINE GRIFFIN, BILL FRISSELL, LEE TOWNSEND AND ROBERT G. O'MEALLY IN SUPPORT OF PETITIONER

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MOTION OF AMICI CURIAE FOR LEAVE TO FILE BRIEF

Prospective amicus parties Meet the Composer ("MTC"), American Composers Forum ("ACF"), Electronic Music Foundation ("EMF"), San Francisco Contemporary Music Players ("SFCMP"), Dr. Billy Taylor, Osvaldo Golijov, Jon Jang, Grant Gershon, Stanley Crouch, Gary Giddins, Marty Ehrlich, Farah Jasmine Griffin, Bill Frisell, Lee Townsend and Robert G. O'Meally hereby respectfully request leave to file a brief as amici curiae in support of James Newton's petition for writ of certiorari. Amici have sought the consent of each of the respondent parties, but none of the respondents have granted consent. Petitioner has consented to the filing of the amicus brief.

Amici are a collection of nationally renowned music organizations, composers, producers, commentators, and professors who are at the forefront of the jazz and avant-garde music community. The depth and breadth of knowledge and experience of the amicus parties enables them to present this Court with a perspective unequalled by any of the individual parties to this suit. First and foremost, amici share an interest in protecting original artistic creation, especially in music, and are able to provide the Court with a detailed explanation of the kinds of music implicated by this suit. This, in turn, provides the foundation upon which the Court can evaluate petitioner's central argument that certain kinds of music are so complex, non-traditional, or sophisticated that they should not be evaluated without specialized expertise. Amici also are uniquely positioned to inform the Court of the great public importance of the issues

presented in this case to composers, musicians, producers, and all others involved in the music industry.

For the above reasons Amici respectfully request that the Court grant leave to file the accompanying amicus brief in support of Petitioner James Newton.

Respectfully submitted,

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NEWTON V. DIAMOND, 388 F.3D 1189 (9TH CIR. 2003) 18

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TEMPO MUSIC, INC. V. FAMOUS MUSIC CORP., 838 F.SUPP. 162 (S.D.N.Y. 1993) 13

OTHER AUTHORITIES

A. Kohn & B. Kohn, Kohn on Music Licensing, 2nd Ed., 1287-1288 (1996) 9

Alice J. Kim, *Expert Testimony and Substantial Similarity: Facing the Music in (Music) Copyright Infringement Cases*, 19 Colum.-VLA J.L. & Arts 109 (1995) ..... *passim*

David Sanjek, *"Don't Have to DJ No More": Sampling and the "Autonomous" Creator*, 10 Cardozo Arts&Ent.L.J. 607 (1992) 11

Debra Presti Brent, *The Successful Musical Copyright Infringement Suit: The Impossible Dream*, 7 U. Miami Ent. & Sports. L. Rev. 229, 248-249 (1990) 13

C. Coss & D. Warner (Eds.) Audio Culture: Readings in Modern Music (2004) ..... *passim*

J. Leeds, "Timeline: Mix and Mash," NY Times, Jan. 9, 2005 at Section 2 , Page 4 , Column 5 10

M. Tucker, The New Grove Dictionary of Jazz, 1213 (B. Kernfeld, ed., 2000) 16

Michael L. Baroni, *A Pirate's Pallette: The Dilemma of Digital Sound Sampling and a Proposed Compulsory License Solution*, 11 U. Miami Ent. & Sports L.Rev. 91 (1993) 10

Nancy L. McCullough, *Making the Case Against Illicit Sampling*, 26 Beverly Hills Bar Ass'n J. 139 (1992) 10

Nancy L. McCullough, Note, *A New Spin on Music Sampling: A Case for Fair Pay*, 105 Harv. L. Rev. 726 (1992) 10

R. Walker, "Consumed: The Grey Album," NY Times, March 21, 2004 at Section 6 , Page 32 , Column 1 10

R. Witmer, The New Grove Dictionary of Jazz, 921 (B. Kerfeld, ed., 2000) 16

R.P. Morgan, Twentieth-Century Music (1991) ..... *passim*

Robert M. Szymanski, *Audio Pastiche: Digital Sampling, Intermediate Copying, Fair Use*, 3 UCLA Ent.L.Rev. 271 (1996) 9

Stephanie J. Jones, *Music Copyright in Theory and Practice: An Improved Approach for Determining Substantial Similarity*, 31 Duq. L. Rev. 277, 294-95 (1993) 13

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INTEREST AND IDENTITIES OF AMICUS PARTIES

Meet The Composer ("MTC") is a non-profit organization based in New York City whose mission is to increase opportunities for composers by fostering the creation, performance, dissemination, and appreciation of their music. MTC was founded in 1974 as an outgrowth of a program of the New York State Council on the Arts. MTC seeks to enable composers to make a living writing music and to increase their visible presence as creative artists. Through a range of commissioning, residency, education and audience interaction programs, MTC has revolutionized the environment for composers in this country, establishing broadly accepted standards of payment and opening doors for them to work in a variety of cultural institutions.

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[1] No persons or entities other than amici curiae, their members, and their counsel, have made monetary contributions to the preparation or submission of this brief. Counsel for Petitioner James Newton have provided editorial suggestions concerning the substance of the brief.

American Composers Forum ("ACF") was founded in 1973 as the Minnesota Composers Forum. The American Composers Forum is committed to supporting composers and developing new markets for their music. Its 1,700 members include composers and performers, presenters and organizations that share ACF's goals, and individuals and institutions with an interest in supporting new music. Through granting, commissioning, and performance programs, ACF provides composers at all stages of their careers with valuable resources for professional and artistic development.

Electronic Music Foundation ("EMF") is a non-profit organization based in New York City whose mission is to empower individual creativity and expand the public's range of musical experience. Founded in 1994, EMF fosters exploration and the development of new ideas by producing events, disseminating information and materials about the history and current practice of electronic music, and maintaining a global network of contacts and collaborators.

The **San Francisco Contemporary Music Players** ("SFCMP") is a leader among American performing ensembles dedicated to contemporary chamber music. A nine-time winner of the national ASCAP/Chamber Music America Award for Adventurous Programming of Contemporary Music, this ensemble of 19 musicians has performed more than 1,000 contemporary works, made or contributed performances to sixteen recordings, and has widened the audience of this repertoires through publication and outreach over the last 34 years.

Dr. Billy Taylor is considered one of the leading jazz educators today. After receiving a bachelor degree in music in 1942, Dr. Taylor moved to New York where he worked with Ben Webster and played with such important musicians as Dizzy Gillespie, Don Redman and Charlie Parker. Years later he became the house pianist at Birdland where he supported such artists as Roy Eldridge, Lee Konitz and Oscar Pettiford. In 1975, he received his DME (Doctorate of Music Education) from the University of Massachusetts for his dissertation *The History and Development of Jazz Piano: a New Perspective for Educators*, and in 1982 he published a further work entitled *Jazz Piano: History and Development.* Along with his commitment to education, he has continued to develop as a pianist, displaying a light, fluid and inventive bop style.

Osvaldo Golijov is a composer whose work is performed regularly by musicians such as Robert Spano, Miguel Harth-Bedoya, Dawn Upshaw, Luciana Souza, Maya Beiser, the St. Lawrence, Kronos and Borromeo quartets, and orchestras such as the Boston Symphony and Los Angeles Philharmonic. Dr. Golijov has collaborated on more than 30 works with the Kronos Quartet, and has received numerous commissions from major ensembles and institutes in the U.S. and Europe, including a MacArthur Fellowship, among many other awards. After studying with Mark Kopytman in the Ukraine, whose influence on him included aleatoric music and graphic notation, Golijov arrived in the United States in 1986 and studied with George Crumb while earning a Ph.D from the University of Pennsylvania.

Jon Jang is a nationally recognized San Francisco Bay Area composer, pianist and artistic director of jazz and new music ensembles, whose original works are acclaimed for their compelling mix of different influences and sounds. As a composer, Mr. Jang has received commissions from the NEA, Rockefeller Foundation, Cal Performances, Berkeley Repertory Theatre, Festival 2000 and the Kronos Quartet.

Grant Gershon, who was appointed music director of the Los Angeles Master Chorale in July 2001, has garnered tremendous critical acclaim during his two seasons at the helm of the renowned chorus. Prior to joining the Chorale, Gershon served as assistant conductor of the Los Angeles Philharmonic from 1994-97. He has guest conducted the St. Paul Chamber Orchestra, Houston Grand Opera, Julliard Opera Theatre, and the Finnish chamber orchestra Avanti!, among others, and conducted performances at the Edinburgh, Vienna, Helsinki, Ravinia, and Aspen Music Festivals, the Roma-Europa Festival, and the Festival Otonno in Madrid. In addition to recording with the Los Angeles Master Chorale, Gershon has made a number of other recordings and served as chorus master on two Grammy-nominated CDs, *Sweeney Todd* and Ligeti's *Grand Macabre.*

Stanley Crouch is a columnist, novelist, essayist, critic and television commentator. He has served since 1987 as an artistic consultant at the Lincoln Center in New York City, and is a co-founder of the department known as the Jazz at Lincoln Center. In 1993, he received the Jean Stein Award from the American Academy of Arts and Letters and a MacArthur Foundation Grant.

Gary Giddins was author of the Weather Bird column for the Village Voice for 30 years. His writings on jazz have appeared in many other publications, including the New York Times, the New Yorker, Esquire, the Atlantic, the Los Angeles Times, the Boston Globe, and Jazz Times, to which he presently contributes a monthly column. His book "Visions of Jazz" is the only work on jazz ever to win a major mainstream literary prize, the 1998 National Book Critics Circle Award in criticism. His other books include biographies of Bing Crosby, Louis Armstrong Charlie Parker, and volumes of music criticism: "Riding on a Blue Note," "Rhythm-a-ning," and "Weather Bird." His music writing has earned him an unparalleled six ASCAP Deems Taylor Awards, a Guggenheim Fellowship, a Peabody Broadcasting Award, a Grammy Award, and a lifetime achievement award from the Jazz Journalists Association.

Marty Ehrlich is a composer, ensemble leader, and multi-instrumentalist. In 2004 he received a Guggenheim Fellowship in Music Composition. He is currently Visiting Professor of Music at Hampshire College. He has received numerous grants from the New York Foundation for the Arts, the NEA, the Mary Flagler Charitable Trust, and the Doris Duke Foundation. In 2002 he was named Jazz Clarinetist of the year by the Jazz Journalist Association. In 2000 he was the Peter Ivers Visiting Artist at Harvard University. Marty Ehrlich graduated from the New England Conservatory of Music, of which he is a Distinguished Alumni. He has recorded 15 CD's of his own compositions. The Boston Phoenix called his 2003 recording "The Long View" "one of a handful of

integral long-form works in jazz, standing beside those of the likes of Hemphill, Mingus, and Ellington."

Farah Jasmine Griffin is Director of the Institute for Research in African American Studies and Professor of English and Comparative Literature at Columbia University in New York. She is the author of *Who Set You Flowin': The African American Migration Narrative* (Oxford, 1995) and *If You Can't Be Free, Be a Mystery: In Search of Billie Holiday* (Free Press, 2001). She has edited a number of collections including, *Uptown Conversation: The New Jazz Studies*, a collection of essays co-edited with Robert O'Meally and Brent Hayes Edwards (Columbia University Press, 2004). Professor Griffin's essays and articles on jazz have appeared in The New York Times, Harper's Bazaar, The Philadelphia Inquirer, and Miles Davis and American Culture, and she has written liner notes on Billie Holiday, Lena Horn and Dinah Washington. Her latest book on Miles Davis and John Coltrane (authored with Salim Washington) will be published by Simon and Schuster in 2006. Dr. Griffin has taught at Trinity College, the University of Pennsylvania, and Jazz at Lincoln Center, and has lectured widely on African American literature, music, and politics. Dr. Griffin received her bachelor's degree from Harvard University and her Ph.D in American Studies from Yale University.

Bill Frisell, a guitarist, composer and bandleader, has established himself as a visionary presence in American music in a career spanning more than 20 years and 150 recordings, including 20 albums of his own. Over the years, Frisell has contributed to the work of such collaborators as Paul Motian, John Zorn, Elvis Costello,

Ginger Baker, The Los Angeles Philharmonic, Suzanne Vega, Loudon Wainwright III, Van Dyke Parkes, Rickie Lee Jones, Wayne Horvitz, Hall Wilner, Robin Holcomb, Vernon Reid, Julius Hemphill and the Frankfurt Ballet. His wide-ranging catalog has been cited by Downbeat as "the best recorded output of the decade." Mr. Frisell's most recent album, *Unspeakable*, received the 2005 Grammy Award for Contemporary Jazz record.

Lee Townsend is an independent music producer, artist manager and owner of Songline/Tone Field Productions, specializing in recordings of singer-songwriters, contemporary composers, improvising musicians and cross-cultural musical collaborations. Since 1983,- Townsend has produced recordings of numerous artists including Bill Frisell, John Scofield, Rinde Eckert, Vinicius Cantuaria, Shweta Jhaveri, Dino Saluzzi, Loudon Wainwright III, Elvis Costello, Pat Metheny, Joey Baron, Charlie Hunter, T.J. Kirk, Dave Holland, Hank Jones and John Abercrombie. Lee Townsend is also the producer of the "Century of Song" program for the Ruhr Triennale Arts festival in Germany. He has been Vice President of Artists and Repertoire for Verve/Polygram Records, General Manager and Director of U.S. Operations at ECM Records and a staff producer at National Public Radio affiliate, KCRW-FM in Santa Monica. He has also collaborated on motion picture soundtracks and theater music.

Robert G. O'Meally is Zora Neale Hurston Professor of Literature at Columbia University, where he has served on the faculty for fifteen years. Since 1999, he has been the Director of Columbia's Center for Jazz

Studies. He is the author of *The Craft of Ralph Ellison* and *Lady Day: The Many Faces of Billie Holiday*, and was the principal writer of *Seeing Jazz*, the catalogue for the Smithsonian's exhibit on jazz painting and literature. Dr. O'Meally has co-edited three volumes, *History and Memory in African American Culture*, *The Norton Anthology of African American Literature*, and *Uptown Conversation: The New Jazz Studies*, which was released last year. He has edited *The Jazz Cadence of American Culture*, which was awarded the ASCAP–Deems Taylor prize in December 1999, and a collection of essays for Modern Library entitled *Living With Music: Ralph Ellison's Essays on Jazz*. He also wrote the script for the documentary film *Lady Day* and for the documentary accompanying the Smithsonian exhibit, *Duke Ellington: Beyond Category*. Dr. O'Meally was nominated for a Grammy for his work as co-producer of the 1998 five-CD box set *The Jazz Singers*. He received his B.A. from Stanford (1970) and his Ph.D. from Harvard (1975).

REASONS FOR GRANTING THE PETITION

In their Brief of Amicus Curiae, Amicus parties herein respectfully ask the Court to grant Petitioner James Newton's petition for writ of certiorari and address the issues set forth below.

I. THE ISSUE OF HOW TO MEASURE THE APPROPRIATION OF A MUSICAL SAMPLE IS A MATTER OF GREAT PUBLIC IMPORTANCE

Since the introduction of digital reproduction technology, a legal debate has surrounded the musical practice of digital sampling. The most critical issue in that debate is the question of how to analyze complex or sophisticated musical work. In his petition for writ of certiorari, Petitioner James Newton asks this Court to address a split in the circuits regarding how to measure the substantiality of copied musical expression. Amici agree with petitioner James Newton that this matter is of wide public importance to musicians, artists, producers and consumers, and should be addressed by the Supreme Court.

"The term *digital sampling* or *sampling,* refers to the recording of a sound, or a portion of a previously existing sound recording, with the aid of a device that can store the recording in binary form in the memory of a computer. Sampling was made possible by the emergence of digital sound and computer technology in the 1960s and 1970s and has been made practical in the 1980's and 1990's by the widespread availability of inexpensive sampling-capable digital synthesizers and personal computers." A. Kohn & B. Kohn, Kohn on Music Licensing, 2nd Ed., 1287-1288 (1996). Since the introduction of digital sampling equipment in the 1980s, audio collage techniques have come to play a major role in the musical mainstream. *See, e.g.,* Robert M. Szymanski, *Audio Pastiche: Digital Sampling, Intermediate Copying, Fair Use,* 3 UCLA Ent.L.Rev. 271 (1996) (describing history of digital music

sampling). Low cost audio editing software such as Pro-Tools have enabled a new generation of amateur and professional musicians to craft new compositions out of pre-existing musical works on their home computer.[2] The musical practice of digital sampling has also spawned numerous articles, books, and law review articles.[3]

This explosion of sampling technology and lack of uniform legal precedent brings to mind the pending high profile case of MGM v. Grokster, Case No. 04-480, with one exception. Whereas the controversy surrounding file-sharing of musical works has existed for only a few years, the debate surrounding digital sampling in the music industry has continued unabated for over two decades. As Amicus parties in support of

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[2] Recent examples include "The Grey Album" by D.J. Dangermouse, an unauthorized CD release combining instrumentation of the Beatles' "While Album" with acapella vocal tracks originally intended for rapper Jay Z's "Black Album." R. Walker, "Consumed: The Grey Album," NY Times, March 21, 2004 at Section 6 , Page 32 , Column 1. *See also* J. Leeds, "Timeline: Mix and Mash," NY Times, Jan. 9, 2005 at Section 2 , Page 4 , Column 5 ("Roughly 30 years after D.J.'s began mixing songs into clever new forms, the mash-up -- in which two or more songs are fused into one -- has ascended from underground phenomenon to commercial fad[.]")

[3] *See e.g.*, Nancy L. McCullough, Note, *A New Spin on Music Sampling: A Case for Fair Pay*, 105 Harv. L. Rev. 726 (1992); Nancy L. McCullough, *Making the Case Against Illicit Sampling*, 26 Beverly Hills Bar Ass'n J. 139 (1992); David Sanjek, *"Don't Have to DJ No More": Sampling and the "Autonomous" Creator*, 10 Cardozo Arts&Ent.L.J. 607 (1992); Michael L. Baroni, *A Pirate's Pallette: The Dilemma of Digital Sound Sampling and a Proposed Compulsory License Solution*, 11 U. Miami Ent. & Sports L.Rev. 91 (1993).

Respondents Michael Diamond, *et al.* advised the Ninth Circuit two years ago:

> [W]e believe that it is crucial for this Court to appreciate the significance of the precedent set by this case to innovation and creativity in the musical arts. A rule remains to be written applying fundamental principles of copyright in light of the ascendancy of digital sampling in the artistic and creative process of producing and recording music, and the continued technological developments in that process.

Amicus Curiae Brief in Support of Appellees (Filed Nov. 25, 2002) at 5. On this point, Amici on both sides are in full agreement. More than ever, the federal courts, musicians, the music industry, and consumers of digital editing software seek clarity regarding how to measure the substantiality of a segment of a copyrighted work, particularly where that work is complex, non-traditional, or derives from another culture. The need for clarity is especially pressing given the unjust legal results that can occur, as in Newton v. Diamond, where an "ordinary lay person" standard is used to analyze a complex, non-traditional or avant-garde musical work. For this reason, Amici believe a uniform standard should be applied when analyzing whether a particular musical work has been infringed, regardless of whether it is through digital sampling or more traditional means.

II. AMICI BELIEVE THE COURT SHOULD ADOPT AN APPROACH TO ANALYZING SUBSTANTIALITY OF MUSICAL EXPRESSION THAT RESPECTS THE WIDE DIVERSITY OF MUSICAL PRACTICE

Amici agree with Petitioner James Newton that analysis of difficult and challenging musical works should not be left to an ordinary lay audience, but rather must be evaluated by an audience that has been provided with sufficient expertise to understand the language of the work in question. Music, like language, is contextual and is best understood by those who are conditioned to its cultural practices and traditions. If a listener does not understand the rules, he or she cannot understand a composer's intent or the richness of the resulting musical expression. As Justice Holmes observed in Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903), with respect to works of visual art:

> It would be a dangerous undertaking for persons trained only in law to constitute themselves final judges of the worth of pictorial illustrations, outside the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their authors spoke.

This is the challenge faced by composers of new music, whose work currently would be evaluated in the

Fourth Circuit by a person who "possesses specialized expertise . . . that lay people would lack," and in the Ninth Circuit by the contrary standard of an "ordinary lay observer" lacking expertise. *See, e.g.*, Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 736 (4th Cir. 1990), *cert. denied*, 498 U.S. 981 (1990) (adopting specialized audience approach); Swirsky v. Carey, 376 F.3d 841, 847 (9th Cir. 2004) (reaffirming "ordinary, reasonable person" approach).

Amici believe the approach taken by the District of Columbia, First, Seventh, Eighth, Ninth, Tenth and Eleventh Circuits is inconsistent with the legal system's gradual awakening to the complexity of musical language. For instance, timbre, tone, spatial organization, consonance, dissonance, accents, note choice, combinations, interplay of instruments, basslines, and new technological sounds can all be elements of a musical composition. See Debra Presti Brent, *The Successful Musical Copyright Infringement Suit: The Impossible Dream*, 7 U. Miami Ent. & Sports. L. Rev. 229, 248-249 (1990); Stephanie J. Jones, *Music Copyright in Theory and Practice: An Improved Approach for Determining Substantial Similarity*, 31 Duq. L. Rev. 277, 294-95 (1993); see also Tempo Music, Inc. v. Famous Music Corp., 838 F.Supp. 162, 168 (S.D.N.Y. 1993) ("In contemporary music, and particularly in the jazz music genre, musicians frequently move beyond traditional rules to create a range of dissonant and innovative sounds."). One commentator believes it is the very complexity of music expression that has caused courts to be inconsistent in analyzing the substantial similarity of musical works, noting:

> [T]here is something in music which makes it difficult for lay observers to agree as to whether the mere possibility of substantial similarity exists. The impact of that "something" upon consistency of determinations regarding substantial similarity ... appears to be considerable.
>
> At least one source of that complicating "something" may be found in the very complexity of music.

Alice J. Kim, *Expert Testimony and Substantial Similarity: Facing the Music in (Music) Copyright Infringement Cases*, 19 Colum.-VLA J.L. & Arts 109 (1995), published in R.H. Chused, A Copyright Anthology: The Technology Frontier, 253, 262-63 (1998). Given these inconsistencies, Amici are concerned that the Ninth Circuit's reliance on an "ordinary, reasonable person" standard in Newton v. Diamond fails to address the complexity inherent in 20th and 21st Century forms of musical expression.

Amici are particularly concerned regarding use of an "ordinary reasonable person" when evaluating works in contemporary genres like minimalism. "Minimalist music, at least originally, tended to restrict itself to a tiny repertoire of pitches and rhythmic values, like the F Dorian scale and steady 8th-notes of Philip Glass's "Music in Fifths." The length of the works actually underlines the intense restriction of materials: you might write a four-minute piece using only seven pitches and no one would notice, but write a 30-minute piece, and the austere limitations become a

major phenomenon of the composition." K. Gann, *Thankless Attempts at a Definition of Minimalism*, in C. Coss & D. Warner (Eds.) Audio Culture: Readings in Modern Music at 299 (2004). Minimalist works frequently adopt many of the musical techniques found in James Newton's composition *Choir*, including static harmony, repetition, additive process, phrase shifting, permutational process, steady beat, static instrumentation, linear transformation (including shifts from tonality to atonality), compositional use of overtones, influence of non-western cultures and audible structure. *See* K. Gann, *supra*, at 300-302. An "ordinary reasonable person" whose understanding of music is limited to only melody, harmony and rhythm would lack the necessary skills to evaluate the substantiality of appropriation in such a nuanced work.

Works of microtonality may also require analysis by one informed by specialized expertise in that genre. "As an element in the assimilation of ethnic influences from other regions of the world, microtonal tunings supply intervallic configurations that sound fresh to Western ears and lend themselves to a wide variety of new expressive possibilities. . . . New tunings have opened up innovative approaches to harmony and melody, while the exploitation of unused acoustical processes associated with just intonation, especially those involving interference patterns (or 'beatings'), has introduced a spectrum of timbral effects largely untapped in previous Western music." R.P. Morgan, Twentieth-Century Music at 440 (1991). Examples here include the 43-tone scale of Harry Partch, a composer who used original instruments (including the "spoils of war," "diamond marimba" and "harmonic cannon") to create "music so utterly out of step, not

only with the musical mainstream but also with the avant-garde of the time, it's difficult to appreciate fully in today's more experimental climate." Id. at 303-304.

Traditional and contemporary works of jazz are particularly ill-served when analysis is rendered by those unfamiliar with its language. The difficulty of capturing the essential elements of a jazz composition on paper is widely understood, as the notation system itself remains at odds with the aesthetic values of the music and the creative spirit of its practitioners. M. Tucker, The New Grove Dictionary of Jazz, 1213 (B. Kernfeld, ed., 2000). Although composers and performers of jazz continue to use Western staff notation, this music is not always adequately expressed using traditional notational methods. R. Witmer, The New Grove Dictionary of Jazz, 921 (B. Kerfeld, ed., 2000). Standard notation may be adapted to represent melody in jazz, but it has only limited ability to convey deviations from standard pitch, including compositional elements such as vibrato, blue notes, bends, microtonal and intonational nuances. Id. at 923. *See also* T. Ellingson, "Notation," in H. Myers, (ed.) Ethnomusicology: An Introduction, 153-154 (1992) (observing that African-American musical forms, particularly jazz and spirituals, place far less emphasis on written notation).

An ordinary reasonable person may also be unfamiliar with more recent innovations in electronic music, which is often studio-based and seldom notated.[4]

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[4] "Purely electronic compositions rarely exist in score form, since none is needed for 'performance,' only to supply purely technical information about how the composition was made." R.P. Morgan, Twentieth-Century Music (1991) at 471.

An electronic work by Stockhausen, a work of *musique concrete* by Pierre Schaeffer, and an early 'industrial' piece by the late 1970s group Throbbing Gristle may sound foreign to the lay audience, while a trier of fact with specialized expertise may more readily grasp qualitative and quantitative elements in this music beyond a traditional measure of melody, harmony and rhythm. As 20th Century composer Edgar Varese has remarked:

> Although the new music is being gradually accepted, there are people who, while admitting that it is 'interesting,' say 'but is it music?' It is a question I am only too familiar with. Until quite recently I used to hear it so often in regard to my own works that, as far back as the twenties, I decided to call my music 'organized sound' and myself, not a musician, but 'a worker in rhythms, frequencies and intensities.'

E. Varese, "The Electronic Medium" (lecture) 1962, in Audio Culture: Readings in Modern Music (2004) at 20.

As with electronic music, ordinary lay audiences may also be generally unfamiliar with contemporary musical genres beyond the commercial mainstream, such as Brian Eno's "Ambient Music,"[5] or the intricate musical language of dub reggae and its many

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[5] *See* B. Eno, "Ambient Music," in Audio Culture: Readings in Modern Music (2004) at 95 ("So a recording composer may spend a great deal of her compositional energy effectively inventing new sounds or combinations of sounds.").

descendents, including electronica and hip-hop, where "the mixing board becomes a pictorial instrument, establishing the illusion of a vast soundstage and then dropping instruments in and out as if they were characters in a drama." D. Toop, "Replicant: On Dub," in Audio Culture, *supra* at 357. Rather, a consistent legal analysis of such music demands an analysis by one reasonably familiar with the music's language, including here the "odd perspectives and depth illusions, sound effects, unexpected noises and echoes that repeat into infinity." Id.

Compositional techniques may also involve directing the musician to use unconventional ways of playing conventional instruments, which may not be understood by an ordinary reasonable person. "Often this necessitate[s] a purposeful "misplaying" of the instrument to elicit sounds it was not originally intended to make. . . . Other innovations include woodwind 'multiphonics' (several pitches sounding simultaneously, produced with 'false' fingerings and overblowing);[6] breathing through brass instruments without producing a pitch; key clicks on woodwinds; humming and playing simultaneously on winds, blowing through a mouthpiece not attached to an instrument; playing a piano with a metal rod placed on the strings; playing on the strings of a double bass with percussion mallets (requiring two players, one to finger, one to strike); dipping a sounding tam tam into a bucket of water (thus 'bending' its pitch); and playing timpani

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[6] The Ninth Circuit in Newton v. Diamond recognized that the composition *Choir* made compositional use of multiphonics on flute. *See* Newton v. Diamond, 388 F.3d 1189, 1191 (9th Cir. 2003).

with crotales placed on the drum head." R.P. Morgan, Twentieth Century Music (1991) at 391.

Many different types of folk and ethnic music also play an increasing role in modern composition. This interest in musical cross-fertilization is one manifestation of the increasingly 'global' nature of modern music, from John Cage's interest in Eastern philosophy to Toru Takemitsu's integration of native Japanese elements with Western music. Id. at 421-422. This is equally true when considering the overwhelming influence of African music on jazz, blues and spiritual compositions. Contemporary popular music increasingly reflects the influence of what Marshall McLuhan has described as the "global village." Amici urge the Supreme Court to recognize the increasing popular and commercial impact of world music, and affirm that lower courts must analyze foreign musical works from the perspective of one with an understanding of that music culture.

For each of these reasons, Amici believe that the Federal Circuit split regarding the perspective of the ordinary or specialized audience when evaluating the substantiality of original expression in a copyrighted work should be resolved by the Supreme Court. In resolving this issue, Amici respectfully ask the Court to take an approach that will respect, as much as possible, the widest diversity of musical expression, regardless of musical genre or its culture of origin.

CONCLUSION

For the foregoing reasons, Amici respectfully request that the petition for writ of certiorari by James Newton be granted.

Respectfully submitted,

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